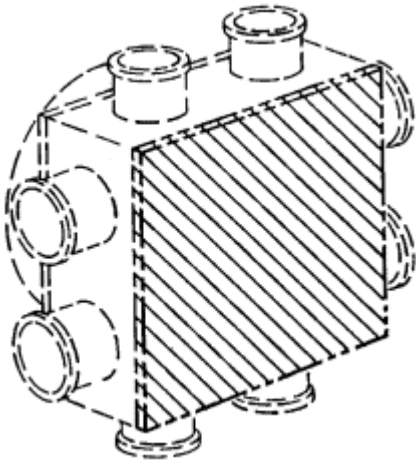


**IN THE MATTER OF AN OPPOSITION by The
Lamson & Sessions Co. to application No.
1,094,353 for the trade-mark Junction Box Design
(blue) in the name of Royal Group, Inc.**

On February 28, 2001, Royal Group Technologies Limited d.b.a. Royal Pipe Company filed an application to register the trade-mark Junction Box Design (blue) [the “Mark”]. The Mark is shown in the drawing below. The Mark consists of the colour blue applied to a face plate of a junction box. The drawing is lined for the colour blue.



The application is based upon proposed use of the Mark in Canada in association with electrical junction boxes.

The application is currently in the name of Royal Group, Inc. and the term “Applicant” will be used to refer to both Royal Group Technologies Limited d.b.a. Royal Pipe Company and Royal Group, Inc.

The application was advertised for opposition purposes in the Trade-marks Journal of January 14, 2004. On June 14, 2004, The Lamson & Sessions Co. [the “Opponent”] filed a statement of opposition. The grounds of opposition are summarized below:

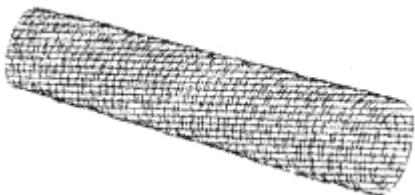
1. The application does not comply with s. 30(i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 [the “Act”] in that the Applicant could not have been satisfied that it is entitled to use the Mark in Canada in association with the Applicant’s wares for all the reasons stated in the statement of opposition.

2. The Mark is not registrable under s. 12(1)(d) of the Act because the Mark is confusing with the Opponent’s registered trade-mark Pipe Design, TMA 392,859.

3. The Applicant is not the person entitled to registration of the Mark under s. 16(3) of the Act because, at the date of filing of the application, the Mark was confusing with the Opponent’s registered trade-mark Pipe Design and its trade-mark Box Design (blue) [collectively the “Opponent’s Trade-marks”], both of which had been previously used in Canada by the Opponent in association with “plastic tubing used to contain electrical conductors in electrical systems installed by contractors”.

4. The Applicant’s Mark is not distinctive because it does not actually distinguish and is not adapted to distinguish the Applicant’s wares from the wares and services of others including the wares of the Opponent because it is confusing with each of the Opponent’s Trade-marks.

The registered Pipe Design mark relied upon by the Opponent is shown below:



The drawing is lined for the colour blue and the registration states, “The representation of the wares shown in dotted outline does not form part of the trade-mark.” The registration issued in 1992 based on use and registration of the mark in the United States of America in association

with plastic tubing used to contain electrical conductors in electrical systems installed by contractors.

A depiction of the Opponent's Box Design (blue) mark appears below under my discussion of the Whaley Affidavit.

The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

In support of its opposition, the Opponent filed the affidavits of Steven Randall Whaley and Jeffrey Charles Williams. The Applicant obtained an order for the cross-examination of Mr. Whaley and a copy of the transcript of the cross-examination has been filed.

The Applicant elected to not file any evidence.

Each party filed a written argument.

The Applicant originally requested an oral hearing, but subsequently withdrew its request.

Onus and Material Dates

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

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

- s. 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- 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) - the filing date of the application [see s. 16(3)];
- non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

Summary of Evidence

Whaley Affidavit

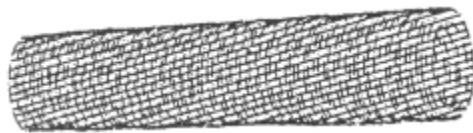
Mr. Whaley is the Canadian/International Sales Manager of the Carlon division of the Opponent. The Opponent is an American company that has a long history. At present, it claims to be “a leading producer in North America of thermoplastic conduit, enclosures, wiring devices and accessories for the construction, consumer, power and communications markets, and large diameter pipe for wastewater markets.” It has three primary business divisions, the largest being the Carlon division. The Carlon division “provides electrical and telecommunications raceway systems, non-metallic enclosures, outlet boxes and electric fittings to the electrical and telecommunications infrastructure markets.”

Mr. Whaley attests that the Opponent “has used a blue colour mark in Canada in association with electrical nonmetallic tubing (ENT), ENT fittings, ENT boxes and Zip boxes (collectively, the ‘Blue Products’)” and that some of these Blue Products were first offered in Canada at least as early as 1985.

Mr. Whaley refers to three blue trade-marks of the Opponent. The first is the Pipe Design (blue) mark that is the subject of registration No. TMA 392,859. The second is the Box Design (blue) mark that he says has been used in Canada in association with electrical outlet boxes and parts since at least as early as 1985. As Exhibit B, he provides a certified copy of Canadian trade-mark application No. 1,210,120, which he says relates to the Box Design (blue) mark. The mark that is the subject of application No. 1,210,120 is described as the colour blue applied to the entire surface of an electrical outlet box, and is shown below:



Mr. Whaley identifies a third blue trade-mark of the Opponent, namely the colour blue applied to the entire surface of plastic tubing used to contain electrical conductors in electrical systems installed by electrical contractors. It is the subject of application No. 1,210,121 and is shown in the following drawing:



It is noted that the statement of opposition referred to only two marks of the Opponent; however, I cannot discern a difference between the first and third marks identified in Mr. Whaley's affidavit and conclude that, although each is the subject of a separate application/registration, they are one and the same mark.

Mr. Whaley has provided copies of the following materials:

- Exhibit D: samples of Carlon advertisements for Blue Products used by the Opponent in the Canadian market;
- Exhibit E: a 1993 brochure of the Opponent's Carlon Canadian products that was distributed to all of Lamson's Carlon customers in Canada;
- Exhibit F: a 1995 brochure for Flex-Plus Blue ENT, Fittings and Accessories that was distributed to all of Carlon's customers in Canada;
- Exhibit G: a 1996 brochure of Zip Box Blue Nonmetallic Switch and Outlet Boxes that was distributed to all of Carlon's customers in Canada;
- Exhibit H: a 1998 Canadian price guide, which pictures some of the Opponent's Blue Products including its blue-coloured mud boxes (that are sometimes referred to as "junction boxes") and blue-coloured tubing – the price guide was distributed to all of Carlon's customers in Canada;

- Exhibit I: a 1999 brochure of Carlon ENT, Fittings and Accessories that was distributed to all of Carlon's customers in Canada;
- Exhibit J: a 2000 Canadian Price Guide Accessories that was distributed to all of Carlon's customers in Canada, and which shows some of the Opponent's Blue Products including its blue-coloured mud boxes and blue-coloured tubing;
- Exhibit K: a 2001 brochure for Carlon Communication Zip Boxes that was distributed to all of Carlon's customers in Canada;
- Exhibit L: a 2002 Carlon ENT Application Handbook that was distributed to all of Carlon's customers in Canada;
- Exhibit M: a 2004 publication entitled "Wiring: Complete Projects for the Home" that displays some of Carlon's blue non-metallic products (however there is no claim that this publication has been circulated in Canada);
- Exhibit N: Carlon product information and brochures that were to be released to its Canadian customers within a few months of April 2005.

Mr. Whaley has provided a chart setting out details of some of the advertising placed for the Opponent's Blue Products in publications that circulated to Canadians in 1999, 2001, 2004 and 2005. The chart lists 5 publications that carried ads prior to February 28, 2001, at a total cost of approximately \$20,000. Prior to June 14, 2004, the total cost of advertisements was approximately \$137,000; by April 2005, the total was approximately \$195,000.

Mr. Whaley has also provided a chart setting out the Canadian sales figures for the Opponent's Blue Products from 1997 to March 17, 2005, broken down by month and product. As of February 28, 2001, the Opponent had sold approximately 1,721,000 feet of its blue-coloured tubing and 29,095 blue-coloured boxes; these figures rose to 4,309,00 and 94,000 respectively by June 14, 2004 and to 5,197,736 and 109,356 respectively by March 2005.

Williams Affidavit

Mr. Williams was an articling student at the law firm that is representing the Opponent. He has provided two books about wiring that he purchased in Toronto on March 14, 2005.

Preliminary Issue re Pleadings

In its written argument, the Applicant has submitted that because the statement of opposition does not define the Opponent's Box Design (blue) mark, the grounds of opposition that purport to rely upon confusion with any mark other than the Opponent's registered Pipe Design (blue) mark ought to be dismissed on the basis that they are not proper grounds of opposition in that they did not specify sufficient detail to enable the Applicant to reply thereto.

It is difficult for me to accept the Applicant's argument given that it did in fact file a counter statement that replied to all of the grounds of opposition. Moreover, the statement of opposition is to be read in conjunction with the evidence [*Novopharm Ltd. v. AstraZeneca AB et al.* (2002), 21 C.P.R. (4th) 289 (F.C.A.)] and I find that it is clear from Mr. Whaley's affidavit that the Opponent's Box Design (blue) mark is the mark shown in Exhibit B to his affidavit. I am accordingly not dismissing any grounds on the basis that they were insufficiently pleaded.

Non-distinctiveness Ground of Opposition Based on Opponent's Box Design (blue) Mark

Although each of the grounds is premised on the likelihood of confusion between the parties' marks, I consider the distinctiveness ground of opposition to present the Opponent's strongest case, so I will address it first. Furthermore, since I consider the Opponent's position with respect to its Box Design (blue) mark to be strongest, I will focus my discussion on the likelihood of confusion between the Applicant's Mark and the Opponent's Box Design (blue) mark.

In order to meet its initial burden with respect to this ground, the Opponent need only show that its Box Design (blue) mark was "known to some extent at least" as of June 14, 2004. [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.) at 58] I find that the Opponent has met this initial burden based on the evidence of promotion of the mark and sales of the marked product prior to the material date. [See for example paragraph 11 and Exhibit E, Whaley affidavit.]

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 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.).]

s. 6(5)(a) - inherent distinctiveness of the marks and the extent to which each has become known
Marks comprised solely of colour are not inherently distinctive [see *AstraZeneca AB v. Novopharm Ltd.* (2003), 24 C.P.R. (4th) 326 (F.C.A.) at paragraph 18]. However, any mark may acquire distinctiveness through use and promotion.

The Applicant's Mark is inherently weak and there is no evidence that it had become known as of the material date of June 14, 2004.

The Opponent's mark is also inherently weak but there is evidence that it had been used and promoted as of the material date.

Thus, consideration of the extent to which each mark has become known favours the Opponent.

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

This factor clearly favours the Opponent as it claims use of its mark in Canada since as early as 1985 and has provided sales figures relating to boxes sold in association with its mark since

1997. In contrast, the Applicant filed its application in 2001 on the basis of proposed use.

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

In his affidavit, Mr. Whaley attested that the major customers of the Opponent's Carlon division include electrical contractors and distributors, original equipment manufacturers, electric power utilities, cable television, telephone and telecommunications companies. During cross-examination, Mr. Whaley attested that in Canada the Opponent and the Applicant are competitors in the making of slab boxes (Question 77, Whaley cross-examination). On page 20 of the promotional materials provided as Exhibit N to the Whaley affidavit, the Applicant's Mark appears in a chart entitled "Competitive Cross Reference ENT Mud Box Assemblies". Mr. Whaley has also attested that the Opponent's blue-coloured mud boxes are sometimes referred to as "junction boxes" (paragraph 20, Whaley affidavit), that slab boxes are "junction boxes" (Question 32, Whaley cross-examination), that a slab box or a mud box is for use in construction of slab floor construction (Question 180, Whaley cross-examination), that the same wiring cables go into a junction box and a slab box (Question 185, Whaley cross-examination) and that a junction box can be used in concrete (Question 189, Whaley cross-examination).

The parties' wares are similar if not identical, given that they are a type of electrical box. Since the parties are in competition, in the absence of evidence to the contrary, it is fair to assume that the nature of their businesses and their channels of trade are similar and overlap.

Overall, the factors to be considered under s. 6(5)(c) and (d) favour the Opponent.

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

Given that both parties' marks consist of the colour blue applied to a product, I conclude that this factor also favours the Opponent.

During the cross-examination of Mr. Whaley and in its written argument, the Applicant referred to the Applicant's wares as being two-toned. However, I agree with the Opponent that the application at issue is not for a two-tone mark. It is simply for the colour blue.

other surrounding circumstances - lack of evidence of confusion

At page 16 of its written argument, the Applicant submits, “The applicant has started selling the subject wares in connection with the subject marks, and has a ‘significant share’ of the market for slab boxes, and yet no instances of actual confusion has been submitted in evidence.” It relies on Questions 96-112 of the cross-examination of Mr. Whaley in this regard. For the following reasons, I do not consider the lack of evidence of confusion to be a significant factor:

- the selling of the Applicant’s wares postdates the material date;
- the extent of sales of the Applicant’s wares in association with the applied for Mark is unknown;
- although Mr. Whaley’s evidence was that the Applicant has a significant share of the market for slab boxes, he did not say that the Applicant uses the applied for Mark in association with such boxes.

The jurisprudence indicates that it is not necessary for an opponent to evidence confusion in order to succeed with respect to a ground of opposition that alleges confusion, but that an adverse inference may be drawn from the lack of such evidence in certain circumstances. However, such an adverse inference is typically only drawn in cases where there has been lengthy or significant concurrent use [See *Christian Dior S.A. v. Dion Neckwear Ltd.* (2002), 20 C.P.R. (4th) 155 (F.C.A.).] In the present case, the evidence does not support the drawing of an adverse inference.

conclusion regarding likelihood of confusion

Having considered all of the surrounding circumstances, I find that the Applicant has not met its legal burden to show that on a balance of probabilities there was not a reasonable likelihood of confusion between its Mark and the Opponent’s Box Design (blue) mark as of June 14, 2004. As a result, I find that the distinctiveness ground of opposition succeeds on this basis.

I note that the Opponent has submitted in its written argument that the Mark is not distinctive because marks comprised of colour alone are not viewed as inherently distinctive and there is no

evidence that the Mark had acquired distinctiveness as of the material date. However, I read the distinctiveness ground as pleaded as being restricted to the issue of confusion.

Section 16(3) Grounds of Opposition

In order to meet its initial burden under s. 16, the Opponent must establish use of its marks in Canada prior to February 28, 2001, as well as non-abandonment of its marks as of January 14, 2004.

The Opponent has shown prior use and non-abandonment of its two pleaded marks in Canada. However, it pleaded prior use of both marks only in association with “plastic tubing used to contain electrical conductors in electrical systems installed by contractors” and the evidence indicates that only the Opponent’s Pipe Design (blue) mark was used in association with such wares. Therefore, I find that the Opponent has only met its initial burden under s. 16(3) with respect to its Pipe Design (blue) mark and I will restrict my s. 6(5) analysis to that mark.

Although I am dealing with a different mark of the Opponent in this analysis, much of my analysis above under the distinctiveness ground based on the Box Design (blue) mark applies *mutatis mutandis*. I will therefore only add comments where the circumstances differ significantly from those in my earlier analysis.

s. 6(5)(a) - inherent distinctiveness of the marks and the extent to which each has become known
This factor favours the Opponent for the reasons set out earlier.

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

This factor clearly favours the Opponent as it claims use of its mark in Canada since as early as 1990 and has provided sales figures relating to tubing sold in association with its mark since 1997. In contrast, the Applicant filed its application in 2001 on the basis of proposed use.

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

The parties’ wares are related in that they are both wares used in electrical systems and they would be installed together. In the absence of evidence to the contrary, it is fair to assume that the

nature of the parties' businesses and their channels of trade are similar and overlap.

Overall, the factors to be considered under s. 6(5)(c) and (d) favour the Opponent.

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

This factor favours the Opponent for the reasons set out earlier.

other surrounding circumstances - lack of evidence of confusion

For the reasons set out earlier, I do not consider the lack of evidence of confusion to be a significant factor and the evidence does not support the drawing of an adverse inference.

conclusion regarding likelihood of confusion

Even though the wares at issue under this ground are not as similar as those under the distinctiveness ground of opposition, bearing in mind that the onus is on the Applicant, I am not satisfied that as of February 28, 2001 there was not a reasonable likelihood of confusion as to the source of the Pipe Design (blue) plastic tubing used to contain electrical conductors in electrical systems installed by electrical contractors and the Junction Box Design (blue) electrical junction boxes. After all, each of the circumstances set out in s. 6(5) favours the Opponent and there is no evidence that anyone else in the electrical industry sells blue-coloured wares. The s. 16(3) ground of opposition is therefore successful based on the prior use of the Opponent's Pipe Design (blue) mark.

Non-distinctiveness Ground of Opposition Based on Opponent's Pipe Design (blue) Mark

For reasons similar to those set out in my discussion of the s. 16(3) ground of opposition, I conclude that the Applicant has also not met its legal burden with respect to the distinctiveness ground of opposition as based on the Pipe Design (blue) mark. The distinctiveness ground accordingly also succeeds on this basis.

Remaining Grounds of Opposition

As I have already found in favour of the Opponent under more than one ground, I will not address the remaining grounds of opposition.

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) of the Act.

DATED AT TORONTO, ONTARIO, THIS 21st DAY OF JULY 2008.

Jill W. Bradbury
Member
Trade-marks Opposition Board