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TRANSLATION
THE REGISTRAR OF TRADE-MARKS

Citation: 2018 TMOB 77

Date of Decision: 2018-07-16

**[UNREVISED ENGLISH
CERTIFIED TRANSLATION]**

IN THE MATTER OF AN OPPOSITION

Protech Chemicals Ltd./Protech Chimie
Ltée.

Opponent

and

PROTECH S.A.M.

Applicant

1,601,601 for PROTECH Design

Application

INTRODUCTION

[1] Protech Chemicals Ltd./Protech Chimie Ltée. (the Opponent) opposes the registration of the PROTECH Design trade-mark (as illustrated hereinafter) (the Mark), covered by application No. 1,601,601 in the name of PROTECH S.A.M. (the Applicant):

ProTech

[2] In filing the application, the Applicant intentionally amended its application so that the statement of goods and services now reads as follows:

[TRANSLATION] (1) Chemicals used in the industry, namely chemical compositions for protection of varnishes and paints for all automobile vehicles, nautical vehicles and aeronautical vehicles, chemical compositions for protection of fabrics and textiles.

(2) Cleaning, buffing and polishing goods, namely cleaners, waxes, chamois, shampoos, polishes, renewers, stain removers for automobile vehicles, sports utility vehicles and minivans, nautical vehicles and aeronautical vehicles; goods for renewal and restoration of painted and varnished surfaces, namely cleaners, buffers, waxes, shampoos, polishes, renewers, stain removers for automobile vehicles, sports utility vehicles and minivans, nautical vehicles and aeronautical vehicles; goods for renewal and restoration of automobile vehicle bodies, boat hulls and aircraft cabins, namely cleaners, buffers, shampoos, polishes, renewers, stain removers, anti-tar, anti-resin and anti-adhesive goods, aerosol primers, paint, stripper, cleaning solvents, joint filler, disposable masks, body fillers, glass cleaners, waxes, odour destroyers; cleaners for fabrics, textiles, leathers, imitation leathers and plastics; goods for conditioning and protecting leather; goods for protecting imitation leathers, namely cleaners, nourishing care, stain removers, creams, lubricants and waxes, sponges; goods for removing tar stains, grease stains and paraffin, namely oils, aerosols, cleaners and strippers; cleaners and glazing agents for windows; cleaners for vehicle tires; goods to polish and buff tires, namely silicones, degreasers, polishes, cleaners; engine cleaners; vehicle wheel rim cleaners; cleaning foams for polishers and buffers; goods for protecting engines against dirt and moisture, namely buffers, waxes, cleaners.

(1) Provision of cleaning, buffing, waxing services for automobile vehicles, sports utility vehicles and minivans, nautical vehicles and aeronautical vehicles; provision of preparation, cleaning, buffing, paint and varnish maintenance services for automobile vehicles, boat hulls, aircraft cabins; provision of cleaning and protection services for fabrics and textiles, carpets and rugs, leathers, imitation leathers and all vehicle interior plastic parts; cleaning of vehicles, cleaning of vehicle engines; varnishing and buffing of vehicle engines; application of films on windows, metal surfaces and glazed surfaces.

(2) Tinting windows by surface treatments; application of protective coats to varnished and painted surfaces; treatment of varnished and painted surfaces; application of protective coats and treatment of paints and varnishes on automobile vehicle bodies, nautical vehicles and aeronautical vehicles; treatment and application of surface coatings, particularly application of plastic, PVC or polyester films on glazed and metal surfaces, coloured films for metal and glass, protective films for glazed and glass surfaces, PVC or adhesive polyester films; treatment and application of polyurethane films on automobile vehicle bodies, nautical vehicles and aeronautical vehicles.

[3] Unless otherwise indicated, the use of “Goods” in the decision is a collective reference to the goods stated in (1) and (2) above. Also, the use of “Services” is a collective reference to (1) and (2) above.

[4] The registration application, originally filed on November 8, 2012, is based on the proposed use of the Mark in Canada and its registration in Monaco.

[5] The Opponent bases its opposition on sections 30(b), (e) and (i), 16(2)(a) and (c), 16(3)(a) and (c) and 2 (distinctiveness) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[6] I consider it appropriate to refuse the application in part.

THE RECORD

[7] The statement of opposition was filed on September 4, 2015. On November 16, 2015, the Applicant filed a counter statement denying the grounds of opposition argued by the Opponent.

[8] In support of its opposition, the Opponent filed an affidavit by David Ades to which Exhibits A to M are attached.

[9] For its part, the Applicant filed the affidavit of Thomas James, to which Exhibit TJ-1 is attached.

[10] Only the Applicant filed a written argument and no hearing was held.

PRELIMINARY REMARKS

[11] I have studied all the evidence of record. I will refer in my decision only to the points that appear relevant to rule on the question in dispute.

EVIDENTIARY BURDEN

[12] It is initially up to the Opponent to establish that its opposition is well-founded. However, the legal onus of showing that the Mark is registrable rests with the Applicant, according to the balance of probabilities [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

RELEVANT DATES

[13] The relevant dates to analyze the grounds of opposition raised by the Opponent are:

- the filing date of the application (November 8, 2012) for the grounds based upon sections 30(b), (e) and (i) of the Act [see *Canadian National Railway Co v Schwauss* (1991), 35 CPR (3d) 90 at p. 94 (TMOB) and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 (TMOB)];
- the filing date of the registration application (November 8, 2012) for the grounds based upon sections 16(2) and (3) of the Act [see sections 16(3) and (3) of the Act]; and
- the filing date of the statement of opposition (September 4, 2015) for the ground based upon section 2 of the Act (non-distinctiveness of the Mark) [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

GROUND OF OPPOSITION SUMMARILY REJECTED

[14] For the grounds of opposition based upon sections 30(b) and (e) of the Act, it is recognized that the Opponent may discharge its initial burden by referring to the evidence adduced by the Applicant [see *Labatt Brewing Company v Molson Breweries, Partnership* (1996), 68 CPR (3d) 216 (FCTD)]. However, this evidence must raise serious doubts [see *York Barbell Holdings Ltd v ICON Health and Fitness, Inc* (2001), 13 CPR (4th) 156 (TMOB)].

[15] In the case at bar, the Opponent's evidence is limited to its commercial activities. No element of its evidence that could support the grounds of opposition based on sections 30(b) and (e) of the Act.

[16] Regarding the Applicant's evidence, as more fully described later, it is limited to evidence taken from the Canadian Trade-mark Registry. Thus, it can be of no use to the Opponent in support of these grounds of opposition.

[17] Consequently, the grounds of opposition based on sections (30)(b) and (e) of the Act are rejected, because the Opponent did not fulfill its initial burden.

[18] Regarding the ground of opposition based on section 30(i) of the Act, this section requires only that the Applicant declares it is satisfied it has the right to use the Mark in Canada in association with the Goods and Services. This statement is included in the present application for registration.

[19] However, this section of the Act may be invoked in support of a ground of opposition and in very specific cases, such as when the Applicant's statement was made in bad faith [see *Sapodilla Co Lt. v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)].

[20] Yet there is no evidence of this nature on the record. I therefore reject this ground of opposition, as the Opponent has not discharged its initial burden.

GROUND OF OPPOSITION BASED ON SECTIONS 16 (RIGHT TO REGISTRATION) AND 2 (DISTINCTIVENESS) OF THE ACT

[21] To satisfy its initial burden under sections 16(2) and (3) of the Act, the Opponent had to prove the use of its trade-marks and its trade names in Canada before the filing date of this registration application (November 8, 2012) and that it had not discontinued them as of the date of publication of the Applicant's registration application (April 8, 2015) [see sections 16(2) and 16(3) of the Act and *Optic Nerve Art & Design Ltd v Optic Nerve Design*, 2005 CanLII 78205, 2005, CarswellNat 4726 (TMOB)].

[22] To satisfy its initial burden under the ground of opposition based upon the non-distinctiveness of the Mark, the Opponent had to prove that its trade-marks or trade names were known in Canada or well known in one specific area of Canada as of the filing date of its statement of opposition, such that the Mark could not be distinctive of the Goods and Services at that date [see *Bojangles' International, LLC v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427 (FC)].

[23] The difference between the relevant dates associated with these grounds of opposition will have no impact on the fate of these grounds of opposition, such as it appears from their analysis.

[24] I must point out that these grounds of opposition, as argued in the statement of opposition, refer to the following trade-marks:

- PROTECH
- PROTECH/OXYPLAST
- PROTECH/OXYPLAST & Design
- PROTECH POWDER
- PROTECH GROUP

(collectively referred to as “the Opponent’s PROTECH marks”);

and the following trade names:

- Protech/Oxyplast
- Protech Powder
- Protech Group

(collectively referred to as “the Opponent’s PROTECH trade names”);

Opponent’s Evidence

[25] Mr. Ades is the Opponent’s General Manager and has held this position since 1994. He declares that he has access to the Opponent’s books and has personal knowledge of the facts described hereinafter or that they were taken from the Opponent’s archives.

[26] Mr. Ades explains that the Opponent was constituted in 1976 and is a world leader in the development and manufacturing of powder coatings. It has facilities in the United States, Belgium and the Czech Republic.

[27] Mr. Ades affirms that the Opponent sells its powder coatings worldwide, including in Canada. He adds that, since its creation in 1976, the Opponent has used the word PROTECH as a trade-mark and trade name and has used the Opponent’s PROTECH Marks over the years.

[28] Mr. Ades affirms that the Opponent has its head office in Montréal, Quebec and places of business all over the world.

[29] At this stage, I wish to make the following remark: Mr. Ades describes the Opponent’s activities around the world in detail, including the use of the Opponent’s PROTECH marks. Yet as the Applicant points out, only the use of the Opponent’s PROTECH marks in Canada, and the use of the Opponent’s PROTECH trade names in Canada, are relevant for the purposes of this

case. Therefore, I will limit myself to summarizing the facts described by Mr. Ades concerning the Opponent's commercial activities in Canada. In so doing, a large part of Mr. Ades' affidavit will not be summarized although, from time to time, I refer to certain allegations concerning the use of the Opponent's PROTECH marks worldwide, which could include Canada.

[30] Mr. Ades' describes the Opponent's goods as thermohardening or thermoplastic powder coatings. He adds that the thermohardening powder coatings generally are applied on the surfaces of metal goods, including automobile chassis and underbodies, train parts, furniture and lighting equipment. The thermoplastic powder coatings generally are applied to a variety of metal goods, including urban furniture, infrastructure pipes and automobile springs.

[31] Mr. Ades adds that, over the years, the Opponent's goods have been sold and delivered in boxes bearing the Opponent's PROTECH marks and the Protech trade name, accompanied by an information sheet bearing these mentions. As Exhibit D to his affidavit, he filed photographs of boxes in which powder coating sold in Canada and the United States are packed. We indeed notice the following logo on the boxes:



[32] However, Mr. Ades does not indicate precisely since when these boxes have been used in Canada to pack the Opponent's powder coating goods. Thus, it is impossible to conclude that these boxes were used prior to the relevant dates. Moreover, the photographs filed as Exhibit D to Mr. Ades' affidavit were taken on March 10, 2016, subsequent to the relevant dates associated with the grounds of opposition under study.

[33] Mr. Ades affirms that the Opponent, since 1976, has continuously used the Opponent's PROTECH marks and its Protech trade name, affixing them to the packaging of its goods, and to its letterhead, envelopes, invoices, information sheets and website. He filed a sample of these materials as Exhibit E to its affidavit.

[34] It is a good idea to reproduce the two different graphics that appear on the envelopes and letterhead filed on the record.



[35] We see the word “PROTECH” and a design. The distinction between the two graphics will have no influence on this decision. However, I will use the expression PROTECH & Design to refer to the first of these trade-marks.

[36] Exhibit E to Mr. Ades’ affidavit contains a letterhead on which the trade-name Protech Coatings Inc. appears, but this is an entity located in the United States. I presume it is used in that country and not in Canada. I will not consider this evidence on the record.

[37] There is also a brochure bearing the mention “THE PROTECH GROUP”. However, Mr. Ades does not tell us if it was distributed in Canada, and if this was the case, since when, and finally, the number of copies distributed.

[38] Mr. Ades provides the annual sales figures in Canada since 2010, for powder coatings in association with the PROTECH trade-mark and trade name. These sales annually exceed 30 million Canadian dollars.

[39] Mr. Ades affirms that the goods bearing the PROTECH trade-mark and trade name were sold to industrial customers in Canada directly through the Sales Department and through salespersons on the Opponent’s route. To this effect, as Exhibit F to his affidavit, he filed a bundle of invoices proving the sale and shipping of the Opponent’s powder coating goods to Canadian and American customers. They bear the trade-name Protech Chemicals Ltd./Protech Chimie Ltée. and the trade-mark PROTECH & Design.

[40] Mr. Ades provides the annual volume of units sold in Canada, which is between four and five thousand tonnes of powder coatings.

[41] Mr. Ades adds that the Opponent's powder coatings, for the past several years, and well before November 8, 2012, have been the subject of promotional campaigns in Canada during trade shows and special events. Moreover, these goods are advertised on the Opponent's website. As Exhibit G to his affidavit, he filed excerpts from this website, describing the Opponent's different goods offered for sale and delivery to Canadian customers and customers worldwide. The trade-mark that appears on the website is PROTECH/OXYPLAST and design.

[42] Mr. Ades provides a list of trade shows in which the Opponent participated or will participate in order to promote its powder coatings. However, as the Applicant points out in its written argument, none of these activities was conducted or will be conducted in Canada. Thus, it is useless to describe Mr. Ades allegations concerning them, including the description of the Opponent's stands at these trade shows.

[43] Mr. Ades provides the amounts spent by the Opponent worldwide for promotion of its powder coating sales in association with the Opponent's PROTECH marks and its Protech trade name. Nonetheless, no information is provided concerning the amounts of money allocated to promotion in Canada.

[44] Mr. Ades adds that the Opponent promotes its powder coatings and its company through social media, such as Twitter, and he filed excerpts from the Opponent's website showing recent tweets.

[45] As Exhibit K to his affidavit, Mr. Ades filed copies of advertising published in magazines and newspapers circulated in Canada and the United States. However, no information is provided regarding the number of copies of these magazines or newspapers in circulation in Canada. Moreover, only the PROTECH & Design and PROTECH/OXYPLAST and Design trade-marks appear in this advertising.

[46] Finally, Mr. Ades affirms that in 2016, the Opponent celebrated its 40th anniversary. To this effect, as Exhibit M to his affidavit, he filed a poster used to promote this event, in which the PROTECH & Design trade-mark appears.

Applicant's Evidence

[47] Mr. Thomas James is a trade-mark analyst with Thomson CompuMark, a firm specializing in trade-mark searches. At the request of the Applicant's agents, he conducted a dilution search of the Canadian Trade-mark Registry for "PROTEC" under various spellings (PROTEC, PROTECK, PROTEK, PROTEX, PROTEQUE, PROTEQ, PROTECT, PROTEKT, PROTEQT OR PROTECHT) in association with anti-rust goods, paint, varnish, cleansers, degreasing oil, etc.

[48] Mr. James filed the results of this search, which show the presence in the Registry of a large number of trade-marks containing the word "PROTEC" under various spellings, with or without graphics, in association with such goods. I will return later in detail to this evidence of the state of the register.

Analysis of Evidence of Record

[49] I notice that among the list of its trade names, the Opponent did not identify, in its statement of opposition, the trade-name Protech Chemicals Ltd./Protech Chimie Ltée., which appears on certain exhibits filed by Mr. Ades. Thus, I cannot take it into account in my analysis to come [see *Massif Inc v Station Touristique Massif du Sud* (1993) Inc 2011 FC 424, 95 CPR (4th) 249 (FCTD)].

[50] Mr. Ades filed photos of packing boxes bearing the PROTECH & Design mark. However, I have no evidence that these boxes were used in Canada prior to the relevant dates, as discussed previously.

[51] Mr. Ades filed invoices for the sale of goods in Canada. I agree with the Applicant that the invoices do not show the sale of goods in association with the PROTECH mark. However, these invoices bear the PROTECH & Design mark. Thus, the Opponent proved the use of the PROTECH & Design trade-mark in association with the powder coating sales services. In addition to the invoices filed bearing the PROTECH & Design trade-mark are the letterheads and envelopes bearing the PROTECH & Design mark.

[52] However, I have no evidence of record of the use of the PROTECH or PROTECH & Design trade-marks in association with goods. Indeed, as mentioned by the Applicant in its written argument, the advertising pamphlets, brochures or excerpts from the Opponent's website do not attest to the use of these trade-marks in association with the goods within the meaning of section 4(1) of the Act.

[53] In light of the Opponent's evidence previously described, and despite the fact that I agree with the Applicant that the Opponent put the emphasis on its international activities, I find that the Opponent discharged its onus of proving the use prior to November 8, 2012 of the PROTECH & Design, PROTECH OXYPLAST and PROTECH OXYPLAST and Design marks in association with the powder coating sales services and that they were known in Canada as of September 4, 2015.

[54] However, I consider that the use of the PROTECH & Design mark constitutes a use of the PROTECH word mark [see *CPSA Sales Institute v Groupe Conseil Parisella Vincelli Associés Inc*, 2005 CarswellNat 2788 (TMOB)].

[55] It is therefore incumbent on the Applicant to prove, according to the balance of probabilities, that the use of the Mark in association with the Goods was not confusing with the Opponent's PROTECH, PROTECH & Design, PROTECH OXYPLAST and PROTECH OXYPLAST and Design trade-marks.

Analysis of the criteria enumerated in section 6(5) of the Act

[56] The test to apply in the matter of confusion is stated in section 6(2) of the Act. This test does not address confusion between the marks themselves, but rather confusion regarding the source of the Goods. Thus, I must determine whether a consumer who has an imperfect memory of the Opponent's PROTECH, PROTECH & Design, PROTECH OXYPLAST and/or PROTECH OXYPLAST and Design marks and who sees the Mark used in association with the Goods and Services, would believe they are offered or authorized by the Opponent.

[57] I evaluate that the Opponent has better chances of success with its PROTECH mark in association with its services since, on the one hand, the PROTECH OXYPLAST and PROTECH

OXYPLAST and Design marks contain the word “OXYPLAST”, which serves to distinguish these marks from the Mark, and the PROTECH & Design contains a distinctive graphic element.

[58] I must take into account all relevant circumstances, including those listed in section 6(5) of the Act, i.e. the inherent distinctiveness of the trade-marks and the extent to which they have become known; the period during which the trade-marks have been in use; the nature of the goods, services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. This list is not exhaustive and it is unnecessary to assign the same weight to each of these factors [see *Mattel Inc v 3894207 Canada Inc* 2006 SCC 22, 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* [2006] 1 SCR 824, 2006 SCR 23; and *Masterpiece Inc v Alavida Lifestyles Inc et al* 2011 SCC 27, 92 CPR (4th) 361 (SCC) for a more in-depth analysis of the general principles governing the test for confusion].

Degree of Resemblance

[59] The resemblance certainly is more pronounced when I compare the Mark with the PROTECH mark than with the Opponent’s other marks. Indeed, the marks involved are identical both phonetically and in the ideas they suggest. Regarding the comparison of the Mark with the Opponent’s PROTECH OXYPLAST and PROTECH OXYPLAST and Design marks, there are visual and phonetic differences with the addition of the term “Oxyplast”.

[60] This factor therefore favours the Opponent regarding the comparison between the Mark and the Opponent’s PROTECH mark. In the circumstances, the analysis of the other relevant criteria will play a determining role in the fate of this opposition.

Inherent distinctiveness of trade-marks and the extent to which they have become known

[61] Needless to say, the word “PROTECH” is highly suggestive, to say the least, if not descriptive of the quality of the parties’ goods and services. The Applicant argues that the Mark has an inherent distinctiveness due to its visual, namely the use of a special font and the

capital T. I do not believe that the graphic portion of the Mark makes a significant additional contribution to the Mark's low degree of distinctiveness. It is therefore a very weak trade-mark.

[62] As for the Opponent's PROTECH mark, it is also highly suggestive, if not descriptive of the powder coating sales services. It also benefits from very weak distinctiveness.

[63] The distinctiveness of a mark may be enhanced through its use and promotion.

[64] There is no evidence of record of the use or promotion of the Mark in Canada.

[65] As described above, the Opponent proved the use of its PROTECH mark in association with the powder coating sales services.

[66] In the circumstances, this factor favours the Opponent.

Period of use of the trade-marks or trade names

[67] Such as it appears from the evidence summarized above, this factor favours the Opponent, which proved the use of its PROTECH trade-mark since January 1976, whereas there is no evidence of use of the Mark in Canada.

Type of goods, services or enterprises and the nature of the trade

[68] The Applicant argues that the Opponent's powder coatings are distinguished from the Goods that are very precisely described in this registration application. I do not agree with the Applicant's very restrictive interpretation concerning certain Goods and Services.

[69] Mr. Ades affirms in his affidavit, as mentioned above, that the Opponent offers sales services for the Opponent's powder coatings, which are applied to metal surfaces, such as automobile bodies and automobile underbodies, train parts, all kinds of equipment, furniture and lighting equipment.

[70] Such as it appears from the statement of Goods and Services, in most instances, these are chemicals or chemical compositions, varnishes and paints for different types of vehicles. I find there is an overlap between the Opponent's powder coating sales services and the Goods and Services, except for the following goods and services:

Cleaning goods, namely chamois, shampoos, for automobile vehicles, sports utility vehicles and minivans, nautical vehicles and aeronautical vehicles; goods for renewal and restoration of painted and varnished surfaces, namely shampoos for automobile vehicles, sports utility vehicles and minivans, nautical vehicles and aeronautical vehicles; goods for renewal and restoration of automobile vehicle bodies, boat hulls and aircraft cabins, namely shampoos, disposable masks, body sealers, glass cleaners, and odour destroyers; cleaners for fabrics, textiles, leathers, imitation leathers; goods for conditioning and protecting leather; goods for protecting imitation leathers, namely sponges; cleaners and buffing agents for windows.

(1) Provision of cleaning services for fabrics and textiles, carpets and rugs, leathers, imitation leathers and all vehicle interior plastic parts; cleaning of vehicles, cleaning of vehicle engines; application of films on windows and glazed surfaces.

(2) Treatment and application of surface coatings, particularly application of protective films for glazed and glass surfaces.

[71] Unless otherwise indicated, the use of “Non-Similar Goods” in the decision is a collective reference to the above-mentioned goods. Also, the use of “Non-Similar Services” is a collective reference to the services enumerated above in (1) and (2).

[72] The Applicant argues that the Goods are not likely to be found in the same distribution niches as the Opponent’s goods since, as provider of services associated with its Goods, the Applicant will sell its Goods under its own banner and will not sell the Opponent’s Goods in any case.

[73] There is no evidence of record to support such an argument. The Applicant chose not to adduce evidence concerning its commercial activities. In the circumstances, we must rely on the description of the goods and services of the parties. As mentioned above, I find there is an overlap between the Opponent’s powder coating sales services and the Applicant’s Goods and Services, except for the Non-Similar Goods and Non-Similar Services.

[74] The Applicant also argues that the Opponent did not allege or adduce as evidence the use of the PROTECH mark or its trade names in association with services. According to the Applicant, there would be no question of overlap concerning the Services.


[75] With all due respect for the contrary opinion, this reasoning does not hold the road. First of all, in its statement of opposition, the Opponent alleged the use of its different PROTECH marks in association with services. Moreover, it proved the use of its PROTECH and PROTECH

& Design trade-marks in association with the powder coating sales services. On this subject, I refer, by way of example, to the invoices filed on the record (Exhibit F to Mr. Ades' affidavit). There is a connection between the powder coating sales services and the Applicant's Goods and Services, except for the Non-Similar Goods and Non-Similar Services.

Other Relevant Factors

State of the Register

[76] As mentioned above, the Applicant adduced state of the register evidence. In its written argument, it reproduced 33 of the 101 citations, considered the most relevant. I agree with the Applicant that at least ten relevant citations exist, including these:

Trade-mark	Registration number	Goods and services
PROTEX	TMA740,249	<i>Chemical automotive fuel system cleaners</i>
PROTEK	TMA564,859	<i>Interior and exterior surface sealers</i>
	TMA558,260	<i>Interior and exterior surface sealers</i>
PROTEK	TMA835,484	Nettoyants pour toutes surfaces lavables [Cleaners for all washable surfaces]
PROTEX	TMA924,820	<i>Paint protection film for use on new and used vehicles, motorbikes, boats and planes.</i>
PROTECT	TMA646,069	Reconstruction, repair, servicing, dismantling, cleaning, maintenance and varnishing of vehicles, motors and their parts, including, vehicle repair in the course of vehicle breakdown service.
PROTEX	TMA728,279	Polymeric fabric laminate used as an intermediate barrier to prevent bulk moisture infiltration in building envelopes and vehicle envelopes.
PROTEX	TMA264,053	<i>Chemical composition to be applied to a metal surface preventing adherence of slag or metal spatter during cutting, gouging, or welding operations, preventing scaling of metal surfaces during heat treating or stress relieving treatment, and improving arc stability and preventing excessive spatter loss</i>

		<i>during arc welding operations.</i>
PROTECT IT ALL	TMA656,614	Exterior coatings, namely, natural oil wood finish, deck finish and roof coatings in the nature of paints. Exterior coatings, namely, anti-graffiti coating. Exterior coatings, namely, clear sealers for concrete and wood. All surface cleaner used to prepare surfaces before the application of paints or coatings. Exterior coatings, namely, natural oil wood finish, deck finish, roof coatings in the nature of paint, anti-graffiti coatings, and clear sealers for concrete and wood.
PROTECT-IT	TMA768,637	Adhesive plastic film used to temporarily protect surfaces while work is being performed.

[77] These ten registered marks are the property of nine distinct entities.

[78] The state of the register evidence must show a sufficient number of relevant registrations to conclude there are numerous trade-marks on the market that include this common characteristic such that the average Canadian consumer is accustomed to distinguish between the marks that include such a characteristic [See *Welch Foods Inc v Del Monte Corp* 44 CPR (3d) 205 (FCTD) and *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB)].

[79] The register evidence shows that a sufficient number of marks exist containing the particle PROTEC or PROTEX in association with goods and/or services for cleaning or protection of various surfaces. In the circumstances, I find that the state of the register is an important factor that favours the Applicant. In this case, the addition of another element to PROTECH and/or a difference in the goods and services of the parties would be sufficient to distinguish the origin of the goods or services associated with these trade-marks.

[80] Thus, the consumer is accustomed to distinguishing among all these trade-marks containing the particle “PROTEC” in association with protection goods or services for sale or application of protection goods. In other words, the addition of another element to PROTECH and/or a difference in the nature of the goods and services of the parties may prove sufficient to distinguish the source of the goods or services associated with these trade-marks.

[81] However, I judge that this factor is diminished in the present case because the Applicant took the entire PROTECH trade-mark. The graphic portion of the Mark, namely the font used and the capital T, are additions or modifications that are very minimal and insufficient in the circumstances, when the Mark is used with Goods and Services other than the Non-Similar Goods and the Non-Similar Services.

[82] I am perfectly aware that the Registrar has mentioned in the past that a merchant who uses, as a trade-mark, an ordinary word commonly used in the industry cannot expect this word to enjoy extended protection. Thus, in these cases, relatively minor differences between the marks are sufficient to distinguish them. However, in the case at bar, the above-mentioned differences are insufficient, in my opinion, to allow the Mark to be distinguished from the PROTECH trade-mark, except when the Mark is used in association with the Non-Similar Goods and the Non-Similar Services.

[83] Each case of opposition based upon an allegation of confusion between two trade-marks is a mixed question of fact and law. The question of confusion must be settled on the basis of the evidence of record. The partial maintenance of this opposition must not be interpreted as recognition of a monopoly granted to the Opponent for the “PROTECH” component of its trade-marks or its trade names associated with coating goods.

Conclusion

[84] I hold the opinion that the applicant has not discharged its ultimate onus of proving, on a balance of probabilities, that the Mark was not confusing with the Opponent’s PROTECH mark when used in association with the Goods and Services, except concerning the Non-Similar Goods and the Non-Similar Services, on each of the relevant dates associated with these grounds of opposition.

[85] Regarding the confusion with the PROTECH OXYPLAST and PROTECH OXYPLAST and Design marks, I hold the opinion that the Applicant has not discharged its burden of proving, on a balance of probabilities, that the Mark was not confusing with them. Indeed, the presence of the term “OXYPLAST” serves to distinguish these marks from the Mark.

[86] In the circumstances, the grounds of opposition based on sections 16(3) and 2 of the Act are maintained in part.

DISPOSAL

[87] In exercising the authority delegated to me pursuant to the provisions of section 63(3) of the Act, I refuse the registration application regarding:

(1) Chemicals used in the industry, namely chemical compositions for protection of varnishes and paints for all automobile vehicles, nautical vehicles and aeronautical vehicles, chemical compositions for protection of fabrics and textiles.

(2) Cleaning, buffing and polishing goods, namely cleaners, waxes, shampoos, polishes, renewers, stain removers for automobile vehicles, sports utility vehicles and minivans, nautical vehicles and aeronautical vehicles; goods for renewal and restoration of painted and varnished surfaces, namely cleaners, buffers, waxes, shampoos, polishes, renewers, stain removers for automobile vehicles, sports utility vehicles and minivans, nautical vehicles and aeronautical vehicles; goods for renewal and restoration of automobile vehicle bodies, boat hulls and aircraft cabins, namely cleaners, buffers, shampoos, polishes, renewers, stain removers, anti-tar, anti-resin and anti-adhesive goods, aerosol primers, paint, stripper, cleaning solvents, waxes; cleaners for vehicle tires; goods to polish and buff tires, namely silicones, degreasers, polishes, cleaners; engine cleaners; vehicle wheel rim cleaners; goods for protecting engines against dirt and moisture, namely buffers, waxes, cleaners.

(1) Provision of cleaning, buffing, waxing services for automobile vehicles, sports utility vehicles and minivans, nautical vehicles and aeronautical vehicles; provision of preparation, cleaning, buffing, paint and varnish maintenance services for automobile vehicle bodies, boat hulls, aircraft cabins; provision of cleaning and protection services for fabrics and textiles, carpets and rugs, leathers, imitation leathers and all vehicle interior plastic parts; cleaning of vehicles, cleaning of vehicle engines; varnishing and buffing of vehicle engines; application of films on metal surfaces.

(2) Application of protective coats to varnished and painted surfaces; treatment of varnished and painted surfaces; application of protective coats and treatment of paints and varnishes on automobile vehicle bodies, nautical vehicles and aeronautical vehicles; treatment and application of surface coatings, particularly application of plastic, PVC or polyester films on metal surfaces, coloured films for metal; treatment and application of polyurethane films on automobile vehicle bodies, nautical vehicles and aeronautical vehicles.

and I reject the opposition regarding the following goods and services:

(2) Cleaning, buffing and polishing goods, namely chamois, shampoos, goods for renewal and restoration of automobile vehicle bodies, boat hulls and aircraft cabins, namely joint filler, disposable masks, body fillers, glass cleaners, odour destroyers; cleaners for fabrics, textiles, leathers, imitation leathers and plastics; goods for

conditioning and protecting leather; goods for protecting imitation leathers, namely cleaners, nourishing care, stain removers, creams, lubricants and waxes, sponges; goods for removing tar stains, grease stains and paraffin, namely oils, aerosols, cleaners and strippers; cleaners and glazing agents for windows; cleaning foams for polishers and buffers.

(1) Application of films to windows and glazed surfaces.

(2) Tinting windows by surface treatments; treatment and application of surface coatings, particularly application of plastic, PVC or polyester films on glazed surfaces, tinted films for glass, protective films for glazed surfaces and glass, PVC or adhesive polyester films.

All pursuant to section 38(8) of the Act [see *Produits Ménagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 482 (FCTD) as authority in split decision].

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified true translation
Arnold Bennett

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS REGISTERED IN THE CASE**

No hearing held

AGENT(S) OF RECORD

Osler Hoskin & Harcourt

FOR THE OPPONENT

Fasken Martineau DuMoulin

FOR THE APPLICANT