

IN THE MATTER OF AN OPPOSITION by Oakwood Lumber and Millwork Co. Limited to application No. 659,849 for the trade-mark FIBER-CLASSIC filed by Therma-Tru Corp.

On June 13, 1990, the applicant, Therma-Tru Corp., filed an application to register the trade-mark FIBER-CLASSIC in association with the following wares: (1) Non-metallic windows for homes; (2) Doors. The application was based on use in Canada since February 1985 in association with “(2) Doors” and use and registration of the mark in the United States of America under No. 1,384,310 in respect of the wares “(1) Non-metallic windows for homes.” The application was advertised for opposition purposes in the Trade-Marks Journal of October 2, 1991, and the opponent, Oakwood Lumber and Millwork Co. Limited, filed a statement of opposition on February 3, 1992.

The first ground of opposition is that, pursuant to s.38(2)(a), the application does not comply with the requirements of s.30 (i) of the Trade-Marks Act, R.S.C. 1985 c.T-13 (hereinafter the Act) in that the applicant could not have been satisfied that it was entitled to use and register the trade-mark in Canada in association with the applied for wares because it was aware of the prior use by the opponent of the trade-mark CLASSIC, Registration No. 321,504, in association with doors. The opponent alleges as its second ground of opposition that the applicant is not the person entitled to registration of the mark pursuant to s.16(3)(a) and s.16(3)(b) of the Act because at the date of filing, the trade-mark was confusing with the trade-mark CLASSIC which had been previously used or made known in Canada by the opponent. The third ground of opposition is that the trade-mark FIBER-CLASSIC is not distinctive pursuant to s.38(2)(d) and s.2 of the Act as it does not distinguish the wares proposed to be sold by the applicant from those of the opponent. I would note in passing that the opponent did not plead a Section 12(1)(d) ground of opposition.

The applicant filed and served a counterstatement on April 6, 1994, in which it denied the allegations asserted by the opponent in its statement of opposition. Neither party filed any evidence and only the applicant filed a written argument. The opponent requested an oral hearing at which only the applicant attended.

As the applicant stated in its written and oral arguments, each of the grounds pleaded by the opponent require the opponent to meet an initial evidential burden. Under s.16(3)(a), there is an initial burden on the opponent to evidence use or making known of its mark prior to the applicant’s filing date. The opponent also has an initial evidential burden under s.30 to support its allegations that the applicant could not have been satisfied that it was entitled to use the trade-

mark. Further, under s.38(2)(d), there is an evidential burden on the opponent to prove the allegations of fact supporting its ground of non-distinctiveness. As the opponent has failed to file any evidence in support of these grounds, I have no choice but to reject each of these grounds of opposition.

Under s.16(3)(b) and s.16(4), the opponent must show that its trade-mark application was filed before the applicant's application and was pending as of the advertisement date of the applicant's mark. In the present case, although the opponent's application for the trade-mark CLASSIC, Registration No. 321,504, was filed before the applicant's application for the mark FIBER-CLASSIC, the opponent's mark had already been registered by the advertisement date of the applicant's mark. Consequently, this ground of opposition must also fail.

Accordingly, and with the authority delegated to me under s. 63(3) of the Act, I reject the opponent's opposition pursuant to s.38(8) of the Act.

DATED AT HULL, QUEBEC, THIS 24th DAY OF FEBRUARY 1997.

Cindy R. Vandenakker
Hearing Officer
Trade-Marks Opposition Board