

**IN THE MATTER OF AN OPPOSITION by  
Pittsburgh Corning Corporation to application No.  
1,129,442 for the trade-mark DECORA WINDOW  
& DOOR SYSTEMS and application No. 1,129,443  
for the trade-mark DECORA WINDOW & DOOR  
SYSTEMS & Design filed by 1274739 Ontario  
Inc.**

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[1] On January 30, 2002, 1274739 Ontario Inc. [the Applicant] filed an application to register the trade-mark DECORA WINDOW & DOOR SYSTEMS [the Mark] as well as an application to register DECORA WINDOW & DOOR SYSTEMS & Design [the Design Mark]. The Design Mark is shown below:



[2] Both applications are based upon use of the applied-for mark in Canada in association with manufacturing, sales, service and installation of exterior window and door products since February 21, 1994.

[3] The application for the Design Mark was advertised for opposition purposes in the Trade-marks Journal of October 6, 2004. The application for the Mark was advertised for opposition purposes in the Trade-marks Journal of March 9, 2005.

[4] On March 7, 2005, Pittsburgh Corning Corporation [the Opponent] filed a statement of opposition against the application for the Design Mark. On August 9, 2005, the Opponent filed a statement of opposition against the application for the Mark.

[5] The same grounds of opposition have been pleaded pursuant to s. 38(2)(a), (b), (c) and (d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 [the Act] against each application.

[6] The Applicant filed and served counter statements, in which it denied the Opponent's allegations.

[7] In support of each of its oppositions, the Opponent filed an affidavit of Thomas James Pirosko, the Opponent's Vice President of Sales.

[8] In support of each of its applications, the Applicant filed an affidavit of Robert Brunino, a director and officer of the Applicant. The Opponent obtained orders for the cross-examination of Mr. Brunino. A copy of the transcript of the cross-examination and answers given to undertakings have been filed. (A single cross-examination was conducted for the two applications.)

[9] Both parties filed written arguments. An oral hearing was held, in which both parties participated.

[10] As the evidence and argument are essentially the same for both applications, the outcome of both oppositions will be the same. I will therefore focus the following discussion of the issues on just one of the applications, namely the one for the Design Mark.

#### Onus

[11] 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].

### Section 30(b) Ground of Opposition

[12] The first ground of opposition is that the application is not in compliance with s. 30(b) of the Act because the Applicant has not used the Design Mark since February 21, 1994, as claimed.

[13] The Opponent's initial burden with respect to s. 30(b) can be met by reference not only to the Opponent's evidence but also to the Applicant's evidence [see *Labatt Brewing Company Limited v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) (F.C.T.D.) 216 at 230]. However, while the Opponent may rely upon the Applicant's evidence to meet its evidential burden in relation to this ground, the Opponent must show that the Applicant's evidence is 'clearly' inconsistent with the Applicant's claims as set forth in its application.

[14] The Opponent here relies upon the Applicant's evidence to meet its initial burden. First, it refers to Exhibit 1 to the cross-examination of Mr. Brunino, which is a corporation profile report for the Applicant that indicates an incorporation date of January 1, 1998. Mr. Brunino confirmed that such record was accurate. [Question 11, cross-examination] Therefore, although Mr. Brunino has provided evidence that the Design Mark was in use prior to January 1, 1998, clearly such use was not by the Applicant, as it did not exist at that time.

[15] Second, reference is made to the answers to undertakings provided by Mr. Brunino in response to the following question (Question 18): "In what manner did your company use these trade-marks back in around February 21<sup>st</sup>, 1994?" In response, the Applicant provided a newspaper article dated August 2, 1995, which states that Robert Brunino and partner Jack Cascone "recently opened Decora Window and Door Systems at 8400 Jane Street in Concord." Photographs were also provided including two identified as "Open House at Decora Window and Door Systems' showroom" dated July 19, 1995; these photos appear to show a ribbon-cutting ceremony.

[16] I find that the foregoing pieces of evidence are clearly inconsistent with the claim that the Applicant has used the Design Mark since February 21, 1994. Not only did the Applicant not exist as of the claimed date of first use but also, even if it were to claim that the partnership of

Roberto Brunino and Jack Cascone was its predecessor, the articles and photographs imply that those individuals commenced operating the Decora Window and Door Systems business in 1995. In the event that a predecessor-in-title was using the mark as of February 21, 1994, then the application would still be lacking because it does not name any predecessor as required by s. 30(b).

[17] The s. 30(b) ground is therefore successful.

#### Grounds of Opposition based on a Likelihood of Confusion

[18] The issue of the likelihood of confusion between the Applicant's Design Mark and the Opponent's mark DECORA underlies the grounds of opposition pleaded under s. 38(2)(b)/s. 12(1)(d), s. 38(2)(c)/s. 16(1)(a) and s. 38(2)(d)/s. 2 of the Act. The material date with respect to each of these grounds ranges from the Applicant's date of first use to today's date but, in the circumstances of this case, nothing turns on the date at which the issue of confusion is determined.

[19] I will first address the likelihood of confusion between the Applicant's Design Mark and the Opponent's mark as of today's date, i.e. pursuant to the s. 12(1)(d) ground of opposition. Under that ground, the Opponent pleads that the Design Mark is confusing with the mark DECORA registered by the Opponent for architectural glass. The Opponent has met its initial burden under this ground as its registrations for DECORA (Nos. TMA358,512 and TMA372,873) are in good standing.

#### *test for confusion*

[20] 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.

[21] 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*

[22] Each of the marks is inherently distinctive since DECORA is not a dictionary word. However, as DECORA resembles and includes “decor”, a dictionary word that relates to the furnishing and decoration of a room, neither mark is an inherently strong mark.

[23] The strength of a trade-mark may be increased by it becoming known through promotion or use. In this case, there is evidence that the Opponent’s mark has become fairly well known. In particular, the Opponent has sold DECORA wares in Canada since at least as early as February 1980 and the gross value of Canadian sales from 1991 to 2005 exceeded \$1 million U.S. annually. In addition, the Opponent advertises its DECORA wares in Canada in various publications and by means of brochures and its web site. Examples of these promotional materials have been provided (Pirosko affidavit, paragraphs 12 –18, Exhibits “H” to “O”).

[24] There is less evidence that the Applicant’s Design Mark has become known through promotion or use. Although the Applicant claims to have used its Design Mark since February 21, 1994, as discussed earlier it appears that it could not have been the Applicant who was using the Design Mark prior to January 1, 1998 and so any earlier use would not add to the distinctiveness of the Design Mark in the hands of the Applicant. The only evidence showing the use or promotion of the Applicant’s Design Mark arose from the cross-examination of Mr. Brunino; in particular, copies of pages from the Applicant’s web site as of June 6, 2007 were filed as exhibits during the cross-examination and materials showing use/promotion in 1994/5

were provided in answer to undertakings given.

[25] Overall, s. 6(5)(a) favours the Opponent since, according to the evidence before me, its mark has become more known than has the Applicant's Design Mark.

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

[26] This factor also favours the Opponent.

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

[27] 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.)]. However, those statements 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.)].

[28] The Opponent's mark is registered for "architectural glass – namely, glass blocks and analogous glass shapes for architectural use." The Applicant has applied to register its Design Mark for "manufacturing, sales, service and installation of exterior window and door products".

[29] In his affidavit, Mr. Brunino states that the Applicant's window and door systems have never incorporated any type of glass blocks in their design or manufacture. He also states that the "window and door systems are functional in nature, such that they are designed to open and close

to allow the transmission of light and air...” (paragraph 4) However, during cross-examination, it was revealed that the Applicant does sell some decorative glass products, namely decorative windows that do not open and do not allow for the transmission of air. These products are promoted as “allow[ing] natural light to flow into your home while at the same time maintaining a degree of privacy.” (See page 7 of cross-examination.)

[30] Mr. Pirosko attests that the Opponent’s glass block, “which allows for the transmission of light while maintaining privacy, is used by architects, professional builders and homeowners for various applications, including walls, partitions, side lights for doors, windows and showers.” [paragraph 4] The glass blocks are “utilized both in and as windows”, i.e. dealers purchase the blocks for fabrication of windows for resale and the blocks are also used in mortared basement windows.

[31] The Opponent’s glass blocks are sold in Canada by way of distributors, home centres (such as Home Depot) and/or sales representatives; thus they are sold both to individual home owners and to members of the construction industry. The August 2, 1995 newspaper article provided by the Applicant states that Decora Window and Door Systems sell customized window frames and doors to both contractors building new homes and homeowners upgrading and improving existing homes.

[32] Overall, it appears that although the Applicant has applied to register its Design Mark for services and the Opponent’s mark is registered for wares, there is an overlap in the wares sold by both parties in association with the marks at issue, namely both parties sell windows or parts thereof. Clearly they are in related businesses and their clientele overlap.

[33] Section 6(5)(c) and (d) therefore 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*

[34] The marks resemble one another because the Applicant's Design Mark incorporates the Opponent's mark, not only in its entirety but also as the first word in its mark. It is generally accepted that the first component of a mark is often considered more important for the purpose of distinction [*Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.)].

[35] Although the Applicant has added other words and design features to the word DECORA, the added words are descriptive and the design features are not so unique that either serves to distinguish the marks one from the other in any significant manner.

[36] Thus, although there are differences between the marks in appearance and sound and in the ideas suggested by them, the marks nevertheless resemble each other to a fairly high degree and s. 6(5)(e) favours the Opponent.

*other surrounding circumstances*

[37] Mr. Brunino attests that to the best of his knowledge and belief, the Applicant has never received any request by any of its consumers to incorporate the use of glass blocks in the design and manufacture of the Applicant's window and door systems, has never been contacted by any consumer seeking to purchase DECORA type glass blocks from the Applicant and has never been advised by any of its sales representatives that consumers had sought to purchase DECORA type glass blocks from the Applicant.

[38] An adverse inference concerning the likelihood of confusion may be drawn when concurrent use on the evidence is extensive and no evidence of confusion has been given by the opponent. [*Christian Dior S.A. v. Dion Neckwear Ltd.* 2002, 20 C.P.R. (4th) 155 (F.C.A.)] I am assuming that Mr. Brunino's evidence is meant to indicate that no confusion has occurred. However, I am only entitled to draw an adverse inference if there has been extensive concurrent use and Mr. Brunino's evidence does not provide sufficient evidence concerning the



extent of the Applicant's use for me to conclude that there has been extensive concurrent use.

*conclusion regarding likelihood of confusion*

[39] Having considered all of the surrounding circumstances, I find that, on a balance of probabilities, confusion is likely. The s. 38(2)(b)/s. 12(1)(d) grounds of opposition accordingly succeed.

Remaining Grounds of Opposition

[40] As I have already found in favour of the Opponent under two grounds of opposition, I will not address the remaining grounds of opposition other than to say that most likely the s. 38(2)(c)/s. 16(1)(a) and s. 38(2)(d)/s. 2 grounds would also have succeeded for reasons similar to those set out under the discussion of the s. 38(2)(b)/s. 12(1)(d) grounds of opposition.

Disposition

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

DATED AT GATINEAU, QUEBEC, THIS 22<sup>nd</sup> DAY OF OCTOBER 2009.

Jill W. Bradbury  
Member  
Trade-marks Opposition Board