

**IN THE MATTER OF AN OPPOSITION
by Ipex Inc. to application No. 1,070,916 for
the trade-mark THE PIPE WITH THE
GOLD STRIPE filed by Prinsco, Inc.**

On August 14, 2000, Prinsco, Inc. filed an application to register the trade-mark THE PIPE WITH THE GOLD STRIPE (the “Mark”). The application is currently based upon use of the Mark in Canada since at least as early as July 14, 2000 in association with “corrugated plastic gravity flow drainage pipe used in non-pressurized applications”.

The application was advertised for opposition purposes in the Trade-marks Journal of May 1, 2002.

On June 7, 2002, Ipex Inc. (the “Opponent”) filed a statement of opposition against the application. The Applicant filed and served a counter statement.

Pursuant to r. 41 of the *Trade-marks Regulations*, previously the *Trade-marks Regulations (1996)*, as it read on September 30, 2007, the Opponent filed the affidavit of Carole Massé.

Pursuant to r. 42, the Applicant filed the affidavits of David O. Carlson, Byron Brouwer, Elizabeth Van der Bill, and James R. Duinck. The Opponent obtained an order for the cross-examination of each of these affiants but did not conduct any cross-examinations.

Pursuant to r. 43, the Opponent filed the affidavit of Travis Lutes. The Applicant obtained an order for the cross-examination of Mr. Lutes and a copy of the transcript of cross-examination, as well as answers to undertakings given, form part of the record.

The Applicant also obtained leave pursuant to r. 44(1) to file the affidavits of Larry A. Groen and Khadija Mahmood. The Opponent obtained an order for the cross-examination of each of these affiants but did not conduct any cross-examinations.

Each party filed a written argument and an oral hearing was held at which each party was represented.

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 *Trade-marks Act*, R.S.C. 1985, c. T-13 (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. [*John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)]

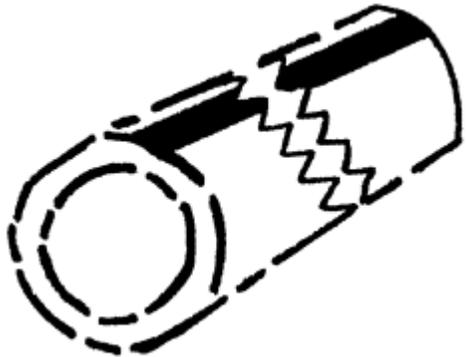
At the oral hearing, the Opponent withdrew its s. 30(b) ground of opposition. The material dates that apply to each of the surviving grounds of opposition are as follows:

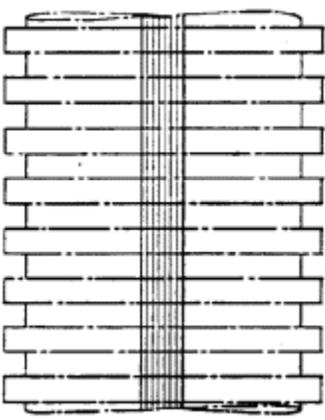
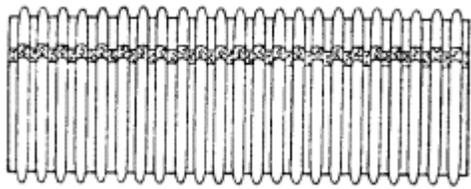
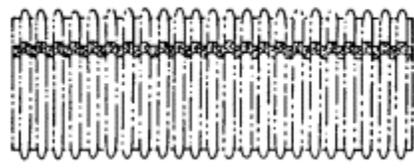
- s. 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)]
- s. 16(1)(a) - the Applicant’s date of first use
- non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

Section 12(1)(d) Ground of Opposition

The Opponent has pleaded that the Mark is confusing with each of the following registered trade-marks individually and collectively as a family:

<u>Trade-mark</u>	<u>Registration No.</u>	<u>Wares/Services</u>
1. THE PIPE WITH THE STRIPE	524,959	Operation of a business dealing in the manufacture, promotion and sale of plastic pipes and tubing for potable water distribution, and specifically excluding plastic pipes or tubing for gas distribution or underground fire-main service
2. GOLD STRIPE	524,956	“ “ “ “ “

3. RED STRIPE	524,943	“ “ “ “ “
4. WHITE STRIPE	525,112	“ “ “ “ “
5. GREEN STRIPE	524,960	Operation of a business dealing in the manufacture, promotion and sale of rigid and semi-rigid plastic pipes and tubing for potable water distribution, primarily for underground use, excluding hoses and power transmission belts and parts for vehicles and automotive and industrial engines, and specifically excluding plastic pipes or tubing for gas distribution or underground fire-main service
6. BLUE STRIPE	525,068	Operation of a business dealing in the manufacture, promotion and sale of plastic pipes and tubing, namely water pipe for potable water distribution, electrical conduit and corrugated pipe and specifically excluding plastic pipes or tubing for gas distribution or underground fire-main service
7. Stripe on a Pipe Design: 	255,111	Polyethylene cold water pressure piping, and polyethylene electrical conduits, polyethylene electrical conduits
8. Blue Stripe Design:	387,212	Plastic pipe namely PVC corrugated electrical conduit

		
<p>9. Red Stripe Design:</p> 	402,481	Corrugated pipe for underground electrical duct
<p>10. Stripe on a Pipe Design:</p> 	430,592	Piping and tubing
<p>11. Stripe on a Pipe Design:</p> 	390,040	Corrugated pipe

It is noted that each of the Opponent's marks 1 through 6 are registered for services, whereas its marks 7 through 11 are registered for wares.

If THE PIPE WITH THE GOLD STRIPE is not confusing with either THE PIPE WITH THE STRIPE or GOLD STRIPE, then it will not be confusing with any of the Opponent's remaining

marks. I will therefore focus my discussion on those two marks of the Opponent. I will begin by summarizing the evidence regarding the reputation associated with each of the party's marks.

Evidence of Use or Promotion of Opponent's Marks

The main evidence concerning the use and promotion of the Opponent's marks comes from Carole Massé, the Opponent's Vice-President of Finance. Ms. Massé refers to a trade-mark of the Opponent which is not mentioned in the statement of opposition, namely the "Stripe Mark", which she defines as a stripe running longitudinally along the exterior surface of a pipe. Ms. Massé says that the Stripe Mark has been registered in various forms, as shown in the trade-marks 7 through 11 in the chart that appears earlier in this decision. Ms. Massé refers to the Opponent's remaining marks (nos. 1 through 6 above) collectively as the "Stripe Word Marks".

Ms. Massé attests that plastic pipe bearing the Stripe Mark has been sold in Canada by the Opponent and its predecessors continually since 1980. During that time period, the Opponent and its predecessors used the following colour stripes: green, red, blue, white or gold on black pipe, and black on a blue pipe. (Hereinafter, reference to the Opponent will be understood to include reference to its predecessors.)

The Opponent's Canadian sales of plastic pipe bearing the Stripe Mark have been provided for each of the years 1993 through 2002 (beginning in excess of 9 million dollars worth in 1993 and ending in excess of 11 million dollars worth in 2002). The total sales of pipe bearing the Stripe Mark prior to 2000 are stated to exceed 63 million dollars.

The Opponent has used a gold-coloured stripe on "water service tubing, which is ¾" to 2" plastic pipe used for connections from the municipal water main to a house" since at least 1990. Sales figures relating solely to this particular colour of stripe have not been provided.

The Opponent relies on the following attestation from paragraph 11 of Ms. Massé's affidavit as evidence that use of its trade-marks THE PIPE WITH THE STRIPE and GOLD STRIPE has been continuous in Canada since 1980 to June 6, 2003, the date of her affidavit:

Similarly, based on the business records of [the Opponent and its predecessors] and based upon my personal knowledge of the plastic pipe industry in Canada, each of [the Opponent and its predecessors] offered for sale and promoted in Canada its plastic pipe bearing the STRIPE Trade Mark in association with the various STRIPE Word Trade Marks, particularly including the mark THE PIPE WITH THE STRIPE and the mark GOLD STRIPE, respectively, during the respective periods [continually from 1980 to date].
[my underlines]

The following specific evidence has been provided with respect to the Opponent's word mark THE PIPE WITH THE STRIPE:

- An advertisement in the Summer 1990 edition of Canadian Pool & Spa Marketing magazine displays PIPE WITH THE STRIPE. [Exhibit "M"]
- A brochure promoting polyethylene pipe that was distributed in Canada sometime before July 1992 refers to THE PIPE WITH THE STRIPE on the front page and elsewhere. [Exhibit "N"]
- A 1996 brochure promoting various plastic pipe products displays PIPE WITH THE STRIPE throughout. [Exhibit "P"]
- Price lists for the Opponent's various striped pipes effective April 14, 2003 display PIPE WITH THE STRIPE. [Exhibit "R"]
- The Opponent's website contained numerous occurrences of PIPE WITH THE STRIPE as of May 30, 2003. [Exhibit "S"]

The following specific evidence has been provided with respect to the Opponent's word mark GOLD STRIPE:

- A brochure distributed in Canada sometime before July 1992 refers to GOLD STRIPE at the top of a page that describes water service tubing sold by one of the Opponent's predecessors. [Exhibit "N", page 6]
- A catalogue page from 1996 refers to GOLD STRIPE in the promotion of "service line tubing". [Exhibit "O"]

The foregoing information enables me to conclude that the marks THE PIPE WITH THE STRIPE and GOLD STRIPE have been used in Canada but the extent of their use has not been detailed. The fact that the Opponent sometimes uses PIPE WITH THE STRIPE, as opposed to THE PIPE WITH THE STRIPE, is of no consequence. [See Principle 2 in *Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535 at 538-9.]

The Applicant has submitted that the Opponent was remiss in not breaking all its evidence down by mark, but I note that the Applicant elected to not seek this information through cross-examination.

Evidence of Use or Promotion of Applicant's Mark

Elizabeth Van Der Bill, the Applicant's Marketing Director, provides the following information:

- Catalogues displaying the Mark "are distributed freely through Prinsco's Canadian distributors to prospective customers." Excerpts from the 2000, 2001 and 2002-2003 catalogues have been provided. [Exhibits "A", "B" and "C"]
- The Mark appears in advertisements in trade journals, including the Canadian magazine *Drainage Contractor*; the 2004 edition of this magazine has been provided. [Exhibit "D"] Ms. Van der Bill has provided the magazine's Canadian circulation figure of 550-600 as of December 8, 2003, but this evidence is clearly hearsay.
- The Applicant's website has displayed the Mark since February 15, 2001; an example from December 16, 2003 has been provided. [Exhibit "E"]
- Calendars displaying the Mark have been distributed in 2000-2004, but it is not clear that any were distributed in Canada. [Exhibits "F"- "J"]
- Tags displaying the Mark are attached to all of the Applicant's coiled corrugated plastic drainage tubing shipped into Canada. [Exhibit "K"]
- Adhesive-backed patches displaying the Mark are applied to the Applicant's dual-wall plastic drainage pipe shipped into Canada. [Exhibit "L"]

I note in passing that Ms. Van der Bill and her colleagues refer to both drainage pipe and drainage tubing. It is not clear to me what the differences are between pipe and tubing but the wares are identified in the application as pipe.

Byron Brouwer, the Applicant's Plant and Production Manager, informs us that, beginning on July 14, 2000, the Applicant has shipped over \$900,000 worth of corrugated plastic drainage pipe and tubing to customers in Canada in association with the Mark. As discussed below, these sales figures are corroborated by Messrs. Carlson and Duininck.

David Carlson, the Applicant's Regional Sales Representative for Manitoba and Ontario, provides more than 50 of the Applicant's catalogues annually to Canadian distributors for distribution. He also provides them with an unspecified number of other promotional materials. He attests that since at least as early as July 14, 2000, all of the Applicant's corrugated plastic drainage pipe or tubing has born the Mark. He provides computer printouts that set out the following Canadian sales figures: 2000 - approx. \$229,000; 2001 - approx. \$148,000; 2002 - approx. \$169,000; 2003 - approx. \$254,000. [Exhibit "A"]

James Duininck, the Applicant's Vice President of Sales, provides copies of invoices relating to the Applicant's sale of THE PIPE WITH THE GOLD STRIPE corrugated plastic drainage pipe and tubing in Canada for the years 2000-2003. The approximate sales volumes of these invoices are as follows: 2000 (post July 13) - \$100,384 US; 2001 - \$152,197 US; 2002 - \$255,083 US; 2003 (to November 30) - \$410,554 US. However, some of those sales relate to accessories to the pipe and tubing, as opposed to the pipe and tubing itself.

The test for confusion

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 specifically enumerated in s. 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks or trade-names 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 or trade-names 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.) and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401 (S.C.C.).]

I shall begin by assessing the likelihood of confusion between THE PIPE WITH THE STRIPE and THE PIPE WITH THE GOLD STRIPE.

s. 6(5)(a) - inherent distinctiveness of the marks and the extent to which each has become known
Neither party's mark is inherently strong as each is suggestive of the products that the party sells. However, the Opponent's mark, which is the senior mark, has a certain cadence and the fact that it is a catchy phrase increases its inherent distinctiveness. Of course, similar comments may be made with respect to the junior mark, given the high degree of resemblance between the two marks.

The Opponent's mark has been promoted and used but it is difficult to assess the extent to which this has increased its distinctiveness. There is somewhat more detailed information concerning the use and promotion of the Applicant's Mark and therefore I conclude that it appears to have acquired more distinctiveness through such means than has the Opponent's mark.

s. 6(5)(b) - the length of time each has been in use

The Opponent's registration claims use since 1980, resulting in its mark having been used for twenty years longer than the Applicant's Mark.

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

According to the Applicant's website, the Applicant provides drainage solutions for engineers, farmers, underground utility contractors, drainage contractors and distributors. [Exhibit "E", Van der Bill affidavit] The invoices provided include among the purchasers some companies that include the words "building products" in their names [see Duininck affidavit].

Mr. Carlson attests that the Applicant sells its corrugated plastic drainage pipe and tubing through its distributors and to building supply wholesalers, and also to Original Equipment Manufacturers; the building supply wholesalers sell the pipe to lumber yards, which in turn sell it to contractors. [paragraph 10] Mr. Lutes, the Opponent's Market development Manager, attests that it has sold its plastic pipe continuously since at least 1994 through the same channels of trade that Mr. Carlson says the Applicant uses. [paragraph 3]

The Opponent's website states that its products are "available in a variety of diameters... making it ideal for more applications:

- Waterwell tubing
- Irrigation systems
- Distribution and transmission of water
- Maple sap collection
- Electrical raceways
- Chemical process lines
- Mine tailing lines
- Ice skating rinks
- Swimming pools
- Geothermal heating systems"

[Exhibit "S", Massé affidavit]

However, when considering the wares, services and trades of the parties, it is the statement of wares or services in the parties' trade-mark application or registration that govern in respect of the issue of confusion arising under s. 12(1)(d) [*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.); *Miss Universe Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)]. Thus, it must be noted that the statement of services in the Opponent's registration is restricted to "operation of a business dealing in the manufacture, promotion and sale of plastic pipes and tubing for potable water distribution, and specifically excluding plastic pipes or tubing for gas distribution or underground fire-main service."

Statements of services 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. In this regard, evidence of the actual trades of the parties is useful, particularly where there is an ambiguity as to the wares or services covered in the application or registration at issue. [*McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (F.C.A.); *Procter & Gamble Inc. v. Hunter Packaging Ltd.* (1999), 2 C.P.R. (4th) 266 (T.M.O.B.); *American Optical Corp. v. Alcon Pharmaceuticals Ltd.* (2000), 5 C.P.R. (4th) 110 (T.M.O.B.)] As shown in Exhibit "P" of the Massé affidavit, the Opponent's marketplace services include the sale of pipes for agricultural, residential and business applications, and the statement of services in its registration is broad enough to encompass agricultural, residential and business applications.

Additional information provided by Ms. Massé concerning the Opponent's business and channels of trade is as follows:

- Since 1980, the Opponent and its predecessors have made and sold in Canada all types of plastic pipes, including corrugated and non-corrugated plastic pipe for sewage and drainage applications, industrial process applications, vent stacks and water sprinkler systems; the Opponent has the capability of making and selling any type of plastic pipe. [paragraph 29]
- Since 1980, the Opponent has sold plastic pipe to various pipe wholesalers, pipe and plumbing suppliers, plumbers, plumbing, electrical and building contractors. [paragraph 31]
- From at least July 14, 2000, the Opponent has sold plastic pipe through the same channels of trade and to the same wholesalers, pipe and plumbing suppliers, plumbers, plumbing, electrical and building contractors as has the Applicant. [paragraph 32]

Although the Applicant has submitted that the Opponent is not in the drainage business, I note that during the cross-examination of Mr. Lutes it was made clear that the Opponent does sell drainage pipe. Although such pipe does not currently bear a stripe, it did bear a yellow stripe in 1999. [See questions 232-237, 275-282 and answers provided to outstanding questions.] [Also see paragraph 29, Massé affidavit.]

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

There is a high degree of resemblance between THE PIPE WITH THE STRIPE and THE PIPE WITH THE GOLD STRIPE in appearance, sound and idea suggested.

other surrounding circumstances

i) settlement agreement

As a further surrounding circumstance, the Applicant relies on a settlement agreement that was signed in 2000 by the Opponent, the Applicant and two other corporations. The agreement concerned another Canadian trade-mark application owned by the Applicant, No. 757,110 for “a trade-mark comprising a gold stripe running longitudinally along the exterior surface of plastic tile and tubing product used for drainage purposes”. The agreement provided that the Opponent would withdraw with prejudice its opposition to application No. 757,110 and not object to the Applicant’s use and registration “of the GOLDSTRIPE Design trade-mark (comprising a gold stripe running longitudinally along the exterior surface of pipe or tubing) in Canada” subject to the following restrictions:

1. Use of any trade-mark comprising a stripe running longitudinally along the exterior surface of pipe or tubing (hereinafter referred to as a “STRIPE” trade-mark) by [the Applicant] is restricted to use of only the GOLDSTRIPE Design trade-mark. For clarification, in addition to its right as defined herein to use said mark upon its goods, [the Applicant] is entitled to illustrate in advertising and promotional material pipe or tubing bearing the GOLDSTRIPE Design trade-mark as defined above. Also for clarification, [the Applicant] may utilize other terms or designs in combination with the GOLDSTRIPE Design trade-mark, provided such terms and designs are not confusingly similar to any marks, terms or designs used by [the Opponent] prior to the adoption and use of said terms or designs by [the Applicant];
2. Use of the GOLDSTRIPE Design trade-mark by [the Applicant] is restricted to corrugated pipe and tubing composed of high density polyethylene no smaller than two inches in diameter and used for purposes of gravity drainage;

3. Use of any STRIPE trade-mark and illustration of pipe or tubing bearing the GOLDSTRIPE Design trade-mark in advertising and promotional material, by [the Applicant] shall not knowingly take place in British Columbia or Alberta and, to clarify, there shall be no deliberate use, illustration or advertising of any STRIPE trade-mark, including the GOLDSTRIPE Design trade-mark by [the Applicant] in British Columbia or Alberta. And to further clarify, this clause does not restrict [the Applicant] from advertising in association with the GOLDSTRIPE Design trade-mark in any trade journal or other publication which has a nation-wide circulation within Canada; and
4. [the Applicant] shall forthwith restrict the statement of wares covered by the Application [No. 757,110] to the specifics described in sub-paragraph (2) above and, in particular, the statement of wares shall be amended to read:

“corrugated plastic pipe and tubing composed of high density polyethylene no smaller than two inches in diameter and used for purposes of gravity drainage”.

[my underlines]

As pointed out by the Applicant, the Board has in the past considered settlement agreements such as the one in issue here as a surrounding circumstance in the assessment of the likelihood of confusion. [See *Mister Mechanic Inc. v. Pater International Automotive Franchising Inc.* (1996), 71 C.P.R. (3d) 275.]

It is the Applicant’s submission that the settlement agreement presents an insurmountable obstacle to the success of this opposition because it can only be interpreted as indicating that the parties’ gold striped pipes can co-exist based on the differences between their pipes. The Opponent naturally disagrees and I am of the view that the Applicant’s interpretation overlooks several important aspects of the settlement agreement. First, the settlement agreement does not deal with the word marks that are at issue here. As evidenced by the Applicant’s own affiant, pipes bearing stripes (even gold/yellow stripes) are sold by a number of parties. There is however no evidence that others use word marks that are similar to THE PIPE WITH THE STRIPE or THE PIPE WITH THE GOLD STRIPE. Second, the agreement restricts the Applicant’s use of the GOLDSTRIPE Design mark to “corrugated plastic pipe and tubing composed of high density

polyethylene no smaller than two inches in diameter and used for purposes of gravity drainage”. [my underlines] The underlined restrictions are not present in the present application’s statement of wares, which simply reads, “corrugated plastic gravity flow drainage pipe used in non-pressurized applications”. Third, the settlement agreement prohibits the Applicant from knowingly using any stripe trade-mark in British Columbia or Alberta. The present application contains no such geographic restriction. Thus, at most, I find that this settlement agreement indicates that the Opponent was prepared to have its striped pipes co-exist with certain gold-striped pipes of the Applicant in certain parts of the country. I do not see how such an agreement resolves the question of whether there is a likelihood of confusion between somewhat different pipes when associated with different trade-marks, across Canada.

The Applicant made submissions concerning the fact that Mr. Lutes was instructed by counsel during his cross-examination to not answer any questions about the settlement agreement, but I am not prepared to hold this against the Opponent for the simple reason that the settlement agreement was not in evidence as of the date of the cross-examination. The agreement was only introduced into evidence by means of the Groen affidavit pursuant to r. 44(1) after the cross-examination of Mr. Lutes.

ii) evidence of third party use or promotion of similar marks

Khadija Mahmood is a lawyer employed by the firm that is representing the Applicant. His affidavit is largely directed to evidence that he has located on the Internet concerning other parties that use coloured stripes on various types of piping. However, the issue here is not whether the use of a coloured stripe (such as a gold stripe) on pipe would cause confusion but whether the use of the words THE PIPE WITH THE GOLD STRIPE would cause confusion. I note that there is no evidence that any other party uses similar wording in association with pipes.

iii) family of marks

The Opponent has claimed that it owns a family of marks but I agree with the Applicant that no relevant family has been proven.

iv) inclusion of Opponent's second mark

The Opponent points out that the Applicant's Mark includes the Opponent's GOLD STRIPE mark in its entirety. There are a number of Board decisions where the fact that an opponent employed two marks, each comprising one half of an applicant's mark, was treated as a significant surrounding circumstance [see *Mini Togs Inc. v. Siebruck Hosiery Ltd.* (2000), 7 C.P.R. (4th) 153 (T.M.O.B.); *Truefoam Ltd. v. Nova Perma Coating Ltd.* (1985), 2 C.P.R. (3d) 128; *Dataline Inc. v. Dyonix Greentree Technologies* (1989), 24 C.P.R. (3d) 378; *Data Accessories Corp. v. Dainolite Ltd.* (1994), 51 C.P.R. (3d) 538].

Conclusion

It is clear from the evidence that the Opponent cannot monopolize the use of a coloured stripe on a pipe. However, the issue at hand is much narrower. The Applicant submits that the Opponent must suffer the consequences of choosing a mark as weak as THE PIPE WITH THE STRIPE and I acknowledge that such mark is not entitled to much of a scope of protection, especially given the very limited evidence concerning its use. I am not however satisfied that it is not entitled to a scope of protection that is broad enough to prevent the registration of THE PIPE WITH THE GOLD STRIPE for the wares covered by this application. The Applicant, as junior user, could well have chosen other phrases to adopt, rather than mimicking the mark which was in use in association with the business of a known competitor. I find that an individual with an imperfect recollection of the Opponent's THE PIPE WITH THE STRIPE mark as associated with the Opponent's pipe-related business would be likely to conclude, as a matter of first impression, that pipes sold in association with the mark THE PIPE WITH THE GOLD STRIPE emanate from the same source. I am not satisfied that the differences in the parties' pipes are sufficient to prevent such a conclusion.

Distinctiveness Ground of Opposition

The Opponent has pleaded that the Mark does not, and is not adapted to, distinguish the wares of the Applicant from the wares and services of the Opponent.

An opponent meets its evidential burden with respect to a distinctiveness ground if it shows that as of the filing of the opposition its mark(s) had become known sufficiently to negate the

distinctiveness of the applied-for mark. [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.); *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.); and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)] Although we have Ms. Massé's uncontroverted statement that both THE PIPE WITH THE STRIPE and GOLD STRIPE have been in continuous use since 1980, I find that the Opponent has not met its evidential burden. The last item showing use of GOLD STRIPE was dated 1996, almost 6 years before the material date. Although there is evidence of use of THE PIPE WITH THE STRIPE both before and after the material date, a gap of 7 years, between 1996 and 2003, exists in this evidence. This gap, combined with the lack of evidence of the extent to which THE PIPE WITH THE STRIPE was used as of June 7, 2002 makes it unclear that either of the Opponent's marks had acquired sufficient reputation as of June 7, 2002 to affect the distinctiveness of the Applicant's Mark.

The distinctiveness ground of opposition therefore is dismissed on the basis that the Opponent has not satisfied its initial burden.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the application pursuant to s. 38(8).

DATED AT TORONTO, ONTARIO, THIS 12th DAY OF FEBRUARY 2008.

Jill W. Bradbury
Member
Trade-marks Opposition Board