



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

Citation: 2010 TMOB 104
Date of Decision: 2010-07-26

**IN THE MATTER OF AN OPPOSITION
by Gentek Building Products Limited to
application No. 1,268,075 for the trade-
mark OXFORD in the name of Masonite
International Corporation**

[1] On August 3, 2005, Masonite International Corporation (the Applicant) filed an application to register the trade-mark OXFORD (the Mark) based on proposed use in Canada in association with “metal doors and non-metal doors, namely, exterior entry doors, door lites, side lites, transom lites and decorative glass, namely glass door panels and glass panels, namely exterior entry, window glass, diffused reflection glass, stained glass, and decorative glass for building use” (the Wares). The Applicant claimed a priority filing date of February 4, 2005 based on United States application No. 78/561,092 in association with the same kind of wares.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of March 7, 2007.

[3] On August 7, 2007, Gentek Building Products Limited (the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

- The Mark is not registrable pursuant to s. 38(2)(b) and 12(1)(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) as it is confusing with the Opponent’s registered trade-mark OXFORD (registration No. TMA525,528) registered March 22, 2000 for “building materials, namely soffit, made of non-metallic materials”.

- The Applicant is not the person entitled to registration pursuant to s. 38(2)(c) and 16(3)(a) of the Act since at the date of filing the Mark was confusing with the trade-mark OXFORD previously used and made known in Canada by the Opponent in association with doors and soffits.
- The Mark is not distinctive pursuant to s. 38(2)(d) and 2 of the Act since it cannot distinguish, and is not adapted to distinguish, the Wares from the wares of the Opponent in view of the Opponent's OXFORD trade-mark.
- The application for the Mark does not comply with provisions of the Act, in particular s. 34 of the Act, in that the Applicant, claiming priority from a U.S. application, did not, at the date of filing, have a real and effective industrial or commercial establishment in the U.S. The application is therefore void, as containing false statements and the Applicant can therefore not claim that it is satisfied of its entitlement to use the Mark under s. 30(i).

[4] The Applicant served and filed a counter statement on October 19, 2007 in which it essentially pled over and denied the Opponent's allegations and put the Opponent to the strict proof thereof.

[5] In support of its opposition, the Opponent filed the affidavits of Christine Van Egmond sworn May 14, 2008, with Exhibits A through K, and Dane Penney, sworn May 13, 2008, with Exhibit A.

[6] The Applicant did not file any evidence in support of its application.

[7] Both parties filed written arguments. Both parties were represented at an oral hearing.

Opponent's Evidence

Affidavit of Christine Van Egmond

[8] Ms. Van Egmond is the Opponent's Marketing Supervisor. Ms. Van Egmond states that the Opponent has been a leading manufacturer of vinyl, aluminum and steel exterior building

products for more than 40 years. Ms. Van Egmond's affidavit provides evidence of the Opponent's use of the OXFORD Mark and the nature of the Opponent's wares and trade.

[9] As Ms. Van Egmond's affidavit is directed towards the use and reputation of the Opponent's registered trade-mark OXFORD it will be discussed in further detail below in the assessment of the s. 12(1)(d) ground of opposition.

Affidavit of Dane Penney

[10] Mr. Penney, a searcher employed by the Opponent's agent, provides results from a search of the OnCorp Direct Inc. online database for active corporate listings in Ontario for the name "Masonite International Corporation" conducted on May 2, 2008.

[11] As Mr. Penney's affidavit is directed towards the Applicant's corporate structure it will be discussed in further detail below in the assessment of the s. 30(i) ground of opposition.

Preliminary Issues

Applicant's Reliance on Evidence Not of Record

[12] At the oral hearing, the Opponent focussed its submissions on the fact that the Applicant did not file evidence but then made submissions in its written argument relying on evidence that had not been properly made of record with the Opponent having been prevented from conducting cross-examination or filing evidence in reply.

[13] At the oral hearing, the Opponent classified the "evidence" the Applicant had relied on in its written argument as belonging to one of the following three types, all of which the Opponent submitted are impermissible:

- Materials from the file history of the application for the Mark (e.g. materials printed from home improvement store websites adduced as "evidence" during prosecution in support of the Applicant's submissions) without having filed a certified copy or copies of the relevant documents or, more importantly, an

affidavit attaching these documents. The Applicant relied on this type of “evidence” in paragraphs 11, 12, 23, 33 and 34 of its written argument.

- State of the register evidence without having filed either certified copies of the relevant registrations or an affidavit attaching particulars thereof. The Applicant relied on this type of “evidence” in paragraphs 23, 35, 37 and 38 of its written argument.
- Facts for which evidence was not adduced regarding: the nature of the parties’ wares, the purchasers of the parties’ wares, the channels of trade, the stores in which the parties’ wares are sold, the location of the parties’ products within these stores, the location of the Opponent’s wares on its website and third party home improvement websites, the size and shape of the packaging for the Wares, the cost of the Wares and information regarding the Applicant’s North American subsidiary. The Applicant relied on this type of “evidence” in paragraphs 9, 11, 12, 14, 16, 18, 28, 29, 30, 32-34 and 40 of its written argument.

[14] With respect to the first category of “evidence” relied upon by the Applicant in its written argument, I find that these materials should have been filed as part of an affidavit or statutory declaration [see r. 42 of the *Trade-marks Regulations* SOR/96-195 (the Regulations)]. To permit parties to rely on documents filed during prosecution without also properly filing them as evidence in the opposition proceeding would create a loop-hole through which parties could attempt to circumvent cross-examination.

[15] With respect to the second type of “evidence” relied upon by the Applicant in its written argument, I agree with the Opponent. The law is clear that, when adjudicating in an opposition proceeding, the Registrar does not exercise discretion to take cognizance of his own records except to verify whether claimed trade-mark registrations and applications are extant [see *Quaker Oats Co. of Canada v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 at 411 (T.M.O.B.) and *Royal Applicant Mfg. Co. v. Iona Appliance Inc.* (1990), 32 C.P.R. (3d) 525 at 529 (T.M.O.B.)]. The parties to opposition proceedings are expected to prove each aspect of their

case following fairly strict rules of evidence [see *Loblaw's Inc. v. Telecombo Inc.* 2004 CarswellNat 5135 at para 13 (T.M.O.B.)].

[16] Further, the Opponent submitted that state of the register evidence cannot be considered where it is adduced through the written argument and without filing certified copies of the registrations or at least an affidavit affixing particulars of the relevant registrations [see *Unitron Industries Ltd. v. Miller Electronics Ltd.* (1983), 78 C.P.R. (2d) 244 at 253 (T.M.O.B.), followed in *John Labatt Ltd. v. W.C.W. Western Canada Water Enterprises Inc.* (1991), 39 C.P.R. (3d) 442 (T.M.O.B.), followed in *Frank T. Ross & Sons (1962) Ltd. v. Hello Cosmetics Inc.* (1994), 53 C.P.R. (3d) 124 (T.M.O.B.)]

[17] With respect to the third type of “evidence” relied upon by the Applicant in its written argument, the Opponent submitted that the Applicant has not adduced proper evidence on any of these points as per r. 42 of the Regulations which requires evidence to be filed in the form of an affidavit or statutory declaration.

[18] As part of this third type of “evidence”, the Applicant commented on excerpts from the Opponent’s website which had not been entered into evidence by either party. At the oral hearing, the Applicant submitted that it should be permitted to rely on the Opponent’s website since it had been introduced into evidence through the Van Egmond affidavit. The Opponent submitted, and I agree, that while it is true that the Van Egmond affidavit introduced portions of the Opponent’s website into evidence, the Applicant was wrongly referring to portions of the website that were not part of the record.

[19] Ultimately I find that none of the “evidence” the Applicant referred to in its written argument, as set out above, was properly filed as evidence and as a result I am disregarding any submissions made by the Applicant based on evidence which is not of record.

Applicant’s Objections to the Van Egmond Affidavit

[20] At the oral hearing, the Applicant objected to Ms. Van Egmond as an affiant stating that she was an unsuitable choice due to the fact that she is not a high level official in the Opponent’s organization nor does she occupy a sales position. The Opponent countered the Applicant’s

argument by pointing out that the Applicant had the opportunity to test Ms. Van Egmond's credibility by way of cross-examination but it chose not to do so. In the absence of cross-examination, I find no reason to doubt Ms. Van Egmond's credibility as a witness.

[21] At the oral hearing, the Applicant also objected to the fact that in paragraph 18 of her affidavit, Ms. Van Egmond provides her opinion on various substantive issues relating to the opposition proceeding. I agree with the Applicant's submission and find that the affiant's opinions on these matters will not be considered as the merit of the opposition is the issue to be decided by the Registrar from the evidence filed in the present proceeding [see *British Drug Houses Ltd. v. Battle Pharmaceuticals* (1944), 4 C.P.R. 48 at 53 and *Les Marchands Deco Inc. v. Society Chimique Laurentide Inc.* (1984), 2 C.P.R. (3d) 25 (T.M.O.B.)].

Onus and Material Dates

[22] 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].

[23] At the oral hearing, the Opponent submitted that the opposition must automatically succeed as the Applicant's failure to file evidence or to request cross-examination of the Opponent's witnesses necessitates a finding that the Applicant had failed to meet its burden of proving that the application for the Mark complied with s. 30 of the Act, that there is no likelihood of confusion between the marks at issue and that the Mark is distinctive. I do not agree with this argument. Given the evidential burden on an opponent, the fact that an applicant chooses not to file evidence or to request cross-examination does not automatically lead to a successful opposition.

[24] The material dates that apply to the grounds of opposition are as follows:

- s. 30(i) - the date the application was filed [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 at 475 (T.M.O.B.) and *Tower Conference*

Management Co. v. Canadian Exhibition Management Inc. (1990), 28 C.P.R. (3d) 428 at 432 (T.M.O.B.).

- 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(3)(a) - the date of filing the application [see s. 16(3) of the Act].
- 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.)].

Section 30(i) Ground of Opposition

[25] The requirement under s. 30(i) of the Act is to include, in the application, a statement that the applicant is satisfied that it is entitled to use the mark in Canada in association with the wares. The Applicant provided such a statement in its application.

[26] In situations like the present where the relevant statement is provided, a s. 30(i) ground of opposition should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of an applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 at 155 (T.M.O.B.)].

[27] The Opponent has alleged that the application is not in compliance with s. 30(i) of the Act because the Applicant is not in compliance with s. 34 of the Act which requires the Applicant to have, at the date of filing the application, a “real and effective industrial or commercial establishment” in the priority country.

[28] To support its s. 30(i) ground of opposition, the Opponent adduced the Penney affidavit. Mr. Penney attaches to his affidavit a Corporate Profile Report obtained from the OnCorp Direct Inc. online database (Exhibit A). The Report includes a Corporate Document List and a List of Current Business Names registered to Masonite International Corporation/La Corporation Internationale Masonite.

[29] In its written argument, the Opponent contends that the results of Mr. Penney's corporate search reveal no connection between the Applicant and the United States. At the oral hearing, the Applicant submitted that the fact that Mr. Penney searched only an Ontario database and did not search any U.S. databases supports a finding that the Penney affidavit is not sufficient to meet the Opponent's evidentiary burden. I agree.

[30] Ultimately, I find that if the Opponent had intended to plead that the application should be refused solely because the Applicant has not complied with s. 34 of the Act, the ground must be dismissed on the basis that it was improperly pleaded. If, however, the Opponent had intended to plead that the application should be refused on the basis that it contains a false statement, then I find that the Penney affidavit is not sufficient to meet the Opponent's evidential burden to support such a ground and accordingly the ground must be dismissed.

Non-registrability Ground of Opposition – s. 12(1)(d) of the Act

[31] Pursuant to s. 12(1)(d) of the Act, the Opponent has pleaded that the Mark is not registrable because it is confusing with the Opponent's registered trade-mark OXFORD (registration No. TMA525,528) (the Cited Mark) registered March 22, 2000 for "building materials, namely soffit, made of non-metallic materials" (the Registered Wares).

[32] Ms. Van Egmond attaches to her affidavit a certified copy of the registration for the Cited Mark (Exhibit B). I have exercised the Registrar's discretion to confirm that the Cited Mark is in good standing as of today's date. Since the Opponent has discharged its initial burden with respect to this ground of opposition, the burden of proof lies on the Applicant to convince the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Cited Mark.

[33] 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.

[34] 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.)]

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

[35] The word OXFORD has no particular meaning in relation to the Wares and as a result the Mark is inherently distinctive. The same is true for the Cited Mark. As a result, the marks at issue have the same degree of inherent distinctiveness.

[36] As the strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use, I will now turn to the extent to which the trade-marks have become known in Canada.

[37] The Applicant did not file any evidence directed to the use of the Mark subsequent to the filing of the application and as a result I am unable to conclude as to the extent to which the Mark has become known.

[38] By contrast, the Opponent claims, through the Van Egmond affidavit, that it has used the Cited Mark in Canada since 1995 with vinyl soffits.

[39] Ms. Van Egmond states that the Opponent prominently displays the Cited Mark on labels affixed to boxes in which the vinyl soffit is shipped and sold. Ms. Van Egmond attaches to her affidavit sample labels which display the Cited Mark (Exhibit C) and makes the sworn statement that these are representative of how the Opponent has displayed the Cited Mark in association with vinyl soffits since 1995.

[40] The Van Egmond affidavit establishes that sales in Canada of the Opponent's soffit sold in association with the Cited Mark amounted to more than \$11.7 million from 2003 to 2008.

[41] At the oral hearing, the Applicant submitted that the Opponent's claimed sales figures were not particularly significant and were at best moderate. The Applicant further submitted that it was not clear from the wording of the Van Egmond affidavit whether the claimed sales figures were restricted to Canada. I do not agree with the Applicant's argument. I find that the affidavit is clear on its face that these are Canadian sales figures. Furthermore, I have no reason not to accept \$11.7 million in sales over a five year period as a substantial amount of sales. While it would have been of assistance to have had a yearly breakdown of the sales, I find that the Opponent has demonstrated significant sales of its OXFORD branded soffit in the 2003-2008 period.

[42] In her affidavit, Ms. Van Egmond states that the Opponent serves more than 25, 000 customers throughout North America and has manufacturing plants with more than one million square feet dedicated to manufacturing and warehousing located in both the United States and Canada.

[43] At the oral hearing the Applicant highlighted the fact that Ms. Van Egmond listed the number of customers as being "throughout North America" and suggested that this should be interpreted as meaning that the number of customers in Canada would likely be much lower than this. The same could be said for the manufacturing and warehousing space as it is not clear from the wording in the Van Egmond affidavit what portion of this space is located in Canada. I agree. Given that the Opponent has provided Canadian sales figures for the Opponent's soffits, I accept that the Opponent has some Canadian customers. That said, based on the evidence of record, I am unable to determine the number of Canadian customers or the amount of manufacturing and warehouse space in Canada.

[44] The Van Egmond affidavit also establishes that the Opponent's Canadian advertising expenditures relating to the Opponent's products, including soffit sold under the Cited Mark, have reached approximately \$200, 000 over the last ten years.

[45] At the oral hearing, the Applicant submitted that expenditures of \$200, 000 over ten years (approximately \$20, 000 per year) for all of the Opponent's product lines does not amount to substantial marketing expenditures. The Applicant further submitted that, having not been provided with a breakdown for each of the Opponent's product lines, the expenditures for soffits

sold under the Cited Mark would be even smaller. At the oral hearing, the Opponent rebutted this argument by submitting that, even if these marketing expenditures were on the low end, they were sufficient to garner the substantial \$11.7 million in sales of products branded with the Cited Mark.

[46] In her affidavit, Ms. Van Egmond states that the Opponent advertises the Registered Wares in association with the Cited Mark through brochures which it distributes to contractors, wholesalers and retail outlets who in turn pass the brochures on to homeowners (Exhibit E).

[47] Ms. Van Egmond also states that the Opponent advertises the Registered Wares in association with the Cited Mark through its websites (*www.gentek.ca* and *www.gentekinc.com*) and has been doing so since at least as early as April 1997 (Exhibit F). Ms. Van Egmond states that the contents of the websites filed as Exhibits F and G are consistent with the details on the Opponent's websites since 1997. Ms. Van Egmond also provides materials printed from the Opponent's website of May 13, 1999, obtained from the website *www.archive.org* (Exhibit H) and a screenshot and printouts from the Opponent's website of 2002 also obtained from the website *www.archive.org* (Exhibit I).

[48] I note that, at the oral hearing, the Applicant objected to the use of these websites as evidence of the truth of the statements made therein and remarked on the absence of any evidence of statistics as to the numbers of Canadians who have actually viewed the Opponent's websites. I agree with the Applicant's submissions on this point and find that these websites cannot be adduced as evidence of the truth of the contents of the statements made thereon [see *Candrug Health Solutions Inc. v. Thorkelson* (2007), 60 C.P.R. (4th) 35 (F.C.T.D.), reversed (2008), 64 C.P.R. (4th) 431 (F.C.A.), (*Candrug*)]. As a result, I am only able to infer that the websites existed on the dates they were printed (this applies to Exhibits F through I of the Van Egmond affidavit). Based on the foregoing, I note that I can only take notice that the English and French versions of the *www.gentek.ca* website existed at the dates they were printed, namely, February 26, 2008 and May 12, 2008, respectively and the *www.gentekinc.com* existed as of April 23, 2008 (Exhibit F). With respect to the 1999 and 2002 websites accessed from *www.archive.org* (Wayback Machine) I note that, while these websites may feature the Cited

Mark, there is no evidence that any Canadians ever saw them and as a result I can only conclude that they existed back in 1999 and 2002, respectively [see *Candrug, supra*].

[49] Ms. Van Egmond also states that the Opponent advertises its wares by distributing marketing materials to architects, home builders and designers regarding the architectural specifications of its products, including soffit sold under the Cited Mark. As an example, Ms. Van Egmond attaches to her affidavit materials printed from a CD-ROM prepared by the Opponent in 2002 and supplied to home builders and designers (Exhibit J). The materials feature the Cited Mark on informational documents which provide descriptions and specifications for the Opponent's soffit sold in association with the Cited Mark.

[50] In her affidavit, Ms. Van Egmond states that as a result of the Opponent's approximately ten years of extensive marketing and sales of solid and vented vinyl soffit in Canada in association with the Cited Mark, the Cited Mark has "become very well known in Canada by architects, contractors, renovators and homeowners". I cannot afford any weight to the affiant's opinion on this matter as it goes to the merit of the opposition. Nevertheless, in view of the evidence furnished, I am satisfied that the Cited Mark has become known to some extent.

[51] Having reviewed the evidence as a whole, and considered the parties' submissions at the oral hearing, I find that this factor favours the Opponent.

6(5)(b) – the length of time each has been in use

[52] The Mark was applied for on August 3, 2005, with a priority filing date of February 4, 2005, on the basis of proposed use in Canada. The Applicant has not filed any evidence which is directed to the use of the Mark subsequent to the filing of the application.

[53] By contrast, the Opponent's evidence, discussed in greater detail above in the analysis of the s. 6(5)(a) factor, supports a finding that the Opponent has used the Cited Mark in Canada since 1995 with vinyl soffits.

[54] Based on the foregoing, this factor favours the Opponent.

6(5)(c)– *the nature of the wares*

[55] It is the Applicant’s statement of wares as defined in its application versus the Opponent’s registered wares that govern my determination of this factor [see *Esprit International v. Alcohol Countermeasure Systems Corp.* (1997), 84 C.P.R. (3d) 89 (T.M.O.B.)].

[56] The Applicant applied to register the Mark in association with “metal doors and non-metal doors, namely, exterior entry doors, door lites, side lites, transom lites and decorative glass, namely glass door panels and glass panels, namely exterior entry, window glass, diffused reflection glass, stained glass, and decorative glass for building use”.

[57] The Cited Mark is registered for use in association with “building materials, namely soffit, made of non-metallic materials”.

[58] At the oral hearing, the Applicant submitted that there is no evidence of close similarity between the parties’ wares and submitted that the Van Egmond affidavit supports a finding that the parties’ wares are different. The Applicant submitted that on the face of the description of the Wares and the description of “soffits” found on the Opponent’s website the difference between the wares is apparent.

[59] As defined in the specification in the registration for the Cited Mark, the Registered Wares belong to the general class of “building materials”. Without any evidence to the contrary, there is nothing in the Applicant’s specification that suggests that the Wares do not belong to this general class. In fact, the specification for the Wares includes the words “for building use”.

[60] Having considered the Applicant’s submissions in both its written argument and those presented at the oral hearing on the issue of the nature of the parties’ wares, I am of the view that the parties’ wares belong to the same general class.

[61] At the oral hearing the Applicant also submitted that the Canadian trade-mark system only provides protection to a trade-mark owner for the wares and/or services specifically set out in the application for registration. The Applicant submitted the Opponent’s protection should thus be limited to soffits as specifically identified in the registration. Furthermore, the Applicant submitted that the Opponent has only shown use of the Cited Mark in association with soffits.

The Applicant further submitted that the Cited Mark had not become sufficiently known to extend its ambit of protection beyond that prescribed in the registration for the Cited Mark.

[62] While I agree with the Applicant's submission that owning a trade-mark registration does not grant a registrant a monopoly over limitless classes of wares and/or services, I am of the view that there is nothing in the evidence to suggest that the Registered Wares belong to a different class than the Wares.

[63] Ultimately, in the absence of any evidence from the Applicant regarding the nature of the Wares, I find that the parties' wares belong to the same general class, namely that of building materials. This is due in part to the fact that the Wares, as identified in the specification include the words "for building use".

[64] Based on the foregoing, I find that this factor favours the Opponent.

6(5)(d) – nature of the trade

[65] The Applicant has not filed any evidence to define the nature of its trade.

[66] The Van Egmond affidavit establishes that the Opponent operates in residential and light commercial markets for both new construction and remodelling projects as well as being involved in various North American public and military programs. The Van Egmond affidavit establishes that the Registered Wares are sold to contractors, architects, wholesalers and retailers through the Opponent's 24 distribution and sales centres across Canada and through the general public through home improvement stores like Rona, Home Hardware, Lowe's, Tim-Br Mart, Castle Building Centres, Kent Home Improvements and Federated Co-op Stores.

[67] In her affidavit, Ms. Van Egmond states that due to her familiarity with the stores where the Registered Wares are sold, she is aware that the Wares are also sold in these stores. Without further evidence to support this, I am not willing to afford this statement much weight.

[68] At the oral hearing the Applicant submitted that the Opponent's evidence supports a finding that the parties' channels of trade are different with little to no overlap between them. The Applicant submitted that if there was any overlap between the parties' channels of trade, it

would only be in home improvement stores and the Applicant submitted that this appeared to be the least important of the Opponent's channels of trade. I cannot consider the Applicant's comments on this as I have no evidence to support the contention that home improvement stores are the least important of the Opponent's channels of trade. The Applicant further submitted that the Opponent did not give any evidence about where the parties' wares would be sold within these stores and suggested that they may be sold in different parts of the store. Again, I have no evidence as to where the parties' wares are sold and cannot speculate that they would be sold in different parts of the same stores.

[69] The Applicant submitted that just because the Opponent owns a registration for one ware that could be sold in a home improvement store it does not give the Opponent a monopoly over every type of ware sold at a home improvement store. While I agree with the Applicant that it would be improper for the Opponent to assert a monopoly over every type of ware sold in a home improvement store, I do not agree with the Applicant that the Opponent is in fact attempting to do this.

[70] Ultimately, in the absence of any evidence as to the nature of the Applicant's trade and given that I have found that the parties' wares belong to the same general class, I find it reasonable to conclude that the channels of trade associated with the trade-marks at issue could be identical or overlapping.

[71] Based on the foregoing, this factor favours the Opponent.

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

[72] In most instances, the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested is the dominant factor 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.)].

[73] The marks at issue are identical in appearance, sound and ideas suggested by them.

[74] Based on the foregoing, this factor favours the Opponent.

Additional Surrounding Circumstance – the Opponent’s Sale of Doors and Windows

[75] The Opponent has alleged that the Opponent sells doors and window glass, which directly overlap with the Wares. The Opponent submits that this increases the likelihood that consumers will infer that the Wares are manufactured or sold by the Opponent, thereby increasing the likelihood of confusion between the Mark and the Cited Mark.

[76] In support of this submission, the Opponent provides evidence in the Van Egmond affidavit of these additional wares sold by the Opponent, such as steel insulated entry doors, windows, patio doors and decorative entrance doors. The steel insulated entry doors are manufactured by a third party company under the private label “First Impressions by Gentek”. These wares are sold under a variety of trade-marks owned by the Opponent (e.g. REGENCY WINDOWS, SIERRA WINDOWS, BUILDER SERIES WINDOWS, 70 SERIES and 80 SERIES), but not in association with the Cited Mark. As supporting evidence, Ms. Van Egmond attaches to her affidavit printouts from the website *www.gentekdoors.com* which provides information about the Opponent’s collections of decorative entrance doors (Exhibit K) and print outs from the Opponent’s websites (*www.gentek.ca* and *www.gentekinc.com*) which feature windows and patio doors manufactured and sold under the Opponent’s various trade-marks (Exhibit G).

[77] As was raised by the Applicant at the oral hearing, I note that none of these materials display the Cited Mark. In fact, the Opponent makes it clear in the Van Egmond affidavit that these additional wares are sold under other trade-marks, not the Cited Mark. However, the fact remains that the Opponent is engaged in the business of selling both soffits and doors.

[78] Ultimately, having found that the nature of the parties’ wares are related, I do not need to consider this additional surrounding circumstance in order to find in favour of the Opponent. It will, however, be relevant in the analysis of the s. 16 ground of opposition.

Conclusion re s. 12(1)(d) of the Act

[79] Having considered all of the surrounding circumstances, in particular the extent to which the marks have become known, the length of time the trade-marks have been in use, the nature of

the wares and trade and the similarities in sound, appearance, and ideas suggested, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Cited Mark.

[80] Having regard to the foregoing, I allow the ground of opposition based on s. 12(1)(d) of the Act.

Non-entitlement Ground – s. 16(3)(a) of the Act

[81] The s. 16(3)(a) ground of opposition is based upon the previous use and making known in Canada by the Opponent of its Cited Mark in association with doors and soffits.

[82] Despite the burden of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Cited Mark, the Opponent has the initial onus of proving that the trade-mark alleged in support of its ground of opposition based on s. 16(3)(a) of the Act was used or made known prior to the priority filing date for the Applicant's application (February 4, 2005) and had not been abandoned at the date of advertisement of the application for the Mark (March 7, 2007) [s. 16(5) of the Act].

[83] As was discussed in more depth above in the analysis of the s. 12(1)(d) ground of opposition, the Opponent provides evidence through the Van Egmond affidavit establishing that the Cited Mark has been used and made known in Canada in association with vinyl soffits since 1995 with substantial sales thereof.

[84] The Opponent submits, through the Van Egmond affidavit, that its product lines include vinyl, aluminum and steel siding, soffit, fascia, trim, vinyl replacement and new construction windows, vinyl and aluminum patio and garden doors, shutters, columns and gable vents. However, when the evidence is analyzed as a whole, it is clear that the Opponent has only used the Cited Mark in association with soffit, as registered. As discussed above as an additional circumstance in the analysis of the s. 12(1)(d) ground of opposition, the additional wares (doors, windows, etc.) are associated with other trade-marks.

[85] Ultimately, when viewed as a whole, I find that the Van Egmond affidavit is sufficient to enable the Opponent to meet its evidentiary burden with respect to soffits. With respect to the

Opponent's claim to prior use and making known of the Cited Mark with doors I find that the Opponent has not met its burden and this portion of the ground of opposition must be dismissed.

[86] As I came to the conclusion that, based on the evidence filed in the record, the Mark is confusing with the Cited Mark and because the difference in relevant dates does not affect my analysis, the non-entitlement ground of opposition therefore succeeds insofar as soffits are concerned.

Non-distinctiveness Ground – s. 38(2)(d) of the Act

[87] This ground of opposition essentially turns on the issue of confusion between the Mark and the Opponent's trade-mark OXFORD used and made known in association with soffits and doors.

[88] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its Wares from those of others throughout Canada [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272 (T.M.O.B.)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness.

[89] I find that, when reviewed as a whole, the Van Egmond affidavit provides sufficient evidence to support a finding that the Cited Mark had become sufficiently known as of August 7, 2007 in association with soffit to negate the distinctiveness of the Mark, thus enabling the Opponent to meet its burden with respect to soffits. With respect to the Opponent's claim to use and making known of the Cited Mark with doors I find that the Opponent has not met its burden and this portion of the ground of opposition must be dismissed.

[90] As the difference in material dates does not have any significant impact on my previous analysis of the surrounding circumstances under the registrability ground of opposition, I find that the Applicant has not discharged its onus to establish, on a balance of probabilities, that the Mark was not confusing with the Opponent's trade-mark OXFORD at the material date. Therefore, I find that the non-distinctiveness ground of opposition is successful with respect to soffits only.

Disposition

[91] 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.

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office