

IN THE MATTER OF AN OPPOSITION  
by Stauffer Chemical Company to  
application No. 555,967 for the  
trade-mark SOLI-BOND filed by  
Soli-Tech, Inc.

On January 22, 1986, the applicant, Soli-Tech, Inc., filed an application to register the trade-mark SOLI-BOND for "hygroscopic cementitious substance used in rigidification process" and "rigidifying slurries resulting from the drilling of wells." The application is based on proposed use in Canada for wares and services and on use and registration in the United States for services. The application was advertised for opposition purposes on September 10, 1986.

The opponent, Stauffer Chemical Company, filed a statement of opposition on February 9, 1987, a copy of which was forwarded to the applicant on February 24, 1987. The first ground of opposition is that the application does not comply with the provisions of Section 30(a) of the Trade-marks Act because the statement of wares and services is not in ordinary commercial terms. The second ground is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with the opponent's trade-mark SILBOND registered under No. 252,510 for the following wares:

- (1) silicate compositions
- (2) ethyl silicate
- (3) orthosilicates, polysilicates, and mixture thereof used in binder systems for foundry sand molds and cores.

The third ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16 of the Act because, as of the applicant's filing date, the applied for trade-mark was confusing with the trade-mark SILBOND previously used and made known in Canada by the opponent. The fourth ground is that the applied for trade-mark is not distinctive in view of the foregoing.

The applicant filed and served a counter statement. The opponent failed to timely file evidence pursuant to Rule 43 of the Trade-marks Regulations. As its evidence, the applicant filed the affidavits of Dwight N. Hartley and Allison Fogarty. As evidence in reply, the opponent filed the affidavit of Jeffrey T. Simmonds. Both parties filed written arguments but no oral hearing was conducted.

As for the first ground of opposition, the onus or legal burden is on the applicant to show its compliance with the provisions of Section 30(a) of the Act. However, there is an evidential burden on the opponent to adduce some evidence in support of the allegations of fact underlying the ground. The opponent has failed to adduce any evidence of its own on point. Its only submission is that the statements of wares and services are not in ordinary commercial terms because they do not appear in the applicant's product brochure appended as Exhibit C to the Hartley affidavit. That fact alone is insufficient, in my view, to satisfy the opponent's evidential burden. The product brochure only refers to the applicant's services and not its wares. Furthermore, although the brochure does not use the exact words appearing in the applicant's statement of services, it does use phrases such as "mud stabilization and solidification process" and "process of drilling mud solidification" which appear to be very similar to the wording of the applicant's statement of services. Thus, I find that the opponent's first ground is unsuccessful.

As for the third ground of opposition, there was an evidential burden on the opponent to evidence use or making known of its trade-mark SILBOND prior to the applicant's filing date. Since the opponent failed to file evidence on point, the third ground is also unsuccessful.

As for the remaining grounds of opposition, they both turn on the issue of confusion. The material time respecting the second and fourth grounds is as of the filing of the opposition. Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

The applicant's mark SOLI-BOND is inherently distinctive since it is a coined word. However, it is not inherently strong since the word BOND is highly suggestive of bonding wares and services and the component SOLI is somewhat suggestive of a solidification process. The Hartley affidavit provides some evidence of use of the applicant's mark but it is insufficiently precise to allow me to conclude that any significant portion of the applicant's sales occurred prior to the filing of the opposition. Thus, I must conclude that the applicant's mark had not become known at all in Canada as of the material time.

The opponent's mark SILBOND is also a coined word and is therefore inherently distinctive. However, it, too, is inherently weak since the word BOND is highly suggestive of bonding materials and the component SIL is somewhat suggestive of the opponent's silicate compositions. There is no evidence of use of the opponent's mark in Canada.

The length of time the marks have been in use is not a significant factor in the present case. The applicant's services of rigidifying slurries at well sites are entirely different from the opponent's wares. As stated in the Simmonds affidavit, the opponent's silicate compounds are used in inorganic zinc coatings, investment casting molds, cores and ceramic shapes and coatings. As also stated by Mr. Simmonds, the opponent's products are primarily sold to foundries. There would appear to be no connection at all between that type of trade and the services performed by the applicant at well sites.

As for the applicant's wares, the statement of wares is not restricted to cementitious substances used at well sites. Furthermore, Mr. Hartley states that the applicant's wares, apart from being used at well sites, are also used to "...rigidify slurries composed of industrial wastes." As noted by Mr. Simmonds in his affidavit, customers using the opponent's SILBOND product in a casting process often use it as one component of a slurry which eventually becomes a waste by-product of the process. Presumably, such customers might use the applicant's SOLI-BOND product to eliminate the waste by-product. Thus, there would appear to be a potential overlap between the trades of the parties with respect to the wares at issue: see the decisions in Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R. (3d) 3 at 10-11 (F.C.A.) and Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R. (3d) 110 at 112 (F.C.A.).

As for Section 6(5)(e) of the Act, I consider there to be a fair degree of resemblance in all respects between the two marks. Both commence with the letter S followed by a vowel and the letter L and both use the suffix BOND.

It is the applicant's contention that the state of the register evidence introduced by means of the Fogarty affidavit is an additional surrounding circumstance in the present case. Ms. Fogarty states that she conducted a search to locate registrations and pending applications for trade-marks including the word BOND covering wares in the nature of adhesives. However, as noted by the opponent, the Fogarty affidavit can only be given relatively low probative weight in view of the fact that it would appear that Ms. Fogarty did not check the trade-marks register nor did she provide complete particulars of the registrations and applications located: see the opposition decision in The Molson Companies Limited v. T.G. Bright & Co. Limited (1984), 3 C.P.R. (3d) 202.

The Fogarty affidavit does, however, provide evidence of over 100 registrations for marks including the word BOND for various adhesive products. But many of the registrations cover wares which appear to be entirely unrelated to the wares, services and trades at issue in the present case. Nevertheless, even given the evidentiary limitations of the Fogarty affidavit, it does serve to underscore the non-distinctiveness of the word BOND as a component of the marks at issue.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the resemblance between the marks and the potential overlap in the trades respecting the wares at issue, I find that the applicant has failed to satisfy the onus on it to show that its mark is not confusing with the opponent's registered mark in respect of the applied for wares. On the other hand, given the disparity between the opponent's wares and the applied for services, I find that the applicant has satisfied the onus on it to show that its mark is not confusing with the opponent's mark in respect of the applied for services. Thus, the second and fourth grounds are partially successful.

In view of the above, I refuse the application insofar as it includes wares and I otherwise reject the opposition. As for the authority to render a divided decision, reference may be made to the decision in Produits Menagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH (1986), 10 C.P.R. (3d) 482 at 492 (F.C.T.D.).

DATED AT HULL, QUEBEC, THIS 28th DAY OF February, 1991.

David J. Martin,  
Member,  
Trade Marks Opposition Board.