



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2020 TMOB 96

Date of Decision: 2020-07-31

IN THE MATTER OF OPPOSITIONS

Anenda Systems Inc.

Opponent

and

EasyTrim Reveals Inc.

Applicant

1,690,913 for EZ.BUMP & Design

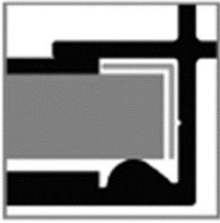
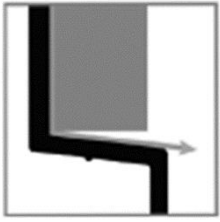
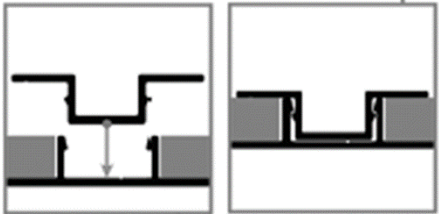
Applications

1,690,914 for EZ.PLANE & Design

1,690,915 for EZ.LOCK & Design

INTRODUCTION

[1] In August 2014, EasyTrim Reveals Inc. (EasyTrim or the Applicant) filed applications to register three design marks under Nos. 1,690,913, 1,690,914, and 1,690,915, depicted below. The Applicant refers to these applications as EZ.BUMP & Design, EZ.PLANE & Design, and EZ.LOCK & Design, respectively, and I will do the same:

	<p>Application No. 1,690,913 EZ.BUMP & Design</p>
	<p>Application No. 1,690,914 EZ.PLANE & Design</p>
	<p>Application No. 1,690,915 EZ.LOCK & Design</p>

(collectively, the Marks)

[2] The applications are based on use in Canada since at least as early as June 2010 and are listed for use in association with the following goods and services:

Goods

- (1) Coated metal and aluminum reveal wall systems consisting of trims, extrusions, sidings and permanent flashing systems, namely, corner moldings, expansion joints, reveal moldings, joint flashing.

Services

- (1) Building construction; technical assistance, support and consulting in the field of design, installation, maintenance, and repair of reveal wall systems.

(the Goods and Services)

[3] Anenda Systems Inc. (Anenda or the Opponent) has opposed these applications on several grounds relating to, *inter alia*, functionality, descriptiveness, any alleged use of the

Marks not constituting trademark use, non-distinctiveness, and whether the applications for the Marks are more properly characterized as distinguishing guises.

THE RECORD

[4] The applications for the Marks were filed on August 22, 2014. They were advertised for opposition purposes in the *Trademarks Journal* of June 3, 2015.

[5] On July 31, 2015, the Opponent filed, against each application, a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition pleaded by the Opponent against each application are identical and include sections 30, 12, 13, and 2 of the Act. As the Act was amended on June 17, 2019, all references in this decision are to the Act as amended, with the exception of references to the grounds of opposition (see section 70 of the Act which provides that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised before this date). The specific grounds of opposition pleaded by the Opponent are set out in Schedule A to this decision.

[6] The Applicant filed counter statements for all three proceedings on October 26, 2015.

[7] In support of each of its oppositions, the Opponent filed two affidavits of Murray Hone, and the affidavit of Adel Elmourad. In support of its applications, the Applicant filed the affidavit of Joshua George Singh. Mr. Singh was cross-examined on his affidavit and the transcript forms part of the record for each proceeding.

[8] Both parties filed a written argument and were represented at a hearing.

[9] As the issues raised in each case are identical, and the evidential record and written arguments are substantively similar in each case, all three matters are addressed in this decision.

EVIDENTIAL BURDEN AND LEGAL ONUS

[10] Before considering the grounds of opposition, it is necessary to review some of the requirements with regard to (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[11] With respect to (i) above, there is an evidential burden on an opponent to support the facts in its allegations pleaded in the statement of opposition [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298]. An evidential burden on an 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 an applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent (for those allegations for which the opponent has met its evidential burden). A legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against an applicant.

OVERVIEW OF THE EVIDENCE

[12] The Opponent's evidence includes two affidavits of Murray Hone, the National Install Manager for the Opponent. Mr. Hone has held this role since approximately October 2011. The same First Hone affidavit (sworn February 26, 2016) was sworn in respect of all three oppositions, and provides evidence relating to the Opponent's business and products. Mr. Hone describes the Opponent as a Canadian producer and distributor of exterior panels and cladding products, including exterior aluminum composite material panels. Mr. Hone states that the Opponent, or its predecessor, has operated in Canada since around February 2011, providing quality exterior panels and cladding products for corporate, commercial, and residential projects (para 4).

[13] Mr. Hone explains that among the products marketed and sold by the Opponent are a component-based cladding panel system (the "AL13 System"). The AL13 System includes extrusion profiles, including an end frame, an inside corner frame, an outside corner frame, a panel frame assembly, and a perimeter frame assembly, that may be used in combination with architectural panels and panel spacers to affix the Opponent's panels to a surface (paras 6,7). The Opponent uses graphic depictions of its AL13 System components (shown below) to help explain how its products work and how to use and install them:



These graphic depictions are also used in connection with the sale, distribution and promotion of the AL13 System and components in Canada (para 13). Information on advertising, channels of trade, and sales of the AL13 System products is also provided.

[14] A second Hone affidavit (sworn February 26, 2016) was also filed in each opposition. While not identical, the affidavits are substantively similar for each application and generally serve to introduce into evidence materials including: (i) copies of the Applicant's promotional materials for the Goods accessed from the Applicant's website *www.easytrimreveals.com*, (ii) copies of applications for patent protection in the United States and Canada by the Applicant in connection with its reveal wall systems, trim pieces, and profiles; and (iii) various materials, such as promotional materials and patent applications, from third parties in the industry intended to show that others make or sell building materials similar or identical in appearance to the applied for Marks and use similar graphic depictions to describe their products, and show how they are to be used. Throughout, I note that Mr. Hone provides his opinions on the ultimate issues in the opposition (for instance whether the Marks are clearly descriptive, functional etc.). I will not refer to or place any weight on any statements which constitute the opinions of Mr. Hone on issues that go to the merit of the oppositions [*British Drug Houses Ltd v Battle Pharmaceuticals* (1944), 1944 CanLII 308 (FC), 4 CPR 48 at 53 and *Les Marchands Deco Inc v Society Chimique Laurentide Inc* (1984), 2 CPR (3d) 25 (TMOB)].

[15] The Opponent also filed three separate affidavits of Adel Elmourad, the Business Development Manager of the Opponent. The affidavits were sworn on February 26, 2016 and are substantively identical for each opposition. Mr. Elmourad attended at a distributor and at a retailer of building products in British Columbia carrying the Applicant's products and photographed some of the products and packaging associated with certain of the Applicant's products. Mr. Elmourad also purchased various of the Applicant's products and provided photographs of the products and receipt from purchase.

[16] As its evidence for all three oppositions, the Applicant filed the affidavit of Joshua George Singh (sworn June 27, 2016), the President and Chief Executive Officer of the Applicant. Mr. Singh describes the Applicant as a building materials manufacturer with a focus towards manufacturing and selling extruded aluminum trim componentry for exterior cladding products like fiber cement, wood, corrugated steel panels, and aluminum composite materials for both interior and exterior use (para 3). Mr. Singh's affidavit provides information on the Applicant's business, the Goods covered under the applications (there is notably little reference to the Services), its promotional methods, materials, and the channels of trade for the Goods (paras 14-27), and sales and revenue data (paras 28-31).

[17] In reaching my decision, I have considered all the evidence in the files. However, only those portions of the evidence that are directly relevant to my findings are discussed.

GROUND OF OPPOSITION RELATED TO FUNCTIONALITY

[18] The Opponent has pleaded that the applications do not conform to the requirements of section 30 of the Act in that the alleged Marks are not trademarks within the definition of section 2. More particularly, the Opponent has pleaded that the "alleged trademark(s) are not capable of being used by a person for the purpose of distinguishing the goods and services described in the applications from the goods and services of others, in that the alleged Marks merely portray a utilitarian or functional (or primarily utilitarian or functional) feature of the goods in association with which it is allegedly used or the manner in which such goods should be used or installed".

[19] The Opponent has also pleaded that the applications do not conform with section 30(b) of the Act in that the Marks are not used for the purpose of distinguishing the goods and services described in the Application from the goods and services of others since they are "at most, a cross-sectional depiction of a portion of the Applicant's goods, which is used by the Applicant to demonstrate features of the goods or how the goods should be put into practice, used or installed, rather than for the purpose of distinguishing the Applicant's goods and services". I note that if the Marks are not trademarks then the date of first use claimed by the Applicant cannot stand as there would be no trademark use as of the date claimed.

[20] Notwithstanding that there may be some uncertainty as to whether the former ground of opposition, which relies on the introductory portion of section 30 of the Act, has been properly pleaded, the same allegation also forms the basis for the latter ground of opposition, which I consider to have been properly pleaded. Accordingly, I have considered both grounds together, recognizing that they will both either succeed or fail.

Material date

[21] The material date for section 30 grounds of opposition is the filing date of the applications, namely August 22, 2014 [*Georgia-Pacific Corp. v Scott Paper Ltd.* (1984), 3 CPR (3d) 469 (TMOB) at 475].

The doctrine of functionality

[22] The function and purpose of a trademark is to indicate the source from which goods come (H.G. Fox, *The Canadian Law of Trade Marks and Unfair Competition*, 3rd ed. (1972), pp. 21, 25). The doctrine of functionality recognizes that trademark law is not intended to prevent the competitive use of utilitarian features of goods, but that it fulfills a source-distinguishing function.

[23] The doctrine of functionality was canvassed by the Supreme Court of Canada in *Kirkbi AG v Ritvik Holdings Inc.*, (2005) SCC 65 (CanLII), [2005] 3 SCR 302. Paragraphs 44 to 46 of the decision are reproduced in part below:

44. In Canada, as in several other countries or regions of the world, this doctrine is a well-settled part of the law of trademarks. In the law of intellectual property, it prevents abuses of monopoly positions in respect of products and processes. Once, for example, patents have expired, it discourages attempts to bring them back in another guise.

45. The doctrine of functionality is a well-established principle of the Canadian law of trademarks. Indeed, our Court characterized it in 1964 as a “well-settled” principle of law:

The law appears to be well settled that if what is sought to be registered as a trademark has a functional use or characteristic, it cannot be the subject of a trademark.

(*Parke, Davis & Co v Empire Laboratories Ltd*, 1964 CanLII 74 (SCC), [1964] S.C.R. 351, at p. 354, *per* Hall J.)

46. The Federal Court of Canada has consistently applied this doctrine. As in the present case, it has held time and again that no mark could consist of utilitarian features. Otherwise, it would make the wares a part of the mark and grant a monopoly on their functional features. For example, it is worth quoting MacGuigan J.A., in a discussion of the validity of a mark consisting of the particular shape of a razor head:

The distinguishing guise in the case at bar is in my opinion invalid as extending to the functional aspects of the Philip shaver. A mark which goes beyond distinguishing the wares of its owner to the functional structure of the wares themselves is transgressing the legitimate bounds of a trademark.

(Remington Rand Corp v Philips Electronics N.V. (1995), 64 CPR (3d) 467 (FCA), at p. 478; see also Pizza Pizza Ltd v Canada (Registrar of Trade Marks), [1989] 3 F.C. 379 (C.A.), at p. 381, per Pratte J.A.; Thomas & Betts, Ltd v Panduit Corp., 2000 CanLII 17096 (FCA), [2000] 3 F.C. 3 (C.A.), at para 25.)

This jurisprudence echoes earlier decisions of the Exchequer Court of Canada which applied the doctrine of functionality in respect of trademarks, under an earlier statute. A combination of elements primarily designed to perform a function may not be the subject matter of a trademark (*Imperial Tobacco Co. of Canada v Registrar of Trade Marks*, 1939 CanLII 261 (FC), [1939] Ex. C.R. 141, at p.145; *Elgin Handles Ltd. v Welland Vale Manufacturing Co.* (1964), 43 CPR 20, at p.24).

47. The Canadian jurisprudence is consistent with legislative and jurisprudential developments in other countries...

...

52. At the root of the functionality principle in European law, as in Canadian intellectual property law, lies a concern to avoid overextending monopoly rights on the products themselves and impeding competition, in respect of wares sharing the same technical characteristics...

[24] While the trademark at issue in the *Kirkbi* decision, *supra*, was in the form of a distinguishing guise, the concept of functionality is not limited to such marks and is also applicable to two dimensional design marks [*Remington Rand Corp. et al v. Philips Electronics N.V. (1995), 64 CPR (3d) 467 (FCA) at p.476*].

The Marks are primarily functional

[25] Based on my review of the evidence, portions of which are discussed below, I find that the Marks possess an intrinsic reference to the principal functional features of the Applicant's Goods, namely the bump, sloped plane, and lock or click features depicted in the EZ.BUMP & Design, EZ.PLANE & Design, and EZ.LOCK & Design marks, respectively. The depiction of

these primarily functional features does not relate to the identification of the source of the Goods and Services. Rather, I find that they serve to identify the purpose and function of the Applicant's Goods and Services.

United States patent application no. 13/194451 entitled "Wall Panel Trim Reveal System and Method"

[26] A copy of this patent is attached as Exhibit E to the second Hone affidavit filed in respect of the EZ.PLANE & Design proceeding, and as Exhibit F to the second Hone affidavits filed in respect of the EZ.BUMP and EZ.LOCK & Design proceedings. The patent lists Joshua George Singh as the inventor; on cross-examination, Mr. Singh confirmed his awareness and ownership of the application (Q61-67). The application holds a publication date of October 11, 2012.

[27] At the hearing, the Applicant objected to the introduction of the patent document on the basis that it is necessary to bring in expert evidence when dealing with patents, and that Mr. Hone is not an expert.

[28] Leaving aside the issue of Mr. Hone's expertise in patent law, or even whether the intent was for Mr. Hone to act as an expert, I note that as an employee of the Opponent, he is not an independent or unbiased witness. Accordingly, I have given no weight to any opinions advanced by Mr. Hone in his review of the patent. However, I do not consider there to be any issues with respect to his introduction of this patent as an exhibit.

[29] Regarding the Applicant's submission that expert evidence is necessary in order to consider the patent, I respectfully disagree and consider that in this case, I am capable of reading what is set out in the various patent documents and drawing my own conclusions from them [*Player's Company Inc v Rothmans, Benson & Hedges Inc.*, 2018 TMOB 145 at para 23; see also *JTI-Macdonald TM Corp v Player's Company Inc*, 2012 TMOB 236 at para 13].

[30] Further, and though not raised by the Applicant, I do not consider the fact that the patent is a United States patent to affect its relevance or the weight to be afforded to it as we are essentially dealing with a question of fact, namely whether the designs depicted in the Marks are primarily functional (see *Parke Davis, supra*). In any event, the same descriptions associated with the figures as they appear in the US patent appear in the Applicant's corresponding

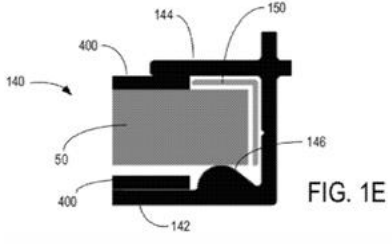
Canadian patent application, which is attached as Exhibit F to the second Hone affidavit filed in respect of the EZ.PLANE & Design proceeding, and as Exhibit G to the second Hone affidavits filed in respect of the EZ.BUMP and EZ.LOCK & Design proceedings. On cross-examination, Mr. Singh confirmed his awareness and ownership of the Canadian application (Q66). Mr. Singh also confirmed that the Canadian patent application is now an issued patent (Q67).

[31] In *Parke Davis, supra*, it was held that when deciding whether a trademark has a functional use or characteristic, an application for a patent covering the trademark provides at least some evidence that the mark has functional use. In this case, the plaintiff owned registrations for a number of trademarks depicting colored gelatin bands, which it used to seal the halves of gelatin capsules containing a pharmaceutical preparation. The defendant used similar bands, and the plaintiff brought an action for infringement and a claim in passing off. A key issue was the validity of the plaintiff's trademark registrations, and the court considered evidence that the plaintiff held, between 1932 and 1949, a United States patent on sealed capsules with similar bands to be relevant to the question as to whether these bands had a functional use or characteristic. The court held that the evidence that the plaintiff so considered its bands when it applied for the US patent in 1932 was surely some evidence that the bands had a functional use.

[32] In the subject proceedings, from my review of the US patent, portions of which are reproduced below, I am of the view that the US patent application is similarity instructive and supports the finding that the bump, sloped plane, and lock features prominently depicted in the EZ.BUMP & Design, EZ.PLANE & Design, and EZ.LOCK & Design marks have a primarily functional application in relation to the associated Goods and Services.

EZ.BUMP & Design

[33] The EZ.BUMP & Design mark is reproduced in the US patent application as set out below:

Figure – 1E of US patent application	Description
 <p>FIG. 1E</p>	<p>[0039] FIG. 1E is a cross-sectional detailed view of a vertical trim piece 140. As shown, vertical trim piece 140 includes mounting wall 142 and tab 144 forming a slot for receiving an edge of a horizontal trim piece 400. Bump 146 formed near an inside corner where tab 144 is connected to mounting wall 142 serves to keep wall panel 50 off of the building wall and closer to tab 144. Bump 146 also forms a moisture drainage channel within vertical trim piece 140, allowing moisture 150 to drain down the length of vertical trim piece 140 and away from the building wall.</p>

[34] On cross-examination, Mr. Singh acknowledged that Figure 1E is the same or similar to the applied for EZ.BUMP & Design mark in appearance (Q142). Mr. Singh also acknowledged that the above description describes Figure 1(e) of the US patent application (Q147).

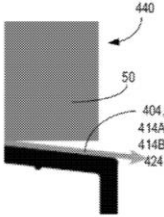
[35] The EZ.BUMP & Design mark shows a ‘bump’ (numbered as 146 in the description). This bump is described as “forming a moisture drainage channel” allowing moisture to drain down and away from the building wall.

[36] A copy of the corresponding Canadian application to the US application is attached as Exhibit G to the second Hone affidavit (para 8, second Hone affidavit filed in respect of EZ.BUMP & Design). While the attached application does not include the physical drawing of Figure 1E, the same language describing it is included (at para [0039] on page 6 of the document).

[37] Mr. Singh also acknowledged that the EZ.BUMP & Design mark has been used to describe an embodiment in at least one patent application (Q139)

EZ.PLANE & Design

[38] The EZ.PLANE & Design mark is reproduced in the US patent application as set out below:

Figure 4E of US patent application	Description
 <p>FIG. 4E</p>	<p>[0048] Now referring to FIG. 4E, shown is a cross-sectional detailed view of the horizontal trim pieces of FIGS. 4A-4C with slopes 404, 414A, 414B, 424 interacting with a wall panel 50. As shown, a slight gap is formed between wall panel 50 and slopes 404, 414A, 414B, 424, whereby any moisture from behind wall panel 50 may escape and drain away from the building and the trim.</p>

[39] On cross-examination, Mr. Singh acknowledged that Figure 4E is similar to the applied for EZ.PLANE & Design trademark (Q212). Mr. Singh also acknowledged that the above description describes Figure 4(e) of the US patent application (Q214).

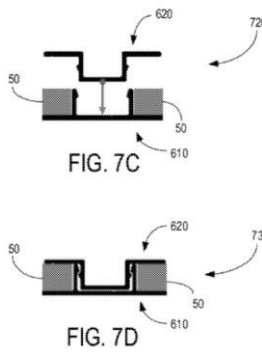
[40] The EZ.PLANE & Design mark shows a ‘slope’ interacting with wall panel 50. The description states that “a slight gap is formed between wall panel 50 and slopes... whereby any moisture from behind wall panel 50 may escape and drain away from the building and the trim”.

[41] A copy of the corresponding Canadian application to the US application is attached as Exhibit F to the second Hone affidavit (para 8, second Hone affidavit for EZ.PLANE & Design). While the attached application does not include the physical drawing of Figure 4E, the same language describing it is included (at para [0048] on page 8 of the document).

[42] Mr. Singh also acknowledged that the EZ.PLANE & Design mark has been used to describe an embodiment in at least one patent application (Q211).

EZ.LOCK & Design

[43] The EZ.LOCK & Design mark is reproduced in the US patent application set out below:

Figures 7C and 7D of US patent application	Description
 <p>FIG. 7C</p> <p>FIG. 7D</p>	<p>[0059] FIGS. 7A and 7B show, in illustrations 700 and 710, the pieces of FIGS. 6A-6C in interlocked positions to illustrate the differences between vertical top cap trim pieces 620 and 630. FIGS. 7C and 7D show in more detail the vertical trim pieces of FIGS. 6A and 6B being interlocked together with wall panels 50 received therebetween. In use, vertical top cap trim piece 620 may be pushed into locking position within vertical back plate 610 using a rubber mallet, or some similar tool.</p> <p>(I note that paragraph [0056] refers to FIGS. 6A-6C as cross-sectional views of various vertical trim pieces with interlocking protrusions.)</p>

[44] On cross-examination, Mr. Singh acknowledged that Figures 7C and 7D are similar in appearance to the applied for EZ.LOCK & Design trademark (Q184). Mr. Singh also acknowledged that the above description accurately describes Figures 7(c) and 7(d) of the US patent application (Q147).

[45] The EZ.LOCK & Design mark shows the vertical trim pieces being interlocked together with wall panels.

[46] A copy of the corresponding Canadian application to the US application is attached as Exhibit G to the second Hone affidavit (para 8, second Hone affidavit for EZ.LOCK & Design). While the attached application does not include the physical drawings of Figures 7C and 7D, the same language describing it is included (at para [0059] on page 11 of the document).

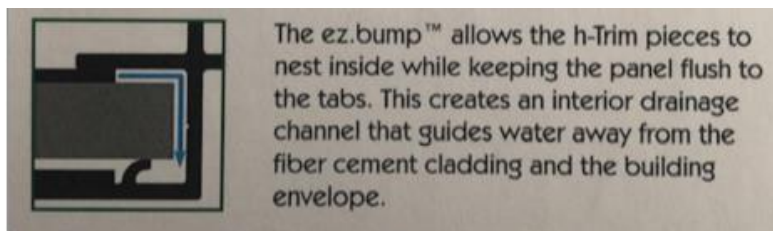
[47] Mr. Singh also acknowledged that the EZ.LOCK & Design mark has been used to describe an embodiment in at least one patent application (Q181).

Applicant's materials - Easytrim Reveals Installation Best Practices Guide

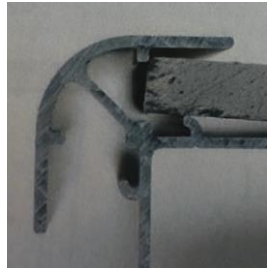
[48] Exhibit B to the Singh affidavit consists of a copy of the Installation Guide made available by the Applicant for its products. Mr. Singh states that this guide can be downloaded from the company's website, that such guides were readily available since at least June 2010, and that the substantive information relating to the installation of the products covered by the trademarks is similar (para 17). A copy of this document also appears at Exhibit A of the second Hone affidavits. Mr. Hone states that it was accessed from the website located at the domain <http://easytrimreveals.com/wp-content/uploads/2013/10/combo2013.pdf> (para 5).

[49] In my view, as with the patent documents, the Applicant's Illustration Guide assists in showing that the applied for Marks effectively represent that the Applicant's products contain a 'bump', 'sloped plane', or 'lock', and depict or explain what these features do (in this regard, the arrows in the EZ.PLANE & Design and EZ.LOCK & Design marks are particularly instructive). The Marks do not serve to indicate the source of the Goods. Rather, the Marks make reference to the primarily functional features of the Applicant's Goods, namely the 'bump', 'plane', and 'lock' mechanisms, which they depict.

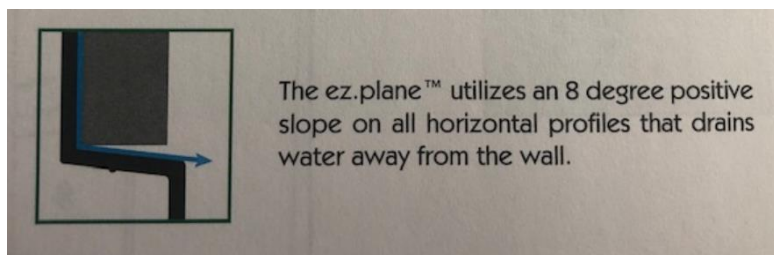
[50] Page 8 of the document, titled "ez.bump™", displays the EZ.BUMP & Design mark - while there some variations to the mark as it appears, I consider them to be minor such that the EZ.BUMP & Design mark remains recognizable [*Canada (Registrar of Trade Marks v Cie internationale pour l'informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA); *Promafil Canada Ltee v Munsingwear Inc* (1992), 1992 CanLII 12831 (FCA), 44 CPR (3d) 59 (FCA)]. A description of the "ez.bump™" appears alongside the design, and explains that the ez.bump™ "creates an interior drainage channel that guides water away from the fiber cement cladding and the building envelope". These are shown below:



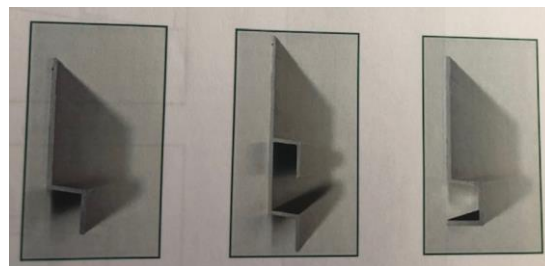
[51] A photograph of the Applicant's product also appears on the document and is reproduced below:



[52] Page 12 of the document, titled "ez.plane™", displays the EZ.PLANE & Design mark along with descriptive text indicating that the "ez.plane™ utilizes an 8 degree positive slope on all horizontal profiles that drains water away from the wall":

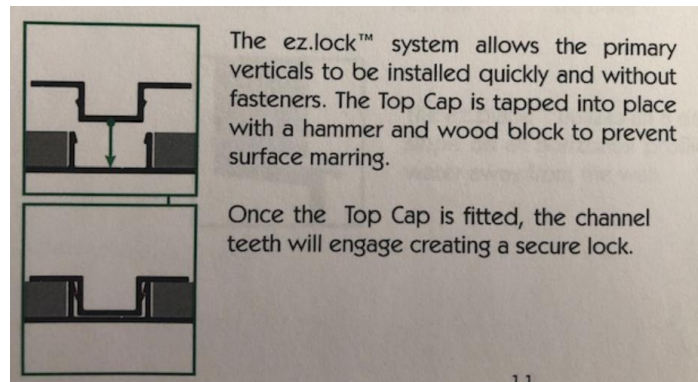


[53] Photographs of the Applicant's product also appear on page 12 of the document and are reproduced below:

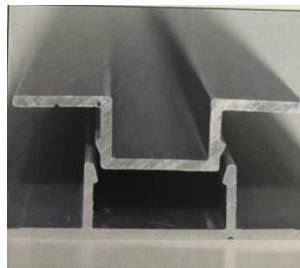


[54] Page 10 of the document is titled "ez.lock™", and page 11 of the document includes the EZ.LOCK & Design mark – I make this finding on the basis that while there some variations to the mark as it appears (particularly in vertical arrangement of the elements instead of horizontal display), I consider them to be minor such that the applied for EZ.LOCK & Design mark remains recognizable [*Canada (Registrar of Trade Marks v Cie internationale pour l'informatique CII*

Honeywell Bull, SA (1985), 4 CPR (3d) 523 (FCA); *Promafil Canada Ltee v Munsingwear Inc* (1992), 1992 CanLII 12831 (FCA), 44 CPR (3d) 59 (FCA)]. Beside the Mark is a description of the “ez.lock™ system” explaining that it allows for verticals to be installed quickly and without fasteners, and indicating that “...once the Top Cap is fitted, the channel teeth will engage creating a secure lock”. The Mark and description are shown below.



[55] A photograph of the Applicant’s product also appears on page 10 of the document and is reproduced below:



[56] I further note that throughout the materials provided in the Singh affidavit, including the the Applicant’s other marketing and advertising materials (Exhibit E), “product legends” (Exhibit F, G), and third party materials (Exhibits H-M), the applied for Marks are similarly presented and are accompanied by descriptive text explaining the functional features (bump, sloped plane, and lock) of the Goods (Q231, 233,236).

Characterization of the Marks by Mr. Singh

[57] At the hearing, the Opponent argued that Mr. Singh’s own characterization of the Marks in his affidavit is effectively an admission that they are primarily functional. Counsel noted Mr.

Singh's explanation of the motivation for the Applicant's products (when they get wet, they get damaged), the innovation designed to address this, followed by an emphasis on what Mr. Singh describes as "a pictorial description of the trademark to identify the products". Relevant portions of the Singh affidavit (with emphasis added) are set out below:

9. In addition, wall panel trim systems make wall panels vulnerable to premature wear and moisture damage when used for exterior applications due to lack of proper moisture control.

10. EasyTrim Reveals has designed innovative products for use with exterior wall panels used for the cladding of the exterior of buildings which overcomes some of the drawbacks and limitation of products by other competitors and persons, including the products of the Company sold under the trademarks EZ.Lock, EZ.Plane or EZ.Bump.

11. The products covered by the EZ.Bump trademark are aimed to channeling water around the cladding is [sic] a protective feature that extends the life of the inset fiber cement. A pictorial description of the trademark to identify the products is listed below: [the EZ.BUMP & Design mark is depicted].

12. The products covered by the EZ.Lock trademark are designed with a unique two piece assembly. The products comprise a set of vertical, horizontal and corner trim pieces designed to be fitted together. **The EZ.Lock system allows the primary vertical trim to be installed quickly and without fasteners. Once the top cap is fitted, the channel teeth will engage creating a secure lock. A pictorial description of the trademark to identify the products is listed below: [the EZ.LOCK & Design mark is depicted].**

13. The products covered by the EZ.Plane trademark are used where water management of fiber cement products is needed. These products permit water to be drained away from the horizontal ledge and the inset cladding with the aid of a downward pointing 8 degree sloped surface. This surface allows gravity to pull water off the surface and prevents capillary action from pulling water up through the porous fiber cement product resting on it. **A pictorial description of the trademark to identify the products is listed below: [the EZ.PLANE & Design mark is depicted].**

[58] In response, the Applicant takes the position that the Marks do not depict the Applicant's products but instead operate as "icons" to describe or represent a category of its products in a consumer-friendly way. In this regard, I note various portions of the Singh cross-examination in which Mr. Singh refers to the Marks as "icons":

Q91: ... In the depiction shown in paragraph 11 [of the Singh affidavit which depicts the EZ.BUMP & Design mark] the dark portions of that depiction correspond to extrusions or profiles sold by the company; is that correct?

A: No, not necessarily. It's an icon that directs customers to an area that allows them to choose from various trim profiles to terminate their product, their inset cladding. It doesn't depict our trims exactly.

...

Q93: Sure. When you use the term "EZ.Bump" in your trademark – for example, in paragraph 11 you say:

"The products covered by the EZ.Bump trademark."

Are you referring to products having a particular feature, as distinguished from extrusions or profiles that do not have a particular feature?

A: Yeah. We use it as an icon to separate the different categories of trims. So all the terminating profiles are captured under that EZ.Bump icon.

...

Q168: ... If I use the term "EZ.Lock system" will you understand that I am referring to the two-piece combination of profiles?

A: Yeah. It's the icon to represent different trim profile options that are two-piece.

Q169: Okay. But if I refer to "EZ.Lock system" will you understand that I am referring to the extrusions or profiles themselves?

A: Yes.

Q170: Okay. So in some contexts the alleged EZ.Lock design trademark is a depiction of the alleged EZ.Lock system; is that correct?

A: Again?

Q171: The alleged EZ.Lock design trademark, in some contexts it's used as a depiction of the EZ.Lock system?

A: Again, it's an icon to represent a category of profile options for my customers to choose from, really identifying verticals.

...

Q198: ... Also at paragraph 13 of your affidavit you include a depiction of the alleged EZ.Plane design trademark; is that correct?

A: Yes.

Q199: Now, in some contexts where the alleged EZ.Plane design trademark is used the dark portions correspond to extrusions or profiles; is that correct?

A: Again, yeah, a category of options for customers to choose from, mainly for horizontals.

...

Q217: With respect to each of the opposed alleged trademarks, would you agree that the opposed alleged trademarks depict how the company's products should be put into practice, used, or installed?

A: No. I see them as icons that would represent a group of corner trims, a group of horizontal trims, a group of vertical trims so that my customers can go to a certain section or category and select which trim they want to use that falls into those categories.

...

Q352: Yes. You've mentioned that the alleged EZ.Bump design trademark, for example, is an icon.

A: M'mm-hmm.

Q353: If you're looking at the legend on the second page is there any indication of what the alleged EZ.Bump trademark refers to? [referring to Exhibit F of Singh affidavit]

A: Yes.

Q354: What? What does the alleged EZ.Bump trademark refer to from these profiles?

A: The profiles that have a bump indicated on them.

Q355: How do you mean "have a bump indicated on them"?

A: EZ.1, EZ.2, EZ.10, EZ.13, EZ.14, EZ.15, EZ.3, EZ.18, EZ.31, EZ.33, EZ.34, EZ.35, EZ.36... all are part of the EZ.Bump series.

[59] The Applicant also submitted that the applied for Marks are not to be confused with a profile of the of the Applicant's Goods, but are instead pictures or fanciful renditions, albeit suggestive in nature, which connote an idea and serve as a trademark. In this regard, I note that the above-referenced Figures 1E and 4E in the US patent application (corresponding to the EZ.BUMP& Design and EZ.PLANE & Design marks, respectively) are expressly described as "cross-sectional detailed views of trim pieces". On this basis, it would not be unreasonable to conclude that these two Marks are in fact profiles of the Applicant's Goods.

[60] In any event, with respect to the characterization of the Marks as icons, I am of the view that even if they are considered in this manner, they still serve to reference the primarily functional features of the Goods in these "product categories" instead of their source. Put another way, the Marks may well provide a "shortcut" to consumers by directing them to products with the primarily functional features, namely the "bump", "plane", or "lock" represented in the Marks. However, this shortcut fails to provide consumers with an indication of the origin of the Goods and Services, which is the function and purpose of a trademark [*Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 (CanLII), [2011] 2 SCR 387, citing *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, [2006] 1 SCR 772, at para 21].

Conclusion

[61] Based on the foregoing, I am satisfied that the Opponent has met the burden on it to put into issue whether the Marks portray a primarily functional feature of the Goods in association with which they are allegedly used or the manner in which such Goods should be used or installed. The legal onus therefore falls on the Applicant to show, on a balance of probabilities, that the applied for Marks are not primarily functional with respect to the section 30 ground of opposition. Further, the Applicant has a legal onus to show, on a balance of probabilities, that the Marks were able to function as a trademark such that use of a trademark pursuant to sections 2 and 4 of the Act occurred as of the date claimed. In my view, the weight of the evidence indicates that even though the Applicant may have intended to use the applied for Marks as trademarks, that in practice, the Marks serve to distinguish the functional structure of the Goods themselves instead of distinguishing their source.

[62] In *Remington Rand Corp v Philips Electronics NV* (1995), 64 CPR (3d) 467 (FCA), the design mark at issue depicted a shaver head representing a triple-headed rotary head assembly. The court noted that if a mark is primarily functional “as part of the ware”, the effect would be to grant “a monopoly on functional elements or characteristics of their wares”, creating a patent rather than a trademark. The court found the three-headed configuration to be functional. As a result, the design mark depicting those functional elements was found to be primarily functional and subsequently expunged.

[63] Similarly, in the present case, the three applied for trademarks portray primarily functional elements that go to the associated Goods themselves, and the Services insofar as they pertain to the Goods. This can be contrasted with a situation wherein the functional element of a mark relates to the identification of the source and quality of the goods, as in *Pizza Pizza Ltd v Canada (Registrar of Trademarks)* 1989, 26 CPR (3d) 355, where the functionality of the applied for mark (a telephone number) was related not to the goods themselves but to the source of the goods.

[64] Accordingly, the section 30 and 30(b) grounds of opposition are successful.

GROUND OF OPPOSITION – DESCRIPTIVENESS OF THE MARKS

[65] The Opponent has pleaded that the alleged trademarks are not registrable pursuant to section 12(1)(b) of the Act as “it (they) are clearly descriptive or deceptively misdescriptive of a character or quality of the goods in association with which it is (they are) allegedly used”.

[66] While not raised at the hearing, the Applicant, in its written argument, submits that this ground, as pleaded, is merely a reproduction of the statutory wording of section 12(1)(b), and as such, that it does not contain sufficient material facts to enable the Applicant to reply to it.

[67] At the decision stage, when assessing whether the Applicant knew the case it had to meet, I am required to read the pleading in conjunction with the evidence [*Novapharm Ltd v AstraZeneca AB*, 2002 FCA 387 (CanLII), 21 CPR (4th) 289]. In this case, contrary to the Applicant’s written assertion that there is no admissible evidence that cures the deficiency in the pleading, I consider that the Applicant did know the case it had to meet in view of the Opponent’s evidence discussed above.

[68] The registrability of the Mark under section 12(1)(b) must be assessed as of the filing date of the applications, in this case August 22, 2014 [*General Housewares Corp v Fiesta Barbeques Ltd* (2003), 2003 FC 1021 (CanLII), 28 CPR (4th) 60 (FC)].

[69] The purpose of the prohibition in section 12(1)(b) is to prevent any single trader from monopolizing a term that is clearly descriptive or common to the trade, thereby placing legitimate traders at a disadvantage [*Canadian Parking Equipment v Canada (Registrar of Trade Marks)* (1990), 34 CPR (3d) 154 (FCTD) at para 14].

[70] The issue as to whether a mark is clearly descriptive or deceptively misdescriptive of the character or quality of the goods must be considered from the point of view of the average purchaser of the goods. Further, "character" means a feature, trait or characteristic of the goods and services and "clearly" means "easy to understand, self-evident or plain" [*Drackett Co of Canada v American Home Products Corp* (1968), 55 CPR 29 (Can Ex Ct) at 34]. The mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression [*Wool Bureau of Canada Ltd v Canada (Registrar*

of Trade Marks) (1978), 40 CPR (2d) 25 (FCTD) at 27-8; *Atlantic Promotions Inc v Canada (Registrar of Trade Marks)* (1984), 2 CPR (3d) 183 (FCTD) at 186].

[71] Moreover, it has been established that when assessing whether a trademark is clearly descriptive or deceptively misdescriptive under section 12(1)(b) of the Act, the Registrar must not only consider the evidence at her disposal, but also apply common sense in making the determination about descriptiveness [*Neptune SA v Canada (Attorney General)* 2003 FCT 715 (CanLII)].

[72] The prohibitions contained in section 12(1)(b) apply to all trademarks, including design marks. A depiction or design may be as clearly descriptive or deceptively misdescriptive as words [Fox on Canadian Law of Trade Marks and Unfair Competition (4th ed.) at pp. 5-34]. Fox further provides that:

... Where the mark is nothing more than a mere picture of the wares it would seem that, notwithstanding the observations of Kekewich J. as noted above, it cannot be considered distinctive (*Frost Steel & Wire Co. v Lundy* (1925), 57 OLR 494). But if the representation is not merely of the goods themselves, but of the goods in a distinctive and fanciful form or shape there would appear to be no objection to its registration (*Bowden Wire Ltd. v Bowden Brake Co. Ltd.* (1913), 30 RPC 580; *J. Lyons & Co. Ltd. v G. and K. Restaurants Ltd.* (1955), 72 RPC 259).

As stated in *Frost Steel and Wire Co. Ltd. v. Lundy*,

There are, however, very few reported cases in which the Courts have had to consider the question whether a design mark that is merely descriptive is capable of registration. But it is difficult to see why there should be any difference between the rules applied in the case of a design and those applied in the case of a word...

[73] In *Ralston Purina Co v Effem Foods Ltd* (1990), 31 CPR (3d) 52 (TMOB), the trademark at issue was a design mark consisting of an actual representation of a cat, rather than a fanciful one, for use in association with “pet food, namely, food for cats”. While the opposition succeeded on the basis of non-distinctiveness, Member Martin wrote:

... I wish to note that, in all likelihood, the opponent’s second ground of opposition would also have been successful. The test to be applied respecting section 12(1)(b) of the Act is the immediate impression the mark used in association with the wares creates on an everyday user of those wares. In the present case, I consider that the use of the applicant’s mark on a can or package of cat food would clearly indicate that the character

of the wares are such that they are intended for cats. The use of similar representations in the pet field by others only serves to reinforce that conclusion.

[74] In the subject proceedings, considering the Marks in association with the Goods in their entirety as a matter of immediate impression, from the perspective of the average consumer, I do not find them to be fanciful in nature. On the contrary, I find the EZ.BUMP & Design, EZ.PLANE & Design, and EZ.LOCK & Design marks to be literal pictorial representations of functional characteristics of the associated Goods, namely the lock mechanism that allows for a vertical to be installed without fasteners; the sloped plane that allows moisture to drain away from the wall; and the bump that creates an interior channel allowing moisture to drain down and away from the wall.

[75] I also consider the fact identical or near identical drawings to the applied for Marks appear in the US patent application (discussed above) to reinforce that the designs are technical and descriptive in nature. It is also noteworthy that the Marks, as they appear in the Applicant's materials (including for example the Installation Guide discussed above), are typically accompanied by text explaining the features (Singh cross-examination at Q227-236). The text is descriptive, identifies the feature (bump, slope, lock), and explains what the features do. The Marks serve the same purpose, albeit in a strictly visual capacity.

[76] Accordingly, considering the Marks as a matter of first impression within the context of the Goods, and employing a common sense approach, I find it reasonable to conclude that the first impression created by the Marks is that they clearly and plainly describe the character of the Goods, namely the inclusion of a lock mechanism that allows for a vertical trim to be installed without fasteners; a sloped plane that allows moisture to drain away from the wall; and a bump that creates an interior channel allowing moisture to drain down and away from the wall (for the EZ.LOCK & Design, EZ.PLANE & Design, and EZ.BUMP & Design marks, respectively).

[77] Accordingly, this ground of opposition is successful with respect to the Goods.

[78] As I have found the Applicant's Marks to be clearly descriptive, I need not address the deceptively misdescriptive allegation set out in the pleadings.

REMAINING GROUNDS OF OPPOSITION

[79] Having already refused the applications under at least two grounds, I will not discuss the remaining grounds of opposition.

DISPOSITION

[80] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the applications pursuant to section 38(12) of the Act.

Jennifer Galeano
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

The grounds of opposition pleaded by the Opponent in paragraph 4 of each statement of opposition (in which the Alleged Trademark refers to the EZ.BUMP & Design, EZ.PLANE & Design, and EZ.LOCK & Design mark) are reproduced as follows:

4. The grounds of opposition of the Opponent are as follows, and, unless indicated to the contrary, all references to sections and subsections in this document refer to the Canadian *Trademarks Act*:

- a) The Opponent relies on Section 38(2)(a) and says that the Application does not conform to the requirements of Section 30(b) in that the Applicant's claimed date of first use of the Alleged Trademark in association with the goods and services described in the Application, the use of which is denied, is false.
- b) The Opponent further relies on Section 38(2)(a) and says that the Application does not conform to the requirements of Section 30(b) in that the Applicant's alleged use of the Alleged Trademark, the use of which is denied, is not "use" of the Alleged Trademark as a trademark, in that the Alleged Trademark is not used for the purpose of distinguishing the goods and services described in the Application from the goods and services of others. The Alleged Trademark is, at most, a cross-sectional depiction of a portion of the Applicant's goods, which is used by the Applicant to demonstrate features of the goods or how the goods should be put into practice, used or installed, rather than for the purpose of distinguishing the Applicant's goods and services.
- c) The Opponent further relies on Section 38(2)(a) and says that the Application does not conform to the requirements of Section 30(b) in that the Applicant has not used the Alleged Trademark in association with the goods and services described in the Application, the use of which is denied, because the trademark allegedly used by the Applicant differs from the Alleged Trademark.
- d) The Opponent further relies on Section 38(2)(b) and says that the Alleged Trademark is not registrable pursuant to Section 12(1)(b) as it is clearly descriptive or deceptively misdescriptive of a character or quality of the goods in association with which it is allegedly used.
- e) The Opponent further relies on Section 38(2)(a) and says that the Application does not conform to the requirements of Section 30 in that the Alleged Trademark is not a "trademark" within the definition of Section 2. More particularly, the Alleged Trademark is not capable of being used by a person for the purpose of distinguishing the goods and services described in the application from the goods and services of others, in that the Alleged Trademark merely portrays a utilitarian or functional (or primarily utilitarian or

functional) feature of the goods in association with which it is allegedly used or the manner in which such goods should be used or installed.

- f) The Opponent further relies on Section 38(2)(b) and says that, if the Alleged Trademark is a trademark at all, the Alleged Trademark is a distinguishing guise, in that it is a shaping of the goods in association with which the Alleged Trademark is allegedly used. The Opponent says that the Alleged Trademark has not been so used in Canada by the Applicant as to have become distinctive of the Applicant at the filing date of the Application and, in addition, that the exclusive use by the Applicant of the Alleged Trademark in association with the goods and services described in the Application would unreasonably limit the development of the reveal wall systems industry in Canada. Accordingly, the Alleged Trademark does not conform to the requirements of Section 13(1)(a) or 13(1)(b), and is not registrable.

- g) The Opponent further relies on Section 38(2)(d) and says that the Applicant's Alleged Trademark is not adapted to distinguish and does not distinguish the goods and services in association with which it is allegedly used from the goods and services of others, including the Opponent.

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE 2020-01-17

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