



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2018 TMOB 43**

**Date of Decision: 2018-05-01**

**IN THE MATTER OF AN OPPOSITION**

**Project Futureproof Inc.**

**Opponent**

**and**

**Shane Wolfe**

**Applicant**

**1,594,217 for FUTURE PROOF**

**Application**

FILE RECORD

[1] On August 27, 2013, Shane Wolfe (an individual) filed an application to register the trademark FUTURE PROOF based on use in Canada since November 15, 2011 in association with various related goods and services (subsequently amended on April 2, 2014). A representative abridged listing of the applicant's goods and services is shown below:

*goods*

books, pre-recorded videos, audio programs, webinars, educational literature containing information on environmentally friendly, renewable energy and greenhouse technologies;

windows, and home automation systems components for the control of photo voltaic systems, solar thermal air systems, solar thermal water systems, heating,

ventilation and air conditioning (HVAC) equipment; structural and insulation building materials

computer software for use in developing applications for mobile devices;

*services*

advice and consulting in the field of information technology and control systems, product development; operation of a website providing information on renewable energy, greenhouse technologies, and energy efficiency; educational demonstrations in the field of home energy conservation.

[2] The subject application was advertised for opposition purposes in the *Trademarks Journal* issue dated October 8, 2014, and opposed shortly thereafter, on December 3, 2014, by Project Futureproof Inc.

[3] The Registrar forwarded a copy of the statement of opposition to the applicant on January 6, 2015, as required by s.38(5) of the *Trade-marks Act* R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition. The applicant also requested the Board to rule on the sufficiency of certain paragraphs of the statement of opposition. The opponent responded to the applicant's request by submitting an amended statement of opposition which the Board found satisfactory. The opponent subsequently submitted a second amended statement of opposition to rectify some minor technical deficiencies in the previous version. Further references to the statement of opposition are to the last amended version submitted on August 4, 2015.

[4] The opponent's evidence consists of the affidavits of John Godden and Craig Backman. The applicant elected not to file any evidence in support of its application. Neither party submitted a written argument. Only the opponent was represented at an oral hearing.

STATEMENT OF OPPOSITION

[5] The statement of opposition alleges four grounds of opposition, discussed below.

[6] The first ground, pursuant to section 12(1)(b) of the *Trade-marks Act*, alleges that the applied-for mark FUTURE PROOF is not registrable because it is clearly descriptive of the

applicant's goods and services. In this regard, the opponent pleads that consumers would understand that the applicant's goods and services, sold under the mark FUTURE PROOF, are for the purpose of creating a sustainable, environmentally friendly building.

[7] The second ground, pursuant to sections 10 and 12(1)(e) of the *Act*, alleges that the applied-for mark is not registrable because it is a prohibited mark. In this regard, the opponent pleads that the phrase FUTURE PROOF has by ordinary commercial usage become recognized as meaning "preparing for future changes." That is, the applied-for mark, for use in association with the goods and services specified in the subject application, would be understood as building products and building practices suitable for constructing economically and environmentally sustainable buildings.

[8] Further pleadings in support of the first and second grounds, which essentially summarize the opponent's theory of the case, are found at paras. 3(j) to 3(l) of the statement of opposition:

3(j). A reasonable person in the market for environmentally sustainable construction, education or consultation services in relation thereto would associate the term "Future Proof" with all the wares and services included in the Application. That is, the wares and services applied for are products and services related to the building or renovating of property such that it endures time, growth and change through the use of environmentally conscious methods, products and facilities.

3(k). The term "Future Proof" is defined as a system or product unlikely to become obsolete, to make a system or product ready to meet potential future requirements or make use of potential future opportunities. The term Future Proof has become understood in Canada as relating to developing and implementing strategies, products and technologies to create a sustainable community. Broadly, this includes skills, tools and knowledge to harness resources and capabilities in order to succeed in the future. Specifically, this term includes sustainable homes, energy and infrastructure.

3(l). Several companies, magazines, authors and blog writers in Canada use the term Future Proof to describe preparing for the future, specifically with respect to creating a sustainable community that is economically and environmentally healthy. This includes economic and environmental sustainability through environmentally friendly building practices and products . . .

[9] The third ground, pursuant to section 16(1)(c), alleges that the applicant is not entitled to register the applied-for mark because, at the date of first use of the applied-for mark (November 15, 2011), it was confusing with the opponent's tradename Project FutureProof previously used in Canada.

[10] The fourth ground (pursuant to section 2, although the section is not explicitly pleaded) alleges that the mark FUTURE PROOF does not distinguish the applicant's goods and services from those of the opponent or of others.

[11] Before assessing the grounds of opposition, I will review the opponent's evidence, the evidential burden on the opponent to support the allegations in the statement of opposition, and the legal onus on the applicant to overcome the opponent's allegations.

#### OPPONENT'S EVIDENCE

*Craig Backman*

[12] Mr. Backman identifies himself as a director of the opponent company. He was also Chairman of the Board of The Sustainable Housing Foundation (SHF), a not-for-profit corporation. SHF focuses on increasing sustainability in the residential building sector.

[13] As early as 2009 Mr. Backman was aware that the term FutureProof was being used in the home wiring industry, but not in the energy efficient home industry. He began to meet with John Godden (also a SHF Board member) to discuss how the term could be applied to the energy efficient home industry.

[14] In January 2009 SHF made a presentation to Royal Bank of Canada in an attempt to obtain its sponsorship of SHF's future proofing initiative. Shown below is an extract from a page of the presentation:

A Green home delivers significantly reduced costs due to impacts on both Energy and Water usage, and creates a more durable home

This reduced cost lasts throughout the lifetime of the home, and will only increase as energy costs rise (Future Proofing) (emphasis added)

Lenders should see this as an opportunity to reduce their risk. Traditionally, Gross Debt Service is calculated using Principle[sic], Interest & Taxes (some add Heating costs)

A truly Green Mortgage should include an estimate of total Energy (both savings & production), and Water conservation

[15] In May 2010 SHF held a seminar discussing how builders could work with local governments to adapt new homes to climate change. Shown below are topics discussed at the seminar (see Exhibit 4 of the Backman affidavit):

- How Green are you?
- Builders Roundtable on working with local governments and future proofing new homes to adapt to climate change (emphasis added)
- Working with Municipalities and benefitting from the Green Belt and Green Energy Act Legislation

[16] Project FutureProof Inc. was incorporated in June, 2013. Its website (on or around July 23, 2015, the date of Mr. Backman's affidavit) discusses the following topics (see Exhibit 5 of Mr. Backman's affidavit):

- What is FutureProofing?
- Why should you FutureProof your home?
- FutureProof your home with our Easy to follow 7-Step Process

[17] In January 2011 SHF made a presentation to Enbridge hoping to obtain a sponsorship for its future proofing initiative. Below is an extract taken from the presentation (see Exhibit 8 of Mr. Blackman's affidavit):

### The Concept of Future Proofing

Energy & water costs in Canada are expected to grow by 8-10% per year

Households will come under growing cost pressure

Smart investments in sustainability will “future proof” Canadians  
against increasing costs

[18] In November 2011 Mr. Backman and Mr. Godden made a presentation on future proofing to Brookfield Homes at its head office in Markham: see Exhibits 11 and 12. Subsequent public events explaining the future proofing concept for home construction are discussed at paras. 19g-19i of Mr. Backman’s affidavit, shown below:

g. Around January 31, 2012, SHF held a meeting of the Sustainable Renovations Leadership Team, a group of renovators focussed on applying the concept of futureproofing to renovations . . . I prepared a presentation titled “Sustainability cannot happen if a sustainable approach is not found that works for all the parties involved” which addressed future proofing existing homes, future proofing tools and earth day[sic] community engagement . . .

h. Around April 30, 2013, the Opponent held an Earth Day Event at Kew Beach Junior Public School . . . Toronto . . . The purpose of this event which was sponsored by Scotiabank EcoLiving, SHF and Enbridge, was to educate the community on why they should FutureProof their homes and how they can save money and do what is right for the earth. I was involved with this event . . .

i. Around June 5, 2013, the Opponent held a presentation called the Tori’s Seminar to introduce homeowners in the Toronto Beaches to the FutureProof concept. At this presentation, the Opponent invited the attendees to visit the Website and to sign up for an energy audit of their home . . .

[19] A page from the Toronto Beaches presentation, referred to in quoted paragraph 19i above, is shown below (from Exhibit 16):

Investing in the Energy & Water efficiency of your home today so you save money every year in the future. Each year your savings will increase as the price of energy and water increase.

By using less energy and water, you also reduce your home's harmful impact on the environment.

Save money, save the world ... the best investment you'll ever make.

*John Godden*

[20] Mr. Godden identifies himself as a Director of the opponent company. He describes the opponent's activities in paras. 8 - 11 of his affidavit:

8. The Opponent provides a variety of consulting services, including consulting services to residential builders regarding residential home energy construction and construction rating. It provides builders and renovators with techniques and products that can be incorporated into construction and renovation projects to improve energy and water efficiency and durability.

9. The Opponent is involved in the integrated design process, helping builders, designers and manufacturers design and construct sustainable housing. That is, it provides consulting services which assist builders in increasing the energy efficiency, durability and healthiness of the homes they build. I, along with other members of the residential energy rating industry, use the term "future proof" in association with the marketing of the goods and services that form part of this industry. The Opponent has worked with over 30 builders in this way.

10. The Opponent provides energy ratings on residential buildings and is sponsored by various companies to promote and educate its clients about certain products and building materials. The Opponent's sponsors include businesses that are involved in various aspects of the field of sustainable buildings and homes, sustainable technology and energy efficiency. . .

11. Through its involvement with The Sustainable Housing Foundation ("SHF"), a not-for-profit corporation incorporated under the laws of Canada with a mandate to significantly increase the number of sustainable homes in Canada, the Opponent is involved in various promotional and educational activities . . . with the purpose of promoting sustainable housing in Canada . . .

[21] In May 2010 SHF held a seminar for builders and manufacturers to strengthen the sustainable housing industry. One of the sessions was "Builders Roundtable on working with local governments and future proofing new homes to adapt to climate change" (see Exhibit 5 of

Mr. Godden's affidavit). It was the first instance where Mr. Godden spoke publicly on the concept of future proofing.

[22] At the time of the May 2010 seminar (and as of the date of his affidavit July 22, 2015) Mr. Godden was president of an Ontario company carrying on business as Clearshpere. The company provides consulting on residential energy efficiency and sustainability, home evaluation, home-testing, and training to builders in the Greater Toronto Area and Southern Toronto. Mr. Gordon believes that future proofing describes the character of the services provided by Clearshpere.

[23] Mr. Gordon discusses the meaning of the term "future-proof" (substantiated by Exhibit materials) at paras. 20-21 of his affidavit:

20. Through [www.google.ca](http://www.google.ca) ("Google Canada") I have accessed the Oxford English Dictionary (the "OED") and reviewed the two definitions of "future-proof" . . . when used as an adjective and as a verb.

21. When used as an adjective, the OED defines "future-proof" to mean "protected from the consequences of future events; esp. (of a product) designed in a manner that provides against rapid obsolescence." . . . the definition was added as a new entry to the OED Third Edition (March 2002) . . .

22. The OED defines "future-proof" when used as a verb as follows: "trans. Of a product, business, etc.: to equip for or protect against future developments; to design in a manner aimed at preventing rapid obsolescence". . . the definition was added as a new entry to the OED Third Edition (March 2002) . . .

[24] Mr. Godden explains his own understanding of the term "future-proof" at paras. 23 and 24 of his affidavit:

23. In the context of the Industry [energy efficient home industry in Canada], I understand the description of a building or house as being future proof (or futureproof or future-proof) to mean that steps have been taken to make the building or house more durable and energy and/or water efficient and, therefore, it describes the sustainable character of the building or house.

24. Similarly, when discussing the act of future proofing (or futureproofing or future-proofing) a building or house in the Industry, I understand this to refer to the process of making the building or house more durable and energy efficient so as to equip the building or house for, or protect it against, future events such as raising energy prices.



[25] The remainder of Mr. Godden’s affidavit demonstrates, through extensive exhibit materials, how the term “future proof” has been used, in the context of quoted paras. 23 and 24 above, in many publications - both before and after the date of filing (August 27, 2013) of the subject application. Some examples, and dates of publication, are shown below:

*Exhibit 20 (February 2003)*

**Future-Proofing Your Building: Designing for Flexibility and Adaptive Reuse**

Some 2,500 years ago, the Greek philosopher Heraclitus made headlines when he proposed that nothing is permanent but change . . . modern-day philosopher Stewart Brand translated Heraclitus’ insight into the language of design: “A building is not something you finish. A building is something you start.”

*Exhibit 21 (March 17, 2008)*

**New Toronto waterfront development will have a “future proof” energy centre**

The plant will initially be powered by natural gas but the design will incorporate the necessary features for ready conversion to more sustainable, alternative fuel sources when they are approved for urban use. The “future-proof” system will make the new waterfront neighborhood a more efficient and sustainable user of energy in years to come.

*Exhibit 27 (November 24, 2011)*

**Innovative Policy Ideas**

Helping building owners future-proof their properties and cut energy bills . . .

LEGAL ONUS AND EVIDENTIAL BURDEN

[26] As mentioned earlier, before assessing the grounds of opposition, it is necessary to review (i) the initial evidential burden on the opponent to support the allegations in the statement of opposition and (ii) the legal onus on the applicant to prove its case.

[27] With respect to (i) above, there is in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 CPR (3d) 293 at 298 (FCTD). The presence of an evidential burden on the opponent with respect to a

particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on the applicant to show that the application does not contravene the provisions of the *Trade-marks Act* as alleged by the opponent in the statement of opposition - for those allegations for which the opponent has met its evidential burden. The presence of a legal onus on the applicant means that if a determinate conclusion cannot be reached (on the usual civil balance of probabilities standard) once all the evidence is in, then the issue must be decided against the applicant.

FIRST GROUND OF OPPOSITION PURSUANT TO SECTION 12(1)(B)

[28] Section 12(1)(b) reads as follows:

12 (1) Subject to section 13, a trademark is registrable if it is not

. . . .

(b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the goods or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin;

[29] The test for section 12(1)(b) is one of first or immediate impression, considered from the perspective of the average consumer of the goods or services. The meaning of a trademark must be considered in the context of the goods and services; “character” in section 12(1)(b) means a feature, trait or characteristic of the product and “clearly” does not mean the description has to be precise but must be “easy to understand, self-evident or plain”: see *Drackett Co. of Canada Ltd. v. American Home Products Corp.* (1968) 55 CPR 29 at 34 (Ex. Ct.); *Drolet v. Stiftung Gralsbotchaft*, (2009) 85 CPR (4th). For a mark to be clearly descriptive within the meaning of section 12(1)(b), a mark must be so apt for normal description of the goods or services that a monopoly on the use of it should not be acquired: see *Clarkson Gordon v. Registrar of Trademarks* (1985) 5 CPR (3d) 252 at 256 (FCTD). The material time to assess whether a mark contravenes section 12(1)(b) is the date of filing of the application, in this case August 27, 2013:

see *Fiesta Barbecues Ltd. v. General Housewares Corp.*, (2003) 28 CPR (4th) 60 (FC) at para. 26.

[30] Further, to determine whether a trademark is registrable under s. 12(1)(b), the Registrar must not only consider the evidence but also apply common sense: *Neptune S.A. v. Attorney General of Canada* (2003) 29 CPR (4th) 497 (FCTD). One of the most important purposes of section 12(1)(b) is to protect the right of all traders to use apt descriptive language. The courts have recognized that descriptive words are the property of all and cannot be appropriated by one person for their exclusive use: see *General Motors Corp. v. Bellows* (1949) 10 CPR 101 (SCC) at pp. 112-113.

[31] I find that the opponent's evidence at least meets the threshold of its evidential burden to put into issue whether the term "future proof" is clearly descriptive of the applicant's goods and services. Mr. Godden's evidence in particular supports the opponent's position that, at the material date August 27, 2013, the average consumer of the applicant's goods and services would, as a matter of first impression, easily understand that the goods and services are intended to provide materials and services suitable for constructing housing that is sustainable notwithstanding changing environmental and economic circumstances. The applicant, for its part, has not provided any evidence, or argument, to counter the opponent's allegations nor has the applicant challenged the probative value of opponent's evidence through cross-examination. Accordingly, I find that the applicant has not met the legal onus on it to show that the applied-for mark does not contravene section 12(1)(b). The opponent therefore succeeds on the first ground of opposition.

#### SECOND GROUND OF OPPOSITION PURSUANT TO SECTIONS 10 AND 12(1)(E)

[32] The opponent has alleged that the applied-for mark FUTURE PROOF is not registrable because the term "future proof" has by ordinary and *bona fide* commercial usage become recognized in Canada as designating the kind and quality of the goods covered in the subject application. Section 10 reads as follows:

Where any mark has by ordinary and bona fide commercial usage become recognized in Canada as designating the kind, quality, quantity, destination, value, place of origin or date of production of any goods or services, no person shall adopt it as a trade-mark in association with such goods or services or others of the same general class or use it in a way likely to mislead, nor shall any person so adopt or so use any mark so nearly resembling that mark as to be likely to be mistaken therefor. (emphasis added)

[33] This Board has accepted that the material date for determining the “ordinary and *bona fide* commercial usage” of the mark in Canada for the purposes of s.10 is the date of the Board’s decision: see, for example, *Sealy Canada Ltd. v. Simmons I.P. Inc.* (2005) 47 CPR (4th) 296 (TMOB), which follows *Canadian Olympic Assn. v. Olympus Optical Co.* (1991) 38 CPR (3d) 1(FCA); *contra*, see *ITV Technologies, Inc. v. WIC Television Ltd.* (2003), 2003 FC 1056 (CanLII), 29 CPR (4th) 182 (FC) where the material date was taken as the date when the mark was first used in Canada, affirmed 2005 FCA 96 (CanLII), 38 CPR (4th) 481, which follows *Carling Breweries Ltd. v. Molson Companies Ltd. et al.*, (1982) 1 CPR (3d) 191(FC), reversing 70 CPR (2d) 154 (TMOB), affirmed 19 CPR (3d) 129 (FCA).

[34] The relevant test for s.10 is that the mark must have been commonly used in Canada at the relevant time as designating an aspect of the goods or services which are the subject of the mark: see para. 88 of *ITV Technologies*, above.

[35] As with the first ground of opposition, I find that the opponent’s evidence at least meets the threshold of its evidential burden to put into issue whether the term “future proof” is a prohibited mark. Mr. Godden’s evidence in particular supports the opponent’s position that, as of either of the material dates November 15, 2011 or today’s date, the term “future proof” has been commonly used in Canada as designating an aspect of the applicant’s goods or services, namely, that they are of a kind and quality suitable for constructing housing that is sustainable despite changing environmental and economic circumstances.

[36] Again the applicant, for its part, has not provided any evidence to counter the opponent’s allegations nor has the applicant challenged the probative value of the opponent’s evidence through cross-examination. Accordingly, I find that the applicant has not met the legal onus on it to show that the applied-for mark does not contravene section 10 at either of the material dates

November 15, 2011 or today's date. The opponent therefore succeeds on the second ground of opposition.

[37] As the opponent has succeeded on the first and second grounds, it is not necessary for me to deal with the remaining grounds. I would add, however, that the opponent would likely have succeeded on the third and fourth grounds on the same basis that the opponent succeeded on the first and second grounds, that is, the opponent has likely met its initial evidential burden to put the allegations of confusion and non-distinctiveness into issue, while the applicant has not provided any evidence or argument to counter the opponent's allegations.

DISPOSITION

[38] In view of the foregoing, the subject application for FUTURE PROOF is refused.

[39] This decision has been made pursuant to a delegation of authority by the Registrar of Trademarks under s.63(3) of the Trade-marks Act.

---

Myer Herzig  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

**APPEARANCES AND AGENTS OF RECORD**

**HEARING DATE** 2018-02-20

**APPEARANCES**

Kenneth Clark

FOR THE OPPONENT

**AGENTS OF RECORD**

Aird & Berlis LLP

FOR THE OPPONENT