



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 51**

**Date of Decision: 2021-03-23**

**IN THE MATTER OF AN OPPOSITION**

**Shelburne Wood Protection Ltd.**

**Opponent**

**and**

**Henry Company, LLC**

**Applicant**

**1,701,986 for TRUE BLUE**

**Application**

OVERVIEW

[1] Henry Company, LLC (the Applicant) is a company that manufactures and sells construction products including air barrier, roofing and waterproofing products. The Applicant has filed application No. 1,701,986 (the Application) to register the trademark TRUE BLUE (the Mark) in association with various education and training services in the fields of air and vapor barrier products and roofing and waterproofing chemical compositions for masonry, wood and other building constructions services.

[2] Shelburne Wood Protection Ltd. (the Opponent) opposes the Application on the basis that the Mark is confusing with the Opponent's registered trademark BLUWOOD which is used by the Opponent in association with coated wood products and lumber preservative coatings that render wood water resistant.

[3] For the reasons that follow, the Applicant has satisfied its legal burden to demonstrate that there is no reasonable likelihood of confusion with the Opponent's trademark, and therefore I reject the opposition.

#### THE RECORD

[4] The Application was filed on November 10, 2014 and is based on proposed use of the Mark in Canada in association with the following services (the Services):

(1) Educational services, namely, conducting classes, seminars and workshops in the fields of air and vapor barrier products and roofing and waterproofing chemical compositions for masonry, wood and other building constructions services and distribution of training materials in connection therewith; Training in the use and operation of products used in the fields of air and vapor barrier products and roofing and waterproofing chemical compositions for masonry, wood and other building constructions services and consultation relating thereto; Training in the use of products used in the fields of air and vapor barrier products and roofing and waterproofing chemical compositions for masonry, wood and other building constructions services; Training services in the field of air and vapor barrier products and roofing and waterproofing chemical compositions for masonry, wood and other building constructions services.

[5] The Application claims priority to a corresponding application filed in the United States on October 20, 2014.

[6] The Application was advertised for opposition purposes in the *Trademarks Journal* on August 24, 2016. On January 18, 2017, the Opponent filed a statement of opposition pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). I note that 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 which refer to the Act as it read before it was amended (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 prior to that date).

[7] The Opponent raises grounds of opposition based on registrability, entitlement, distinctiveness, and non-compliance with sections 30(e) and 30(i) of the Act. The primary basis for the opposition is an alleged likelihood of confusion with the Opponent's registered trademark

BLUWOOD (registration No. TMA890,740). The goods covered by the Opponent's registration are set out in Schedule A to this decision.

[8] The Applicant filed a counter statement on March 31, 2017 denying the grounds of opposition.

[9] Both parties filed evidence and written representations. Only the Opponent requested a hearing, but that request was conditional on the Applicant also requesting a hearing which did not occur. Consequently, the matter proceeded to a decision without a hearing.

#### EVIDENCE

[10] The parties' evidence is summarized below and is further discussed in the analysis of the grounds of opposition.

#### **Opponent's Evidence**

[11] The Opponent filed as its evidence the affidavit of David Gray sworn July 26, 2017 (the Gray Affidavit). Mr. Gray was not cross-examined.

[12] Mr. Gray is an officer and director of the Opponent. The Opponent is a private company which was incorporated in Ontario in 2006. Mr. Gray describes the Opponent's use of the trademark BLUWOOD in association with the sale and distribution of wood products and lumber preservative coatings. These products are supplied to contractors through various retail and commercial suppliers of lumber, structural components, and building materials, such as lumber yards and big box retailers such as Lowe's Canada and Home Hardware. He indicates that the Opponent has continuously used the trademark BLUWOOD in Canada since at least as early as October 18, 2009.

[13] The trademark BLUWOOD is used in association with wood which has been treated by the Opponent with a coating to render it water repellent and thus resistant to mold. The Opponent's trademark is also used in association with preservative coatings for wood that can be sold separately.

[14] The Gray Affidavit includes numerous examples of the use of the trademark BLUWOOD, including on lumber packaging, on spray bottles of sealant, and on retail displays. The Gray Affidavit also includes numerous examples of advertising of the Opponent's products in association with the trademark BLUWOOD, including online and print advertisements, features in home renovation magazines and television programs, and endorsement by a prominent individual in the construction field.

[15] The Gray Affidavit includes the Opponent's annual sales figures in Western Canada and Ontario in association with the trademark BLUWOOD for the years 2009 to 2017, as well as sales figures in Atlantic Canada in 2011 and 2012. From 2009 to 2017, the Opponent's total sales in Canada in association with the trademark BLUWOOD exceeded \$6 million.

### **Applicant's Evidence**

#### *The Tropper Affidavit*

[16] The Applicant filed as its evidence the affidavit of Marc Tropper sworn February 23, 2018 (the Tropper Affidavit). Mr. Tropper was cross-examined on his affidavit and the transcript of that cross-examination forms part of the record.

[17] Mr. Tropper is the Senior Vice President, Building Envelope Systems, Commercial Sales, of the Applicant. He states that for over 30 years the Applicant and its predecessors and affiliated companies have manufactured and sold specialty construction products such as air barrier products, roofing products, waterproofing products, concrete accessories, driveway products and performance additives.

[18] Mr. Tropper indicates that Henry Company Canada Inc. (Henry Canada) is a wholly owned subsidiary of the Applicant, and that Henry Canada acts as the Canadian distributor for products of the Applicant.

[19] Mr. Tropper states that Henry Canada is the owner in Canada of various trademarks which include the word "blue" and are used in association with air barrier products, roofing products, water proofing products, concrete accessories, driveway products and performance additives. These registered trademarks owned by Henry Canada are identified as BLUESKIN VP

(TMA830,031), BLUE SEAL Design (TMA720,138), BLUE SEAL (TMA719,128), BLUEBASE (TMA571,742), and BLUESKIN (TMA335,623), and are collectively referred to in the Tropper Affidavit as the “Henry Blue Marks”.

[20] Mr. Tropper states that the products offered for sale and sold by Henry Canada in association with the Henry Blue Marks are offered for sale and sold to Canadian distributors who then sell the products to professional contractors and installers in Canada. The products are also sold by Henry Canada to Canadian retailers such as hardware and home improvement stores which then sell the products to consumers.

[21] Mr. Tropper indicates that these products are sold in containers such as buckets, tubes and cans which bear a label marked with the relevant Henry Blue Mark, and that a Henry Blue Mark is displayed on labels affixed to all such product containers. Exhibit “A” to the Tropper Affidavit consists of printouts from the Henry Canada website which display of some of the Henry Blue Marks, including BLUE SEAL, BLUESKIN and BLUESKIN VP, as well as some examples of product packaging displayed on that website.

[22] Mr. Tropper indicates that sales in Canada for products in association with the Henry Blue Marks from 2013 to 2017 totalled in excess of \$100 million, and that annual sales for each of those years exceeded \$25 million.

*Certified copies of trademark registrations*

[23] As part of its evidence, the Applicant also filed certified copies of Canadian trademark registration Nos. TMA830,031 (BLUESKIN VP); TMA720,138 (BLUE SEAL Design); TMA719,128 (BLUE SEAL); TMA571,742 (BLUEBASE); and TMA335,623 (BLUESKIN). The listed owner of each of these registrations is Henry Canada.

ONUS AND MATERIAL DATES

[24] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the Application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably

be concluded that the facts alleged to support each ground of opposition exist [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[25] The material dates for the grounds of opposition are as follows:

- Sections 38(2)(a) / 30 of the Act - the filing date of the Application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Section 38(2)(b) / 12(1)(d) of the Act – the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- Sections 38(2)(c) / 16(3)(a) of the Act – the priority filing date of the Application [*Eartrise Farms v Saretzky* (1997), 85 CPR (3d) 368 (TMOB)]; and
- Sections 38(2)(d) / 2 of the Act - the filing date of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

#### GROUND OF OPPOSITION SUMMARILY DISMISSED

##### **Section 30(e) Ground of Opposition**

[26] The Opponent pleads that the Application does not comply with section 30(e) of the Act because the Applicant did not intend to use the Mark in Canada. There is no evidence of record to support this ground. Accordingly, the Opponent has not met its initial evidential burden for the section 30(e) ground of opposition, and this ground is dismissed.

##### **Section 30(i) Ground of Opposition**

[27] Section 30(i) of the Act requires an applicant to include a statement in the application that the applicant is satisfied that it is entitled to use the trademark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant's statement untrue, such as evidence of bad faith or non-compliance with a federal statute [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155; and

*Canada Post Corporation v Registrar of Trade-marks* (1991), 40 CPR (3d) 221 (FCTD)]. Mere knowledge of the existence of an opponent's trademark is not sufficient to support a section 30(i) ground of opposition [see *Woot Inc v WootRestaurants Inc*, 2012 TMOB 197].

[28] In the present case, the Application contains the requisite statement and there is no evidence that this is an exceptional case involving bad faith or the violation of a federal statute. Accordingly, the section 30(i) ground of opposition is dismissed.

#### GROUND OF OPPOSITION BASED ON ALLEGED CONFUSION

##### **Preliminary Comments**

[29] The Opponent's registrability, entitlement and distinctiveness grounds of opposition all turn on the question of whether there is a likelihood of confusion between the Mark and the Opponent's trademark BLUWOOD.

[30] With respect to the Opponent's registrability ground of opposition, the Opponent's statement of opposition does not expressly plead reliance on section 12(1)(d) of the Act. This is notable given that the Opponent *does* expressly identify the provisions of the Act on which it relies for all of its other grounds of opposition, including entitlement under section 16(3)(a) and distinctiveness under section 2. However, when the statement of opposition is read as a whole, I am prepared to accept that the Opponent has sufficiently raised a ground of opposition under section 12(1)(d) of the Act. In particular, at paragraph 1(b) of the statement of opposition, the Opponent identifies its registration TMA890,740 for the trademark BLUWOOD, and at paragraph 1(c)(v) the Opponent alleges that the Applicant's Mark is confusing with the Opponent's trademark. The Opponent also references reliance on section 38(2)(b) of the Act in paragraphs 1(c) and (d) of the statement of opposition.

[31] I have exercised my discretion to check the Register and confirm that the Opponent's registration remains extant [see *Quaker Oats Co Ltd of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. The Opponent has therefore met its initial evidential burden for a section 12(1)(d) ground of opposition. I am also satisfied that the Opponent has met its initial evidential burden for the section 16(3)(a) and section 2 grounds of opposition, given the

Opponent's evidence of its use and reputation in Canada in its trademark BLUWOOD prior to the material dates for those grounds.

[32] The Applicant therefore bears the legal burden of demonstrating on a balance of probabilities that there is no likelihood of confusion between the Mark and the Opponent's trademark. In conducting the confusion analysis, below, I do so with reference to the registrability ground of opposition, for which the material date is the date of my decision, since this allows me to consider the parties' evidence in full. However, the outcome of the confusion analysis is the same for the entitlement and distinctiveness grounds of opposition, as the earlier material dates for those grounds have no impact on the analysis in this case.

### **Test for Confusion**

[33] The test for confusion is set out in section 6(2) of the Act which provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods and services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods and services are of the same general class or appear in the same class of the Nice Classification. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time the trademarks have been in use; (c) the nature of the goods and services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them.

[34] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, [2006] 1 SCR 772 at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.



[35] The test for confusion is assessed as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the applicant's mark, at a time when he or she has no more than an imperfect recollection of the opponent's trademark, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot, supra*, at para 20].

*The inherent distinctiveness of the trademarks and the extent to which they have become known*

[36] In my view, the Opponent's trademark BLUWOOD possesses at least some inherent distinctiveness. The component "BLU" is unique in that it is a misspelling of the word "BLUE". The Applicant argues that the Opponent's trademark lacks inherent distinctiveness because the Opponent's BLUWOOD wood products are in fact blue in colour as a result of the Opponent's treatment process. However, in my view, the Opponent's trademark retains at least some inherent distinctiveness given the contraction of the two terms "BLU" and "WOOD" and the unique spelling of the first component.

[37] In addition, I am satisfied that the Opponent's trademark BLUWOOD has become known in Canada within the Opponent's channels of trade, given the Opponent's evidence of its use and advertising of the trademark in Canada since 2009.

[38] With respect to the Applicant's Mark, in my view, it possesses a higher degree of inherent distinctiveness than the Opponent's trademark. "TRUE BLUE" is an English dictionary term and thus in my view the Mark is likely to be read as a unitary phrase. In particular, the *Canadian Oxford Dictionary*, 2nd Ed. defines "true-blue" as "*adjective* **1** steadfastly loyal or devoted. **2** real; genuine." [see *Tradall SA v Devil's Martini Inc*, 2011 TMOB 65 (TMOB) at para 29 which provides that the Registrar can take judicial notice of dictionary definitions]. As the term "TRUE BLUE" does not describe any particular feature or character of the Applicant's Services, the Mark possesses inherent distinctiveness. With respect to the extent to which the Mark has become known, the Application is based on proposed use and there is no evidence to suggest that the Applicant has commenced using the Mark in Canada. Thus, there is no evidence that the Mark is known at all in Canada.

[39] Taking into account the inherent distinctiveness of the trademarks and the extent to which they have become known, on balance, this factor favours the Opponent given the extent of the Opponent's use of its trademark. However, in my view, this factor only favours the Opponent to a slight degree given the higher degree of inherent distinctiveness of the Applicant's Mark.

*The length of time the trademarks have been in use*

[40] The evidence demonstrates that the Opponent has used its trademark BLUWOOD in Canada since at least as early as 2009. In contrast, the Application is based on proposed use of the Mark in Canada and there is no evidence to suggest that use of the Mark has commenced. Therefore, this factor favours the Opponent.

*The nature of the goods, services or business; and the nature of the trade*

[41] When considering the goods and services of the parties, it is the statement of goods and services in the parties' trademark application and registration that govern the issue of confusion [see *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties can be useful, particularly where there is an ambiguity as to the goods or services covered in the application or registration at issue [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB)].

[42] In the present case, the Services listed in the Application do not overlap directly with the goods listed in the Opponent's registration, in that the Opponent's goods are the treated wood products themselves, while the Applicant's Services are education and training services relating to multiple different construction materials and methods. That said, I am satisfied that the parties' respective goods and services are sufficiently close in nature, in that both relate to mechanisms and techniques for wood waterproofing, and are likely to travel through similar channels of trade in Canada, that this factor favours the Opponent.

*Degree of resemblance*

[43] When considering the degree of resemblance, it is preferable to first consider whether there is an aspect of the trademark that is “particularly striking or unique” [*Masterpiece, supra*, at paragraph 64].

[44] In my view, the striking or unique aspect of the Opponent’s trademark is the component “BLU”, given its novel spelling. With the Applicant’s Mark, the striking aspect is “TRUE BLUE” as a whole, given that this term is likely to be read as a unitary phrase since it is an English dictionary term.

[45] Despite the common presence of “BLU”, in my view, the trademarks as a whole appear and sound quite different. The first and last components of the parties’ respective trademarks are different, and the Mark does not incorporate the unique spelling “BLU” in the Opponent’s trademark.

[46] In addition, the ideas conveyed by the trademarks are different. In this regard, I agree with the following submission of the Applicant set out in paragraphs 45 and 46 of the Applicant’s written representations:


45. The idea suggested by the Trademark is also much different than the idea suggested by the Opponent’s mark. The Opponent’s mark conveys the idea of blue coloured wood. This is precisely what the Opponent intended as well since its products “colour” wood blue.

46. By contrast, the Trademark connotes the idea of fidelity or authenticity (i.e. a “true blue” friend). This is supported by the dictionary definition of “true blue”.

[47] As noted above, the degree of resemblance between the trademarks is often the most significant factor in the confusion analysis. In the present case, despite the common presence of “BLU”, I consider the degree of resemblance between the parties’ trademarks to be low, such that this factor favours the Applicant.

*Surrounding circumstance – Trademarks owned by Henry Canada*

[48] As part of its evidence, the Applicant filed certified copies of the following Canadian trademark registrations, each owned by Henry Canada, a wholly owned subsidiary of the Applicant:

<b>Reg. No.</b>	<b>Trademark</b>	<b>Goods</b>
TMA830,031	BLUESKIN VP	Synthetic non-woven barrier material in the nature of sheets of plastic fabric used as a protective and isolative barrier in building construction.
TMA720,138		Waterproofing compound for sealing and waterproofing concrete, masonry, polymeric insulation board, foam, asphalt, tile, wood, metal, and other building and/or construction surfaces.
TMA719,128	BLUE SEAL	Waterproofing compound for sealing and waterproofing concrete, masonry, polymeric insulation board, foam, asphalt, tile, wood, metal, and other building and/or construction surfaces.
TMA571,742	BLUEBASE	Building materials, namely, self-adhesive roofing membranes.
TMA335,623	BLUESKIN	Building material, namely, membrane to impede air flow.

[49] The Tropper Affidavit indicates that these trademarks are used in Canada by Henry Canada, and that Canadian sales in association with these trademarks collectively exceeded \$25 million per year from 2013 to 2017. When this is considered in conjunction with the product examples included as Exhibit “A” to the Tropper Affidavit and the description of product packaging in paragraphs 8 and 9 of the Tropper Affidavit, I am satisfied that the Applicant has demonstrated use in Canada by Henry Canada of at least the trademarks BLUE SEAL, BLUESKIN and BLUESKIN VP.

[50] It is well established that the existence of prior registrations owned by a party does not automatically entitle that party to register a similar trademark [see *Groupe Lavo Inc v Proctor & Gamble Inc* (1990), 32 CPR (3d) 533 (TMOB) at para 15; see also *Highland Feather Inc v*

*American Textile Co*, 2011 TMOB 16 at para 20]. Moreover, in the present case, these prior registrations are not owned by the Applicant, but by a different legal entity, Henry Canada. The Applicant has not demonstrated, nor has it argued, that Henry Canada's use of these trademarks accrues to the Applicant. Effectively, these are third party registrations from the perspective of the parties to this opposition.

[51] Nevertheless, the presence on the register of these third party trademarks which incorporate the term "BLUE", combined with the evidence of their use in Canada on a significant scale in association with relevant goods, does weaken the Opponent's claim that the presence of the word "BLUE" in the Applicant's Mark is sufficient to give rise to a likelihood of confusion. The coexistence in the Canadian marketplace of these trademarks owned by Henry Canada and the Opponent's trademark suggests that consumers are able to distinguish between such marks based on features other than the word "BLUE". I do not consider that coexistence on its own to be dispositive of the issue of confusion, nor do I consider it as significant a factor as the assessment of the degree of resemblance between the trademarks, discussed above. However, I do consider it a surrounding circumstance which weighs in the Applicant's favour.

#### Conclusion regarding confusion

[52] Having considered all of the surrounding circumstances, I conclude that the Applicant has satisfied its legal burden to show that there is no reasonable likelihood of confusion between the parties' trademarks. Notwithstanding the Opponent's use and reputation in Canada in its trademark BLUWOOD, I do not consider the degree of resemblance between the trademarks to be sufficiently high as to give rise to a likelihood of confusion.

[53] Consequently, I reject the section 12(1)(d), section 16(3)(a) and section 2 grounds of opposition.

DISPOSITION

[54] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

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Timothy Stevenson  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

## **SCHEDULE A**

### **Canadian Registration No. TMA890,740**

#### **Goods**

(1) Water repellant, anti-microbial-supportive film treated dimensional lumber, plywood, oriented strand board (OSB), and engineered wood products, namely, wafterboard, particleboard, fiberboard, insulation board, drywall board, floor joists, roof trusses and rim board.

(2) Water-repellant, anti-microbial-supportive film treated fascia board, trim board, wood siding, mill work, namely, interior finish components, namely, baseboards, mantles, window casings and crown moulding, wood window frames, wooden doors, wood door frames, and wood columns; liquid and spray forms of compound to apply to wood products to provide an anti-microbial-supportive film.

(3) Water repellant, anti-microbial-supportive film treated lumber, cut timber, composite wood-based sheathing products, and fiber-based sheathing products for construction made of wood and wood fibers, namely, wooden timbers, floor joists, headers, sheathing board, sub flooring, beams, rafters, studs, non-metal roof trusses, plywood, oriented strand board, laminated veneer lumber, particle board, chip board, fiberboard for use in floors, walls, ceilings and roofs; lumber, cut timber, wood-based sheathing products and fiber-based sheathing products treated with a surface conditioning, priming, water repellant anti-microbial-film, namely, soffit and fascia, sashes, non-metal fencing, wood trim, non-metal girders, non-metallic columns, wood flooring, non-metal doors, wood siding, chip boards for the furniture industry, plywood, oriented strand board, laminated veneer lumber, particle board, chip board, and fiberboard for use in floors, walls, ceilings and roofs.

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

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**HEARING DATE** No Hearing Held

**AGENTS OF RECORD**

Osler, Hoskin & Harcourt LLP

For the Opponent

CPST Intellectual Property Inc.

For the Applicant