IN THE MATTER OF AN OPPOSITION by Andersen Corporation to application No. 586,332 for the trade-mark FLEXIFRAME filed by Mark-Bric Canada Ltd.

On June 17, 1987, Mark-Bric Canada Ltd. filed an application to register the trade-mark FLEXIFRAME based upon use of the trade-mark in Canada since March 2, 1987 in association with "display frames for displaying graphic sheet materials such as posters, photographs and other artwork". Subsequent to the oral hearing, the applicant submitted an amended application in which its statement of wares was amended to cover: "display frames made of plastic for displaying graphic sheet materials such as posters, photographs and other artwork, for commercial, industrial and retail use".

The opponent, Andersen Corporation, filed a statement of opposition on July 19, 1989 in which it alleged that the applicant's trade-mark FLEXIFRAME is not registrable in view of the provisions of Section 12(1)(d) of the Trade-marks Act in that the applicant's trade-mark is confusing with its registered trade-mark FLEXIFRAME, registration No. 283,210 covering building materials, namely window components including prefinished wooden members for constructing window frames of varied shapes. The opponent also alleged that the applicant is not the person entitled to registration of the trade-mark FLEXIFRAME and that the applicant's trade-mark is not distinctive in that the applicant's trade-mark is confusing with its registered trade-mark FLEXIFRAME, as well as being confusing with its common law trade-mark FLEXIFRAME which has been used in Canada since at least as early as August 1982 in association with a frame product.

The applicant filed a counterstatement in which it denied the allegations set forth in the statement of opposition.

The opponent filed as its evidence the affidavit of Joseph E. Arndt while the applicant filed as its evidence the affidavit of Ragnar Beck, together with a certified copy of registration No. 232,945 for the trade-mark FLEX-FRAME standing in the name of Acco World Corporation and covering "Hanging frames for file folders".

Both parties filed written arguments and both were represented at an oral hearing.

The first ground of opposition is based on Section 12(1)(d) of the Act, the opponent alleging that the applicant's trade-mark FLEXIFRAME as applied to the wares covered in the present application is confusing with the its registered trade-mark FLEXIFRAME, registration No. 283,210.

In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between its trade-mark FLEXIFRAME and the opponent's registered trade-mark FLEXIFRAME as of the date of my decision, the material date with respect to grounds of opposition based on Section 12(1)(d) of the Trade-marks Act (see Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. et al, 37 C.P.R. (3d) 413 (F.C.A.) and Conde Nast Publications, Inc. v. The Canadian Federation of Independent Grocers, 37 C.P.R. (3d) 538 (TMOB)).

Considering initially the inherent distinctiveness of the trade-marks at issue, both the applicant's trade-mark FLEXIFRAME as applied to display frames made of plastic for displaying graphic sheet materials and the opponent's registered trade-mark FLEXIFRAME as applied to window components including prefinished wooden members for constructing window frames of various shapes are suggestive of the respective wares of the parties, namely, some type of flexible frame arrangement or construction. As a result, the trade-marks at issue are relatively weak marks possessing limited inherent distinctiveness.

Under paragraph 6(5)(a) of the Act, the Registrar is also required to have regard to the extent to which the trade-marks at issue have become known. In the present case, the Arndt affidavit attests to one specific sale by one of the opponent's distributors located in the United States to a Canadian customer, the sale comprising six FLEXIFRAME window units in August 1982. Further, the affiant makes a number of general statements relating to sales by its distributors located in the United States near the Canadian border "who have both shipped product directly to Canadian retailers and customers who have themselves transported the products over the border into Canada" (paragraph 31, Arndt affidavit). According to Mr. Arndt, the opponent has "continuously sold products under the FLEXIFRAME trademark to Canadian consumers through its distributors in the United States of America, as stated in Paragraph 31, from at least as early as August, 1982" (paragraph 33, Arndt affidavit).

I find it surprising that Mr. Arndt was able to locate an invoice dated in 1982 but was unable to adduce as evidence any other invoices to confirm the alleged "significant" and continuous sales of FLEXIFRAME window units by the opponent's distributors to Canadian customers. I can only assume from the opponent's evidence that the number of sales of FLEXIFRAME window units to Canadian customers have been minor in nature. Further, the opponent's evidence is equally

unconvincing with respect to the distribution of advertising and promotional materials including the trade-mark FLEXIFRAME to Canadian customers or potential customers. As a result, I have concluded that the opponent's trade-mark FLEXIFRAME has not become known to any measurable extent in Canada.

In his affidavit, Ragnar Beck, President of the applicant, attests to in excess of $220,000 in sales and more than $20,000 in advertising of the applicant's FLEXIFRAME frames and display units in Canada from 1987 to 1989 inclusive. I have concluded, therefore, that the applicant's trade-mark FLEXIFRAME has become known to at least some extent in Canada.

The length of time that the trade-marks at issue have been in use favours the opponent in this opposition to the extent that the opponent has evidenced the sale of six of its FLEXIFRAME window units by one of its distributors to a Canadian customer in August 1982 whereas the applicant commenced using its trade-mark FLEXIFRAME in Canada in March 1987.

As the trade-marks at issue are identical, the only remaining criteria for consideration under Section 6(5) of the Act are the nature of the wares and the nature of the trade of the parties. In this regard, the applicant's "display frames made of plastic for displaying graphic sheet materials such as posters, photographs and other artwork, for commercial, industrial and retail use" differ from the opponent's "building materials, namely window components including prefinished wooden members for constructing window frames of varied shapes". In this regard, the applicant's display frames made of plastic do not fall within the same general class as building materials and the applicant's wares would not be considered as being related in any way to window components including prefinished wooden members for constructing window frames.

As for the nature of the trades of the parties, the opponent's wares as defined in its registration would be wares which would be sold either by the manufacturer or its distributors primarily to building contractors or architects for inclusion in commercial or residential buildings. In particular, the wording of the statement of wares set forth in the opponent's registration suggests that the opponent's FLEXIFRAME window components are intended to be sold as fixed lengths of prefinished wooden members which are then cut to size by a contractor to fit the particular non-standard configuration of window being made. As such, I would expect that the opponent's wares would be purchased by relatively sophisticated purchasers such as building contractors, architects, or the like who are involved in the residential or commercial building trades, as opposed to the average unsophisticated consumer of building materials. Further, I would expect the opponent's

wares to be used for fabricating a permanent window frame structure which would not be disassembled once window frame has been installed.

With respect to the applicant's display frames made of plastic for displaying graphic sheet materials, I would assume that such wares would be sold to any type of business that would wish to display advertising, promotional or informational materials either within their premises or at trade shows, exhibitions or the like. I would therefore expect such wares to be relatively portable and readily assembled and disassembled to facilitate changes in the graphic sheet materials being displayed from time to time. In his affidavit, Mr. Beck identifies potential users of his company's display frames as being trade exhibitors, photo laboratories, screen printers, sign makers, and promotional departments and head offices of large corporations. Further, according to Mr. Beck, the applicant's display units can be used to form display tables, product display units, light displays, floors, brochure stands, and wall mounted and ceiling mounted displays.

As a further surrounding circumstance in respect of the issue of confusion, the applicant relied upon the existence of the registration for the trade-mark FLEX-FRAME, registration No. 232,945 covering "Hanging frames for file folders". However, the mere existence of that registration is of no relevance to any of the issues in this opposition as no evidence of use of that trade-mark has been evidenced by the applicant.

As yet a further surrounding circumstance in respect of the issue of confusion, the opponent has relied upon paragraph 38 of the Arndt affidavit in which the affiant states that the opponent is presently developing an expansion of its product line associated with the trade-mark FLEXIFRAME to "include framed art glass (such as stained glass), removable divided lite grille patterns, and the like, for insertion within its window frames and/or for other free-standing uses of such products". However, none of the numerous catalogues or brochures annexed as exhibits to the Arndt affidavit evidence the manufacture or sale by the opponent of wares other than windows including roof windows, sliding doors and components or members used in the construction of these wares. Further, the opponent has only applied its trade-mark FLEXIFRAME to window frames and members used in the construction of window frames, there being no concrete evidence pointing to any effort to extend the use of the trade-mark FLEXIFRAME to other wares. Additionally, I doubt that the possible application of the opponent's trade-mark FLEXIFRAME to stained glass and grille patterns advances the opponent's case to any extent in relation to the issue of confusion between the trade-marks of the parties.

Having regard to the differences in the nature of the wares associated with the trade-marks as issue, as well as the respective channels of trade of the parties, I have concluded that the applicant has met the legal burden upon it of establishing that there would be no reasonable likelihood of confusion between its trade-mark FLEXIFRAME and the registered trade-mark of the opponent. I have therefore rejected the grounds of opposition based on the allegations of confusion between the applicant's trade-mark and the opponent's registered trade-mark FLEXIFRAME.

The remaining grounds of opposition are based on allegations of confusion between the applicant's trade-mark FLEXIFRAME and the opponent's common law trade-mark FLEXIFRAME as previously used in Canada in association with a "frame product". The opponent's description of its wares as a "frame product" is ambiguous as to the specific wares associated with the opponent's common law trade-mark FLEXIFRAME. Assuming, however, that the ground of opposition is in compliance with Section 38(3)(a) of the Act, the opponent's evidence establishes that it had previously used its trade-mark FLEXIFRAME in Canada in association with prefinished window frames, wares which arguably fall within the scope of a "frame product". Further, to the extent that the opponent opposed the present application, it is at least arguable that the opponent has shown that it had not abandoned its trade-mark FLEXIFRAME in Canada as of the date of advertisement of the applicant's application in the Trade-marks Journal (October 19, 1988). Accordingly, I have concluded that the opponent has met the burden upon it under Sections 16(5) and 17(1) of the Trade-marks Act in relation to the Section 16 ground of opposition.

As the opponent has met the initial burden upon it, the applicant must meet the legal burden upon it of establishing that there would be no reasonable likelihood of confusion between its trade-mark FLEXIFRAME as applied to the wares covered in the applicant's amended application and the opponent's trade-mark FLEXIFRAME as applied to prefinished window frames. In this regard, the same criteria applicable in considering the issue of the likelihood of confusion in relation to the Section 12(1)(d) ground are equally applicable in assessing the issue of confusion in relation to the non-entitlement and non-distinctiveness grounds. As a result, and having concluded that the applicant's trade-mark FLEXIFRAME is not confusing with the registered trade-mark FLEXIFRAME as applied to "building materials, namely window components including prefinished wooden members for constructing window frames of varied shapes", I have likewise concluded that the applicant's trade-mark is not confusing with the opponent's common law trade-mark FLEXIFRAME as applied to "prefinished window frames" and have therefore rejected the grounds of opposition based on that trade-mark.

In view of the above, I reject the opponent's opposition pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 31st DAY OF OCTOBER 1994.

G.W.Partington,
Chairman,
Trade Marks Opposition Board.

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