



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

Citation: 2014 TMOB 11
Date of Decision: 2014-01-20

**IN THE MATTER OF AN OPPOSITION
by Ebel Quarries Inc. to application
No. 1,493,710 for the trade-mark
ALGONQUIN in the name of Owen
Sound Ledgerrock Limited**

[1] Ebel Quarries Inc. (the Opponent) opposes registration of the trade-mark ALGONQUIN (the Mark) that is the subject of application No. 1,493,710 by Owen Sound Ledgerrock Limited (the Applicant).

[2] The application was filed on August 26, 2010 and is based on use of the Mark in Canada since at least as early as January 1996 in association with:

dimensional and natural stone products for building, landscaping, masonry, tile, and paving namely wall stone, window sills, copings, treads, door sills, stone carvings and mouldings, stone tiles, stone blocks, facing stones and panels for buildings, patio stones and path slabs, paving stones, paving tiles and paving blocks (the Wares).

[3] The Opponent alleges that the application does not comply with the requirements of section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) in that the Mark has not been continuously in use as a trade-mark, in the ordinary course of trade, in association with the Wares, since the alleged date of first use, and that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada. The Opponent also alleges that the Mark is not registrable under section 12(1)(c) of the Act as it is the name, in English, of the Wares, and under section 12(1)(b) of the Act as it is clearly descriptive or deceptively misdescriptive of the character or quality of the Wares or of their place of origin. Finally, it alleges that the Mark is not

distinctive under section 2 of the Act as it does not actually distinguish, nor is it adapted to distinguish, the Wares of the Applicant from the wares of others.

[4] For the reasons that follow, the application ought to be refused.

The Record

[5] The Opponent filed its statement of opposition on August 12, 2011. The Applicant then filed and served its counter statement essentially denying all of the grounds of opposition alleged in the statement of opposition.

[6] In support of its opposition, the Opponent filed the affidavit of Mark Ebel, Vice President and part owner of the Opponent, sworn on February 15, 2012; and the affidavit of Andrew Negus, President and CEO of Block and Stone Resource Group Inc. (BSRG), sworn on February 17, 2012.

[7] In support of its application, the Applicant filed the affidavit of Michael I. Gauthier, Human Resources Manager and Sales and Marketing Manager of the Applicant, sworn on June 14, 2012; the affidavit of Thomas Stobbe, majority owner and President of the Applicant, sworn on June 6, 2012; the affidavits of William Chamberlain and Charles Laviolette, former employees of the Opponent, both sworn on June 6, 2012; the affidavit of Siamak Hariri, one of the founding partners of Hariri Pontarini Architects, sworn on June 15, 2012; and the affidavit of Wendy (O'Brien) Gaudet, President of OSI Hard Surfaces Inc., sworn on June 19, 2012.

[8] Both parties filed written arguments; a hearing was not held.

The Parties' respective burden or onus

[9] The legal onus is on the Applicant to show that its application does not contravene the provisions of the Act as alleged in the statement of opposition. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from

which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA); and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FC)].

Overview of the parties' evidence

[10] In view of the abundance of evidence presented in this proceeding, it is helpful to begin with an overview of the testimonies at the outset of my decision. In considering the evidence, I am setting aside any statements that amount to an affiant's personal opinion on questions of fact and law that are to be determined by the Registrar in this case. Moreover, I am not prepared to accept any of the affidavits as expert evidence as none of the affiants possesses the necessary independence from the parties on the outcome of this case [see *Black Entertainment Television, Inc v CTV Limited* (2008), 66 CPR (4th) 212 (TMOB)]. I will also point out some of the issues raised by the parties throughout the overview.

The Opponent's evidence

The Ebel affidavit

[11] Mr. Ebel states that the Opponent owns and operates a stone quarry located in Wiarton, at the southern end of the Bruce Peninsula in Ontario, not far from the Applicant's quarry. He further states that the Opponent's quarry lies in a "unique geological district which is dissected by a broad basement ridge known as the 'Algonquin Arch'". To this end, he attaches as Exhibit "A" to his affidavit an article from the Ontario Ministry of Northern Development and Mines' website on the geology of the Southwestern Ontario District, including a map of the area with a reference to the "Algonquin Arch". I note that Mr. Ebel's statement on the exact location of the Opponent's quarry in relation to the "Algonquin Arch" is challenged by the evidence put forth by the Applicant, as set out in the following section.

[12] In terms of the Opponent's business, Mr. Ebel states that it extracts and processes dimensional and landscaping stones for indoor and outdoor use including pavers, copings and block stones. Its clients include landscape architects, landscapers, home owners and builders.

According to Mr. Ebel, the Opponent has been using the term “Algonquin” as a stone description for over 14 years to describe a particular type of limestone extracted from the Opponent’s quarry that is located between the Riada and Eramosa layers found only in Ontario. In this regard, Mr. Ebel attaches as Exhibit “B” eight invoices issued by the Opponent to the Applicant, dated between June 2001 and November 2002, for products described as “Algonquin Blocks” and “Algonquin Pcs”. The invoices represent sales in excess of \$25,000 of “Algonquin” stone products. I note that one of the Applicant’s affiants, Mr. Gauthier, also makes reference to these invoices in his affidavit, purporting to put these transactions into a different context. I will discuss Mr. Gauthier’s testimony in further detail in the following section.

[13] Mr. Ebel also attaches as Exhibit “C” to his affidavit over 50 invoices issued by the Opponent to third parties whose names and street addresses have been either completely or partially redacted, dated between June 2007 and December 2011. More particularly, the invoices with partially redacted addresses were issued to entities located in different areas of Ontario such as Kemble, Mississauga, Schomberg, Huntsville, Thornhill, York, and Toronto, for sales of stone products in different quantities. While the sales figures have also been redacted, I note that the quantities of stone products sold vary between one single piece of 6.25 square feet, to more than 900 pieces, representing over 2,500 square feet of stones. The invoices contain various product descriptions with the term “Algonquin”, including:

- “Algonquin Sawn Slab”
- “Algonquin Slabs”
- “Algonquin S6S”
- “Sand Blasted Algonquin”
- “Algonquin”
- “Rustic Algonquin Sand Blasted Cut Flagstone”
- “Sand Blasted Top Algonquin”
- “Algonquin Coping”
- “Algonquin Sand Blasted Pavers”
- “Honed Algonquin Limestone”

[14] As for the remaining items listed on these invoices, some products are described as “Beige ‘A’ Cut Flagstone”, “Beige Broken Flagstone”, “Beige Rustic Cut Flagstone”, “Beige Cobblestone”, “Beige Wiarthon Random Slabs”, “Eramosa Sawn Slabs”, and “Eramosa Slabs”. Others appear to specifically reference the Opponent by name, for instance “Ebel Cut Flagstone”, “Ebel Steps G3S”, and “Beige Ebel Banding”.

[15] The Applicant argues that these invoices do not show use of “Algonquin” as a descriptive term. Rather, it contends that they suggest only that the term is “used by [the Opponent] to identify a particular product”. I will return to this point below when assessing the non-distinctiveness ground of opposition.

[16] As evidence of use of the term “Algonquin” by others, Mr. Ebel states that the Opponent often receives inquiries from customers regarding “Algonquin” stone. Attached as Exhibit “D” to his affidavit are seven sample email exchanges between himself, acting on behalf of the Opponent, and customers whose names have been redacted, dated between September 2011 and January 2012, confirming orders of various “Algonquin” stone products in specific measurements. The orders vary between one single piece of 30” x 30” “Algonquin sandblasted” stone to an “Algonquin order” for a total of 5,400 square feet of stones. The Applicant argues that these emails do not show independent usage of the term “Algonquin” by third parties. Rather, it contends that they simply confirm the Opponent’s usage of the term with its customers. Still, these emails show that third parties were ordering and purchasing stone products known as “Algonquin” from the Opponent in relatively large quantities.

[17] On that same topic, Mr. Ebel states that landscape designers, architects and other project designers also use the term “Algonquin” descriptively in their specifications for a particular project if that is the type of stone they want for a job. He further states that other quarries and stone distributors also use the term “Algonquin” to describe a stone type. Attached as Exhibits “E”, “F” and “G” to his affidavit are printouts from websites purporting to show use of the term “Algonquin” as a type of stone by the Applicant, the Ontario Ministry of Northern Development and Mines, and other traders. More particularly, these exhibits include:

1. Printouts from the Applicant’s website dated February 14, 2012 with the following information:

Algonquin Limestone with a honed finish displays warm neutral ‘earthy’ tones. Light brown-beige with a subtle fleuri pattern. This stone is indigenous to the Warton, Ontario, Canada region and is not known to exist anywhere else throughout the world. Honed Algonquin is generally used in interior applications while the sandblasted and smooth sanded finishes are popular choices for exterior cladding and cut stone masonry.

The printouts also include six photos of the stone with information such as its description, its colour, its finishes, its applications, its products, its maximum

- measurements, as well as the test results such as measurements for absorption and abrasion resistance. Upon review of the printouts, it is not entirely clear whether the Applicant is using the term “Algonquin” in a trade-mark sense or in a descriptive sense to identify a type of stone that it is promoting;
2. Printouts from the Ontario Ministry of Northern Development and Mines’ website at www.mndm.gov.on.ca with photos of stones identified as “Algonquin Blue Granite” and “Algonquin Limestone”. The printouts also contain test results for “Algonquin Limestone” such as measurements for absorption and abrasion resistance;
 3. Information on a church building project in Lagrangeville, New York, that involved the use of Arriscraft stone products by a company called Consolidated Brick. One of the materials used in the project is described as “Citadel Building Stone – Algonquin Blend”. Without any context to this document, I agree with the Applicant that it appears to reference use of “Algonquin” blend stones by one entity for a project in the United States. Thus, it does not appear to provide any information regarding the use of the term “Algonquin” in the Canadian marketplace;
 4. Printouts dated February 4, 2012 from a website identified as a natural stone database named Graniteland.com with the following definition: “Algonquin Limestone is a grey Limestone from Canada. In natural stone trade, Algonquin Limestone is often simply called a Granite”. The printouts also include a photo of the stone with information such as the stone name (Algonquin Limestone), its pseudonym (Calcaire Algonquin), its main color (grey), its country of origin (Canada), its classification (limestone), its texture (fine) and its applications. There are also ads for renovation projects as well as links to third party suppliers of Algonquin Limestone identified as “WiarionLimestone.com” and “TPS Stone Co., Limited”;
 5. Similar to Graniteland.com, printout dated February 14, 2012 from a website named Stone-Installer Beta at www.stone-installer.com contains basic information on “Algonquin Limestone”, including a photo of the stone, its most common name (Algonquin Limestone), its trade names (Algonquin Limestone and Calcaire Algonquin), its simplified type (marble-like), its primary texture (fine grained), and the country of quarry (Canada). There are no links to third party ads; and

6. Printouts dated February 9 and 14, 2012 from websites identified as AlgonquinLimestone.com, EramosaLimestone.com and RiadaLimestone.com. One website in particular, EramosaLimestone.com, refers to WiarntonLimestone.com (previously mentioned as a third party supplier in the trade directory printouts of Graniteland.com) as the main site. These appear to be websites that promote various stone products, including Algonquin stones. The printouts contain little information except for the same 1-800 number, suggesting that they are connected to the same entity, and a contact form for purchase requests and questions.

[18] As I understand its submissions, the Applicant contends that the last three printouts described above under items 4-6 appear to be extracted from non verifiable third party websites of unknown origins with no clear connection to Canada. Thus, the information is unreliable and should be considered hearsay evidence. I agree. None of these websites appears to be specific to Canada. Furthermore, the authoritative value of these websites, if any, cannot be ascertained. As stressed by the Applicant, these websites appear to compile information provided by others as opposed to being either an independent operation or one carefully analysing and portraying information received. In fact, these printouts appear to be no more than links on the Internet to entities that sell various stone products without any context. As such, they cannot be relied upon as evidence of the truth of their contents.

The Negus affidavit

[19] Prior to establishing BSRG in April 2008, Mr. Negus said to have worked with the Applicant for 11 years. Mr. Negus states that BSRG quarries and processes many different types of limestone on its property, including “Algonquin limestone”, in Wiarnton, Ontario. It has also been purchasing, marketing and selling “Algonquin” and other types of limestone from the area since its inception.

[20] Regarding the use of the term “Algonquin”, Mr. Negus states that it has been used to describe a particular type of stone located in the Guelph unit of the middle Silurian stone formation in the industry prior to 1997. However, no documentary evidence has been brought forward by the affiant in support of this assertion. Thus, Mr. Negus’ mere statement does not

allow me to determine the extent to which the term “Algonquin” was used as a descriptive term “in the industry” at that given point in time.

[21] Mr. Negus states that BSRG’s customers and suppliers also use the term “Algonquin” to describe a type of stone in their business documents including invoices, purchase orders, packing slips, price requests, etc. He further states that since 2008, BSRG has purchased “Algonquin limestone” for processing from several local suppliers including the Opponent, Hiltz Marble and Granite Inc., as well as York Marble Tile and Terrazzo Inc. and has resold these products as “Algonquin limestone”. In support of his assertions, Mr. Negus attaches as Exhibit “A” to his affidavit six sample copies of email exchanges between himself, acting on behalf of BSRG, and clients whose names have been redacted, dated between February 2010 and October 2011. The emails discuss the availability of “Algonquin limestone”, “Black limestone”, “Dark grey limestone”, and “Granite slab”, for various quantities (from 180 to 10,000 square feet of stone products). Similarly, produced as Exhibits “B” and “C” are copies of two project plans of the same “wall panel” project dated July 23, 2008, one prepared by BSRG and the other by a client whose name has been redacted. The material identified on the plans is “Algonquin”.

[22] The Applicant argues that these emails do not evidence the term “Algonquin” being used in an “obviously descriptive” manner, and that Mr. Negus’ testimony is completely consistent with showing “the [Applicant’s Mark] being ‘borrowed’ by others”. More particularly, the Applicant argues that these emails show the term “Algonquin” alongside other registered marks of the Applicant, namely SENESUN of registration No. TMA810,647. However, the Applicant did not evidence this alleged registration [see *Unitron Industries Ltd v Miller Electronics Ltd* (1983), 78 CPR (2d) 244 at 253]. Also, even if the term “Algonquin” was indeed used as a trademark rather than as a descriptive term, these emails still show that clients were requesting stone products known as “Algonquin” from another stone trader in the industry besides the Applicant in 2008, 2010 and 2011, whether the use was “borrowed” or not. I will return to this point below when assessing the non-distinctiveness ground of opposition.

The Applicant's evidence

The Gauthier affidavit

[23] Mr. Gauthier first provides an overview of the Applicant's business with respect to the origin of the "Algonquin" stone. He states that the Applicant began quarrying from a particular layer of beige/brown coloured dolostone in the Warton region found 15 to 25 feet below the surface "in 1995-1996". According to Mr. Gauthier, the Applicant was the only company to have the equipment to quarry deep enough to extract this band of stone at that time. While distinct layers of stone found in the Guelph/Eramosa member formation can be differentiated by their colour and patterning, Mr. Gauthier states that there is no accepted geological name or term given to each stone layer. For that reason, the Applicant began to use the term "Algonquin" "to describe the buff/beige to brown band of stone" and "adopted the term to describe [its] stone" at the suggestion of one of its employees, Mr. Laviolette, "in 1995-1996". The affiant adds that prior to 1995, there was no geological source with terms such as "Algonquin stone", "Algonquin limestone", or "Algonquin dolostone".

[24] Excerpts from various publications, including the Ontario Dimensional Stone Catalogue and the Ontario Dimension Stone Producers & Processors Directory by the Ontario Ministry of Northern Development and Mines, issued in 1990, 1993 and 1994, are attached as Exhibits "B", "C" and "D" to his affidavit in support of the assertion that the term "Algonquin" was not used by others "to describe stone" at that time.

[25] Mr. Gauthier states that "post 1995-1996", the Applicant "began marketing the term 'Algonquin' to describe a particular band of stone throughout the mining industry as well as with the general public, contractors, masons, interior designers and architects". To this end, he attaches as Exhibits "I" and "J" to his affidavit copies of the Applicant's brochures from 1996-1997 and 1999-2000, as well as its price list from 2004 as Exhibit "K", purporting to evidence how the term "Algonquin Limestone" was used by the Applicant at that time. Upon review of these documents, I note that "Algonquin Limestone" is mentioned as one of the Applicant's stone products; others include "Eramosa Marble", "Senesun Limestone", "Buff Flagstone", "Black Flagstone", "Silverware" and "Indiana". However, it is not entirely clear if these terms are used in a trade-mark sense or descriptively as types of stone.

[26] Mr. Gauthier attaches as Exhibits “F” and “G” excerpts from the Ontario Dimension Stone Producers & Processors Directory of 98-99 and of 2003 published by the Ontario Ministry of Northern Development and Mines. They include references to the Applicant along with multiple stone names, including “Algonquin Limestone”. While Mr. Gauthier asserts that these publications demonstrate that the Applicant was the only producer of “Algonquin” limestone, I note that the publications also contain references to “Algonquin” products from other stone producers located in Ontario, namely “Algonquin Blue Granite” by “Cushman Stone and Gravel” in both editions, and “Algonquin Pink” by “Tasso Lake Stone” in the 2003 edition.

[27] Mr. Gauthier attaches as Exhibit “H” a copy of an article from *The Sun Times* of Owen Sound published on February 24, 1998. He explains that the article refers to the introduction of “Algonquin Limestone” into the market “two years ago” from one of the Applicant’s quarries. A summary sheet of test results dated January 6, 2004 for, as described by Mr. Gauthier, the Applicant’s “Algonquin stone and other stone types” is also attached as Exhibit “L”.

[28] In response to Mr. Ebel’s testimony, Mr. Gauthier states that the “Algonquin Arch” is located 150-175 kilometres south of the Opponent’s quarry and that the term has no geological significance to the stone quarried near Wiarton, Ontario. Mr. Gauthier also attaches a copy of the Opponent’s brochure along with its wholesale price list from 1999, and a brochure from 2010-11, as Exhibits “M”, “N” and “O” purporting to show the absence of “Algonquin” stone products offered by the Opponent at that time. Finally, Exhibit “P” is a printout of the Opponent’s website, showing an announcement posted on May 6, 2010 regarding the addition of a new product to the Opponent’s product list, described as “Sand Blasted Algonquin Pavers”.

[29] Mr. Gauthier also attaches as Exhibits “U” and “R” respectively copies of the very same invoices introduced as Exhibits “B” and “C” to the Ebel affidavit. Concerning more particularly the invoices issued by the Opponent to the Applicant, Mr. Gauthier states that they relate “to sales of blocks of unfinished product which identify [the Applicant’s Mark] in response to [the Applicant]’s request.” However, the affiant did not provide any documentary evidence to support this assertion. Concerning more particularly the invoices issued by the Opponent to third parties, Mr. Gauthier states that they show “12 Algonquin stone product invoices to persons or companies other than [the Applicant] dated prior to August 26, 2010”, which is the filing date of

the application for the Mark. I note that the majority of the invoices included in this second series of invoices are dated between June 4, 2007 and August 12, 2011, which is the filing date of the statement of opposition. I will return to these points below when assessing the non-distinctiveness ground of opposition.

[30] In response to Mr. Negus' testimony, Mr. Gauthier attaches as Exhibit "S" a copy of the BSRG 2011 brochure, purporting to show the absence of "Algonquin" stone products as one of BSRG's "stone types".

[31] In terms of sales, Mr. Gauthier states that the Applicant has had approximately 1,000 "Algonquin projects equating to millions of dollars". The affiant sets out a list of 20 projects dated between 1996 and 2011, said to be some of the most notable and award winning projects utilizing "Algonquin" stones.

[32] Finally, Mr. Gauthier states that the Applicant is the originator and the sole producer of "Algonquin stone" and that it is made from a limestone of a particular density with a set of specific characteristics including subtle black veining. Photos of the Applicant's "Algonquin" stones as flooring and staircases in buildings are attached as Exhibit "V" to his affidavit.

The Stobbe affidavit

[33] Mr. Stobbe's affidavit corroborates a substantial portion of Mr. Gauthier's affidavit, attaching some of the same exhibits. The affiant also produces ten articles from various websites regarding building projects, said to have used the Applicant's "Algonquin" limestone as Exhibits "K" to "T". I note that Exhibit "R" consists of an article that references the use of "Algonquin limestone" to build the University of Waterloo – School of Pharmacy project. However, it is not entirely clear if the term "Algonquin" is used in a trade-mark sense or simply to describe a type of limestone. As for the remaining articles, none of them mentions "Algonquin" stone products, or any other materials for that matter. Rather, they focus on the architecture and the design of the buildings.

[34] Similar to Mr. Gauthier's testimony, Mr. Stobbe's affidavit does not provide any clear statement with respect to the time when the term "Algonquin" was first used as a trade-mark in

association with the Applicant's stone products. One notable addition to Mr. Stobbe's testimony is his statement that Messrs. Ebel and Negus "are promoting and selling different layers as the same product under the trade name Algonquin in the marketplace".

The Chamberlain affidavit

[35] Mr. Chamberlain states that he worked for the Opponent from April 1984 until September 1999. He states that by September 1999, the Opponent had not quarried or produced any stone from the layers that were quarried by the Applicant to obtain "Algonquin" stones due to equipment constraints. Attached as Exhibits "A" and "B" to his affidavit are the Opponent's brochure and price list from "the late 1990s" purporting to show the absence of "Algonquin" products at that time.

[36] Mr. Chamberlain further states that the term "Algonquin" was not used by the Opponent or any other quarry in the Warton region "until the last few years", thereby confirming the use of that term by the Opponent and other traders in recent years.

The Laviolette affidavit

[37] Mr. Laviolette recounts the events that led to the adoption of the term "Algonquin" to "describe a stone type" by the Applicant. In particular, Mr. Laviolette states that the term "Algonquin" came from his personal knowledge of a "large glacial lake named 'Algonquin' that covered Southern Ontario and Northern United States at the time of the last ice age".

[38] Mr. Laviolette further states that it was widely recognized that "Algonquin" limestone originated from the Applicant, and that from 1996 to 2005, the Applicant was the only company that used the term "Algonquin" in association with a particular band of stone sold on the market. While I am not prepared to give weight to Mr. Laviolette's personal opinion that "Algonquin" limestone was widely recognized to originate from the Applicant, these statements bring support to the Opponent's position that other companies have been selling "Algonquin" stones since at least 2005.

The Hariri affidavit

[39] Mr. Hariri states that to his knowledge, the Applicant brought its “Algonquin” stone products to the market in the mid 1990s. He further states that his architectural firm has incorporated “Algonquin” stones into many of its award winning designs and buildings. Attached as Exhibits “A” to “D” to his affidavit are articles that discuss various architectural projects with mentions of “Algonquin limestone”.

[40] Upon review of these articles, I note that while there are references made to “Algonquin limestone” as one of the materials used in the projects, it is not entirely clear if the term “Algonquin” was used in a trade-mark sense or descriptively in reference to a type of limestone. In any case, none of the articles makes any connection between “Algonquin limestone” and the Applicant.

The Gaudet affidavit

[41] Ms. Gaudet states that her company offers various limestone types to clients who include architects, interior designers, and developers. She states that her company began promoting the Applicant’s “Algonquin” limestone in the early to mid 2000s and that it is widely considered by stone professionals to be a “stone type” of the Applicant.

[42] More particularly, Ms. Gaudet states that her company has not purchased “Algonquin” limestone from any other company even though she has “heard that other stone quarries have been claiming to have Algonquin limestone” but she has “not been able to confirm that this is true.” She also states that “for industry insiders of Ontario stone, it is well recognized that Algonquin [was] well established as an [Applicant] product *prior to 2010*” [emphasis added].

[43] Again, while I am not prepared to give weight to Ms. Gaudet’s personal opinion that “Algonquin” limestone was well recognized to originate from the Applicant, I note that Ms. Gaudet makes reference to the use of the term “Algonquin” by others in the stone industry in recent years, which corroborates similar observations made by other witnesses of the Applicant, namely Messrs. Stobbe, Chamberlain and Laviolette as discussed above.

Analysis of the grounds of opposition

[44] I shall now turn to the analysis of the grounds of opposition, although not in their order of pleading.

The non-conformity ground of opposition based on section 30(b) of the Act

[45] The Opponent has pleaded that the Mark has not been continuously in use as a trademark, in the ordinary course of trade, in association with the Wares, since the alleged date of first use, namely January 1996, contrary to section 30(b) of the Act.

[46] The relevant date for considering the circumstances concerning this ground of opposition is the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)]. In this regard, section 30(b) of the Act requires that there be continuous use of the Mark since the date claimed [see *Labatt Brewing Co v Benson & Hedges (Canada) Ltd* (1996), 67 CPR (3d) 258 (FCTD)]. The Opponent's evidential burden respecting the issue of non-conformity with section 30(b) of the Act has been characterized as a light one because the facts concerning this ground are more readily available to the Applicant than to the Opponent [see *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. The Opponent may meet its burden by reference to the Applicant's evidence, provided that the Applicant's evidence is clearly inconsistent with the claims set forth in its application [see *Labatt Brewing Co v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD)].

[47] In the present case, the Opponent has not provided any evidence in support of its allegations. Rather, it relies on the Applicant's evidence to meet its initial evidential burden. In particular, the Opponent submits that the Applicant's own evidence shows that it was not until after "1995-1996" that the Applicant actually began "marketing the term Algonquin to describe a particular type of stone". Further, the Opponent contends that the Applicant never alleged use of the Mark as contemplated by section 4 of the Act as of the claimed date of first use. Instead, the Applicant's statement regarding the "marketing" of the Wares is the closest evidence of "use" submitted, and even this evidence comes well after January 1996.

[48] In reply, the Applicant submits that the Opponent has failed to discharge its evidential burden. Specifically, the Applicant contends that the Opponent has led no evidence on this point and that its own evidence shows adoption and use of the Mark “in 1995 or 1996”. As such, the Applicant argues that this ground of opposition should be struck.

[49] I disagree with the Applicant.

[50] As per my review of Messrs. Gauthier’s and Stobbe’s testimonies, the Applicant began quarrying from a particular layer of beige/brown coloured stone in the region found 15 to 25 feet below the surface “in 1995-1996”. The term “Algonquin” was suggested by Mr. Laviolette to describe this band of stone, also “in 1995-1996”. While this information is corroborated by Mr. Laviolette’s testimony, all I am able to conclude from these statements is that the term “Algonquin” was first adopted by the Applicant sometime during a two-year span, between 1995 and 1996, as a term to describe a particular layer of stone that it began to quarry. However, these statements do not expressly and unequivocally speak to the use of the term “Algonquin”, as a trade-mark per se, in association with stone products as of January 1996.

[51] To the contrary, Messrs. Gauthier and Stobbe both further state in their respective affidavits that the Applicant only began to “*market*” stone products under the name “Algonquin” “*post 1995-1996*” [emphasis added]. These testimonies suggest that the term “Algonquin” might not even have been associated with the Applicant’s products until *after* December 31, 1996, which is clearly inconsistent with the Applicant’s claimed date of first use of the Mark in Canada. In other words, rather than providing support for the date of January 1996, the evidence supports a later date of first use.

[52] Adding confusion to the matter is the difficulty I have in reconciling the vague allegations of adoption of the term “Algonquin” “in 1995-1996” with the little information and documentation that the Applicant presented with respect to the use of that term, as a trade-mark, in association with its Wares.

[53] As per my review of the evidence submitted by the Applicant, there is no documentary evidence showing any of the Applicant’s stone products bearing the Mark. There is also no indication that any of the Applicant’s marketing brochures or price list attached as Exhibits “I”,

“J” and “K” to the Gauthier affidavit accompanied the stone products at the time of transfer so as to provide any notice of association between the Mark and the Wares at the time of transfer in accordance with section 4(1) of the Act [see *BMW Canada Inc v Nissan Canada Inc* (2007), 60 C.P.R. (4th) 181 (FCA)]. Furthermore, even if I were to assume that these documents accompanied the Wares at the time of transfer, and further showed use of the term “Algonquin” in a trade-mark sense rather than as a descriptive term, the fact remains that the earliest of these documents is from “1996-1997”, which time period does not directly support the date of first use claimed by the Applicant.

[54] Likewise, the Applicant has elected to discuss the sales of the Wares in very general terms only, leaving me unable to conclude that the Wares have been sold under the Mark as of January 1996. Mr. Laviolette merely states that many architects have used the Applicant’s “Algonquin” stone products for their projects “since 1995-1996”; and Mr. Stobbe states that “[f]rom 1996”, approximately 1,000 projects have used the Applicant’s “Algonquin” limestone, “equating to millions of dollars worth of stone”. However, no other sales figures or breakdown is provided. Even though the Applicant was under no obligation to positively evidence sales of the Wares as of January 1996, it remains that these statements do nothing to clarify the uncertainty around the time when stone products were first sold under the Mark.

[55] Finally, I note that in its written argument, the Applicant itself does not appear to be able to point to any clear evidence of use as of January 1996 when it states that the evidence proves that the Applicant adopted and began to use the Mark “in 1995 *or* 1996” [emphasis added].

[56] To sum up, when the Applicant’s evidence is viewed in its entirety, I note that it discusses quite extensively the time when the Applicant first quarried a particular layer of stone, as well as the origin of the term “Algonquin”. However, none of the affidavits directly asserts use of that term as a trade-mark as of the claimed date of first use. To the contrary, they contain statements that suggest a later date of first use. Moreover, despite the large quantity of documentary evidence put forth in support of the application, it is still unclear whether the Applicant did in fact use the term “Algonquin” as a trade-mark per se in association with its stone products in accordance with section 4(1) of the Act, or simply as a term to describe a particular type of stone. When all these ambiguities are put together, the Applicant’s own

evidence casts doubt on the accuracy of the date of first use claimed in the application. With no other evidence suggesting use of the Mark in association with the Wares as of January 1996 within the meaning of section 4 of the Act, I find the Applicant's evidence to be clearly inconsistent with the alleged date of first use.

[57] Accordingly, the section 30(b) ground of opposition succeeds.

The non-distinctiveness ground of opposition based on section 2 of the Act

[58] The Opponent has pleaded that the Mark is not distinctive under section 2 of the Act as it does not actually distinguish, nor is it adapted to distinguish, the Wares of the Applicant from the wares of others. More particularly, this ground of opposition, as pleaded by the Opponent, has three prongs, namely that the Mark is not distinctive in view of the fact that (1) it is the name of the Wares; (2) it is clearly descriptive of the character and quality, or the place of origin of the Wares; and (3) it is a descriptive term commonly used in the industry by the Opponent and others in association with stone and stone products.

[59] Generally, the material date for assessing distinctiveness is the date of filing of the opposition, in this case August 12, 2011 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FCTD)]. The legal onus is on the Applicant to show that its Mark actually distinguishes its Wares from those of others throughout Canada [see *Muffin Houses Inc v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)]. However, as indicated above, there is an initial evidential burden on the Opponent to establish the facts relied upon in support of this ground.

[60] I will first address the third prong of the ground of opposition, which deals with descriptive use of the term by the Opponent and others. In deciding this issue, I am guided by the comments of Mr. Justice Addy, in *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD):

On the issue of lack of distinctiveness of a mark, although it must be shown that the rival or opposing mark must be known to some extent at least, it is not necessary to show that it is well known [...]. It is sufficient to establish that the other mark has become known sufficiently to negate the distinctiveness of the mark under attack.

[61] Further, the Opponent is not limited to relying on its own use or making known of the term “Algonquin”; it may rely on third party use or making known [see *Clarco Communications Ltd v Sassy Publishers Inc* (1994), 54 CPR (3d) 418 (FCTD)]. An attack based on non-distinctiveness is not restricted to the actual sales of goods in Canada; all relevant evidence that tends to establish non-distinctiveness may be taken into consideration [see *Motel 6, supra*, para 45].

[62] The Opponent submits that based on the extensive use of the term “Algonquin” by itself and third parties in the industry “to describe and/or as the name of the stone products”, it cannot be distinctive of any single entity, including the Applicant.

[63] In reply, the Applicant submits that the Opponent has not met its initial evidential burden as there is no evidence of independent use by others that would lead to a substantial, significant or sufficient reputation. Furthermore, even if this initial evidential burden has been met, the Applicant contends that it has acquired an established reputation for its “Algonquin” stone products.

[64] I disagree with the Applicant.

[65] As per my review of Messrs. Ebel’s and Negus’ testimonies, the Opponent has provided evidence that the term “Algonquin” has been commonly adopted by the Opponent and other traders in the industry in reference to stone products prior to August 12, 2011 together with supporting exhibits.

[66] Concerning more particularly the Opponent’s own use of the term “Algonquin” in association with the sale of its stone products, two series of invoices are on file. The first series [Exhibit “B” to the Ebel affidavit, which is further attached as Exhibit “U” to the Gauthier affidavit] evidences the Opponent’s sale of “Algonquin” stone products to the Applicant in 2001 and 2002. The second series [Exhibit “C” to the Ebel affidavit, which is further attached as Exhibit “R” to the Gauthier affidavit] evidences the Opponent’s sale of “Algonquin” stone products to third parties across Ontario between 2007 and 2011.

[67] I am not prepared to disregard the invoices between the Opponent and the Applicant based solely on Mr. Gauthier’s unsubstantiated assertion that they relate “to sales of blocks of

unfinished product which identify [the Applicant's Mark] in response to [the Applicant's] request". The circumstances surrounding this alleged request have not been explained by the Applicant. Without any further explanation or supporting documentation regarding the relationship, if any, existing between the Applicant and the Opponent, and in the absence of any indication of a licensing agreement between the parties regarding the use of the Applicant's Mark by the Opponent, I have no reason not to accept these invoices at face value. Yet, these invoices show the sale of "Algonquin" stone products by the Opponent, in its own capacity, to the Applicant.

[68] As for the invoices issued by the Opponent to third parties, the Applicant contends that they suggest, at best, careless use of the Applicant's Mark by the Opponent or at worst, "a bad faith use of a known mark of a competitor". I disagree.

[69] The fact that Mr. Ebel and the Applicant had prior business relationships with each other could explain in part when and how the Opponent first became aware of a stone type called "Algonquin". However, this does not in itself establish bad faith or careless use of a competitor's trade-mark later on. As per my review of the Ebel affidavit, there is no indication that the Opponent used the term "Algonquin" in an attempt to identify its stone products with another entity's trade-mark, intentionally or otherwise.

[70] In fact, when the second series of invoices is compared with those addressed to the Applicant, there is no distinction between "Algonquin" products that were sold to the Applicant and those sold to third parties. On this point, I note that the Applicant has not offered any evidence to suggest that it has ever objected to the use of the term "Algonquin" by the Opponent on its invoices, even after it was made aware of such practice following the receipt of the Opponent's invoices for products described as "Algonquin Blocks" back in 2001 and later on.

[71] There is no indication that the term "Algonquin" was used by the Opponent, be it as a trade-mark of its own or that of the Applicant, to identify a stone product from a particular source. Rather, based on a fair reading of these two series of invoices, the term "Algonquin" appears to be used as a descriptive term to identify a type of stone, similar to other descriptive terms noted in these invoices such as "Beige Broken Flagstone" and "Beige Cobblestone". My finding is reinforced by Mr. Negus' testimony as well as the Applicant's own evidence.

[72] As indicated above, excerpts from the Ontario Dimension Stone Producers & Processors Directory by the Ontario Ministry of Northern Development and Mines introduced by the Applicant itself through the Gauthier affidavit, reference two additional traders who supplied “Algonquin” stone products in 1998 and 2003, namely “Algonquin Blue Granite” by “Cushman Stone and Gravel”, and “Algonquin Pink” by “Tasso Lake Stone” [see Exhibits “F” and “G” to the Gauthier affidavit]. This directly puts into question the Applicant’s claim as the sole producer of the “Algonquin” stone products as of the material date.

[73] Mr. Negus’ testimony further supports evidence of sale of “Algonquin” limestone by another stone supplier, BSRG, prior to the material date. In particular, Mr. Negus’ various email exchanges with clients regarding BSRG’s inventory of “Algonquin” limestone and other types of limestone in 2010 and 2011 [see Exhibit “A” to his affidavit], as well as project plans prepared by BSRG and one of its clients in 2008 [see Exhibits “B” and “C” to his affidavit], provide support to the allegation that consumers were requesting stone products known as “Algonquin” stones from a third party supplier as early as 2008. As with Mr. Ebel’s testimony, there is no indication that BSRG used the term “Algonquin” in an attempt to identify its stone products with another entity’s trade-mark, intentionally or otherwise.

[74] The Applicant’s own evidence does not refute the evidence presented by the Opponent. Indeed, while the Applicant provides ample information regarding events that took place in the mid 1990s, coinciding with the introduction of a new type of stone product described as “Algonquin”, the evidence does not support its assertion that the Mark was distinctive of its stone products at the filing date of the statement of opposition. To the contrary, it is consistent with the Opponent’s position that the term “Algonquin” was at that time used by itself and others to describe a type of stone.

[75] As noted above, Mr. Gauthier produces a printout of the Opponent’s website confirming the introduction of “Sand Blasted Algonquin Pavers” by the Opponent prior to the material date [see Exhibit “P” to his affidavit]. Messrs. Stobbe, Chamberlain and Laviolette, as well as Ms. Gaudet, all provide testimonies to the effect that the Applicant is no longer the only source of “Algonquin” stone products in the industry. In fact, Mr. Chamberlain acknowledges that, at the time of his affidavit sworn on June 6, 2012, the term “Algonquin” had been used by other

quarries in the region in “the last few years”. Likewise, Ms. Gaudet asserts in her affidavit sworn on June 19, 2012 that she has heard of other quarries that have claimed to have “Algonquin” limestone “in the last couple of years”. Mr. Laviolette’s testimony further lends support to the proposition that “Algonquin” stone products from other sources have been on the market since at least 2005.

[76] While the Applicant might have been the first to quarry a particular layer of stone and to later produce and market a stone product under the term “Algonquin”, it no longer appears to be the only supplier of “Algonquin” stones for a number of years. There is sufficient evidence to show that due to third parties’ adoption of the term “Algonquin” to describe their own wares in recent years, the Mark was no longer identifying a specific source of stone products in the marketplace as of the material date. It therefore could not function as a trade-mark capable of distinguishing the wares of one party from another.

[77] Accordingly, the Applicant has failed to show, on a balance of probabilities, that the Mark distinguished its Wares from those of others at the filing date of the statement of opposition. The third prong of the section 2 ground of opposition therefore succeeds.

[78] In view of the above, I do not consider it necessary to address the first and second prongs of the non-distinctiveness ground of opposition.

Remaining grounds of opposition

[79] As I have already found in favour of the Opponent under two grounds of opposition, I do not consider it necessary to address the remaining grounds of opposition.

Disposition

[80] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the

application pursuant to section 38(8) of the Act.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office