

# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2025 TMOB 21

**Date of Decision:** 2025-01-31

## **IN THE MATTER OF AN OPPOSITION**

**Opponent:** Five Seasons Comfort Limited

**Applicant:** Products Unlimited, Inc.

**Application:** 1922128 for FILTER Design

## **BACKGROUND**

[1] Products Unlimited, Inc. (the Applicant), is a leader in making innovative filtration products used in many different types of businesses, including industrial, commercial and residential. On September 26, 2018, it filed an application for the trademark FILTER Design (the Mark), which, as amended, is represented visually and described as follows:

Position

The trademark consists in whole or in part of the positioning of a sign.

Visual representation



#### DESCRIPTION

The trademark consists of the position of generally diamond-shaped apertures in which a column of generally diamond shaped apertures is slightly offset from another column to either side, the goods are shown with a dashed outline and do not form part of the trademark but is included merely to show the positioning of the trademark.

[2] The goods applied for in association with the Mark, as amended, are air filters for industrial and commercial uses and installations namely filters for paint booths (the Goods).

[3] Five Seasons Comfort Limited (the Opponent), is a manufacturer of high efficiency Electronic, Media and HEPA Air Cleaning Systems for residential, commercial and industrial applications. It has opposed the application on a number of grounds, including that the Mark is intended to perform a utilitarian function.

[4] For the reasons that follow, the application is refused.

#### **FILE RECORD**

[5] The Mark was advertised in the *Trademarks Journal* on August 17, 2022.

[6] On February 2, 2023, the Opponent filed a statement of opposition pursuant to section 38 of the *Trademarks Act*, RSC 1985, C T-13 (the Act), as amended, asserting numerous grounds of opposition against the Mark, (set out in the attached Schedule A).

[7] The Applicant filed and served a counter statement denying each of the grounds of opposition.

[8] As its evidence in chief, the Opponent filed the affidavit of Julia Walters, sworn July 28, 2023, as well as a certified copy of the file history for this application No. 1,922,128. Ms. Walters is an assistant employed by the Opponent's agent. In addition to providing particulars of the file history for the Applicant's application, Ms. Walters conducted a search on CIPO's database and identified all trademark applications and registrations in the name of the Opponent. Attached to her first affidavit as exhibits B1 – B9 are printouts of each of the Opponent's trademark registrations. She also conducted searches for the Opponent's company and provided as exhibits C-I printouts of the landing page for its website as well as a printout of the Opponent's catalogue and other information about the Opponent's company. Attached as Exhibits N through W of her affidavit are printouts of webpages from various third party manufacturers of various types of filters.

[9] In support of its application, the Applicant filed the affidavit of Michael Beier. Mr. Beier is the Vice President of the Applicant, and has held that position since 2008. Mr. Beier generally provides information about the Applicant's business and the applied for Mark. For example, he notes that the Applicant's filters are marketed and sold under the trademark "Paint Pockets".

[10] As its evidence in reply, the Opponent filed a second affidavit of Julia Walters, this one sworn January 19, 2024. In the second Walters affidavit,

Ms. Walters states that she conducted a Google search for "Paint Pockets". Her search revealed a business called Paint Pockets Company, located at the same address of record of the Applicant. She was then directed to the Paint Pockets Company website at *www.paintpockets.com*, for which she attached website printouts to her affidavit. The Applicant did not object to the Opponent's reply evidence.

[11] Neither affiant was cross-examined on their affidavits.

[12] Both parties filed written representations but neither party requested an oral hearing.

### **SUMMARY OF THE EVIDENCE**

[13] I have studied all of the evidence but do not find it necessary to summarize it in detail; instead I will focus below on those portions that I consider the most pertinent to the issues at hand.

#### ***The Applicant's Activities With Respect to the Mark.***

[14] I will begin by summarizing the history of this application, which was attached as part of the Opponent's evidence.

[15] At the filing date of the Application, the Applicant described the Mark as follows:

The mark consists of a configuration of a filter design which includes columns of generally diamond-shaped apertures in which a column of generally diamond-shaped apertures is slightly offset from another column to either side.

[16] On November 8, 2021, the Examiner raised an objection pursuant to section 12(2) of the Act, indicating that the test was whether the Mark's features were primarily designed to perform a function and whether registration would grant a trader a monopoly on its functional feature.

[17] The Examiner stated that a trademark's features were dictated primarily by a utilitarian function if those features were essential to the use or purpose of the goods listed in the application. The Examiner initially concluded that the Mark was considered to perform a function of the Goods and therefore unregistrable in view of section 12(2) of the Act. He further explained that his objection was to be considered an absolute bar to registration since the Act does not permit an applicant to file evidence showing that the trademark had acquired distinctiveness as of the filing date. However, he added that the objection under section 12(2) may be overcome either by convincing the Registrar that the trademark's features are not dictated primarily by a utilitarian function, or by excluding those features from the trademark (by way of a statement to that effect and by depicting the feature(s) in dotted outline in any visual representation).

[18] The Applicant submitted further amended applications on June 1, 2022, and June 29, 2022. The final amended application, as advertised for opposition purposes, is reproduced below:

The trademark consists of the position of generally diamond-shaped apertures in which a column of generally diamond-shaped apertures is slightly offset from another column to either side, the goods are shown with a dashed outline and do not form part of the trademark but is included merely to show the positioning of the trademark.

[19] As noted above, the Applicant submitted the affidavit of Mr. Beier as its evidence in chief. Mr. Beier explains that the Mark has been used in Canada since at least as early as January, 1998. He provides evidence of sales of filters in Canada between 2019 and 2023, ranging between \$885,928 US and \$1,570,113 US per year.

[20] Mr. Beier emphasizes the following about the features of the Mark at paragraphs 5 and 6 of his affidavit:

5. It is important to emphasize that the offset columns of diamond-shaped apertures are embedded into the filter media itself, they are not separate covers or frames over a filter as is the case with other companies' filters.

6. The diamond-shaped apertures are non-functional with respect to any other shape such as triangles, circles, rectangles, and the like. The diamond-shape does not offer any functional benefit over any other shape. The diamond-shaped apertures are used to distinguish Products Unlimited filters from others. The diamond-shape has been used for more than 20 years and is recognized throughout the industry because of this shape.

[21] The Opponent's evidence also includes the following statements regarding the Applicant's products from the Paint Pockets website:

Paint Pockets is the best performing single stage overspray arrestor, bar none...*Its unique design holds up to five times more overspray than other filters*, enabling you to cut your filter changes by up to 80%. *The three dimensional pockets embedded in the front face of Paint Pockets more than double its surface area*, allowing the arrestor to capture and hold very large quantities of overspray. *Paint Pockets arrestors have superior wet tensile strength*. Arrestors loaded with wet overspray do get heavy, but they won't tear or sag [second Walters Affidavit, Exhibit C.1, emphasis added].

*Its unique pockets enable Paint Pockets to accumulate significant quantities of overspray before it begins to noticeably restrict booth airflow*. This feature permits you to "tune" your entire finishing process for maximum transfer efficiency and, more importantly, to operate in the optimum efficiency zone. Increased transfer efficiency means more parts coated per quantity sprayed and longer intervals between filter changes. A higher percentage of the finish is coating parts instead of the arrestors [second Walters Affidavit, Exhibit C.1, emphasis added].

[22] The Opponent admits that Ms. Walters was not in a position to confirm the truth of the contents of the third party websites attached to her affidavits, including the printouts of the Applicant's website, as they constitute hearsay. I am prepared, however, to give full weight to the printouts of the Applicant's website, despite them being hearsay. In this regard, I find that these printouts were necessary for the Opponent to challenge the registrability of the Applicant's Mark. I also consider these

printouts to be reliable since the Applicant appears to have participated in their creation and also had the opportunity to refute the evidence [see *Reliant Web Hostings Inc v Tensing Holding BV*, 2012 CarswellNat 836 (TMOB) at para 35].

### ***Filters of Third Parties and Those of the Opponent***

[23] Primarily in support of its distinctiveness ground of opposition as pleaded, the Opponent has provided evidence concerning its filters as well of those of other filters in the Canadian marketplace.

[24] Ms. Walters attaches as Exhibit B.1 to B.9 of her first affidavit a printout of each of the following registrations of the Opponent:

Exhibit	Trademark	Serial/Reg. No.
B.1		TMA489811
B.2	FIVE SEASONS	TMA235798
B.3	LABAIRE	TMA193897
B.4		TMA310553
B.5		TMA903300
B.6	CINQUARTZ	TMA793842
B.7		TMA581751
B.8		TMA590906
B.9	ElectroAir	TMA581649

[25] Attached as Exhibits C-I to Ms. Walters' first affidavit are various printouts about the Opponent's business from the Opponent's website

*www.fiveseasonaircleaners.com* and other websites. Attached as Exhibits N to W to Ms. Walter's affidavit, are "print screen printouts" for various air and furnace filters from the following websites: *www.amazon.ca*, *www.uline.ca*, *www.kochfilter.com*, *www.homedepot.ca*, *www.canadiantire.ca*. The Opponent maintains that sales of third party manufacturers' air filters on Amazon indicate that two of them were first available in Canada as of April 1, 2015, and September 25, 2013 (see Walters first affidavit, Exhibits N and O). Further, on July 27, 2023, Ms. Walters purchased two Filtrete air filters from a Canadian Tire store located in Toronto.

[26] As noted earlier, the Opponent admitted that Ms. Walters was not in a position to confirm the truth of the contents of the third party websites attached to her affidavit as they constitute hearsay. Indeed, the mere existence of the web pages does not establish the extent or duration of use of the filters that may be displayed on them or even that the pages have been accessed by relevant consumers [*ITV Technologies Inc v WIC Television Ltd*, 2003 FC 1056 at paras 21-22; *aff'd* 2005 FCA 96]. Accordingly, the third party websites attached to her affidavit are of little evidential value, aside from establishing that the websites did in fact exist.

### **ONUS**

[27] There is no dispute that there is an initial evidentiary 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 exists.

[28] Once this initial burden is met, the Applicant must satisfy the Registrar, on a balance of probabilities, that the grounds of opposition pleaded should not prevent the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd*, 1990 CanLII 11059 (FC), 30 CPR (3d) 293 (FCTD) at



298; *Dion Neckwear Ltd v Christian Dior, SA*, 2002 FCA 29, 20 CPR (4th) 155 (FCA)].

## **OVERVIEW**

[29] This case is unique by virtue of the nature of the Mark itself, since the Mark is of a non-traditional nature, in that it is “the position of a sign” [section 2 of the Act and section 31(e) of the Regulations]. Non-traditional trademarks have only been recognized by the Act since it was amended on June 17, 2019. It is therefore no surprise that an opposition to a Mark trademark consisting of “the position of a sign” has not yet been considered in any prior decisions of this Board nor of the Federal Court.

[30] Further, in view that the Mark was advertised after June 17, 2019, the Act as amended applies. This is particularly noteworthy given that the provisions in the Act prior to June 17, 2019 relating to other previous non-traditional trademarks (such as distinguishing guises under the former section 13 of the Act) will not be applied in this case. The concept of “distinguishing guise” was removed from the Act by way of the June 17, 2019, amendments.

[31] Section 13(1)(b) of the Act related to distinguishing guises, and was considered a statutory codification of the well-recognized “functionality doctrine” which prohibits the registration of any trademark which is wholly or primarily functional or utilitarian: *Kirkbi AG v Ritvik Holdings Inc*, 2005 SCC 65 at para 60. Given that the new definition of a trademark in section 2 of the Act includes those marks which may have formerly been referred to as distinguishing guises, jurisprudence of the Registrar and the Federal Court regarding distinguishing guises may inform the development of jurisprudence regarding this type of non-traditional trademark [see, for example, *Protecting Non-Traditional Trademarks in Canada, Practical Law*

*Canada Practice Notice*, by Daniel G.C. Glover, Partner and Marissa Caldwell, Associate, McCarthy Tetrault LLP, January 24, 2024].

[32] Finally, I note that the concept of functionality is not limited to distinguishing guises but is also applicable to two dimensional design marks [*Remington Rand Corp v Philips Electronics N.V.* (1995), 64 CPR (3d) 467 (FCA) at p.476 and *Anenda Systems Inc v EasyTrim Reveals Inc*, 2020 TMOB 96].

### **ANALYSIS OF THE GROUNDS OF OPPOSITION**

[33] I will begin by noting that the grounds pleading that the Mark is not registrable having regard to section 18.1 of the Act are not proper grounds of opposition. In this regard, section 18.1 of the Act applies to situations when the Federal Court may expunge a trademark registration for being invalid. The TMOB does not have authority to make such a finding under section 18.1. Further, the present case concerns a trademark application, not a trademark registration. Both of these grounds have accordingly been dismissed.

[34] With respect to the other grounds of opposition, it is apparent from the parties' evidence and submissions that there are key issues in this proceeding, each of which constitute a basis for multiple grounds of opposition raised by the Opponent. For example, the statement of opposition alleges in various sections that the diamond shaped apertures of the Mark are functional.

[35] Therefore, even though the Opponent only focused on the grounds based on sections 30(2)(a), 12(1)(b), 2 and 38(2)(a.1) of the Act in its written representations, in view that the evidence concerning the Mark and whether its features perform a utilitarian function is pertinent to a number of the grounds of opposition, I consider it useful at this point to first consider

whether the features of the Mark are dictated primarily by a utilitarian function.

**Section 12(2) Ground of Opposition**

[36] The Opponent's section 12(2) ground of opposition is pleaded as follows:

Pursuant to Section 38(2)(b), the Applicant's Trademark is not registrable having regard to Section 12(2) in that the "generally diamond-shaped apertures in which a column of generally diamond-shaped apertures is slightly offset from another column to either side" shown and featured in the Applicant's Trademark (and as described in the Applicant's Application) are dictated primarily by a utilitarian function. These "generally diamond-shaped apertures", as shown and described in the Applicant's Trademark, are a structural feature of the Applicant's Goods (e.g., air filters) that are intended to maximize structural support and rigidity while also maximizing airflow.

[37] Section 12(2) of the Act denies registration of a trademark if, in relation to the goods or services listed in the application, its features are dictated primarily by a utilitarian function.

[38] The legal principle of the functionality doctrine in trademark law prohibits registration of functional product features. The functionality doctrine, as noted by the Supreme Court of Canada in *Kirkbi AG v Ritvik*, *supra*, ensures that protection for utilitarian product features are provided through a limited-duration patent, not through the potentially time-unlimited (by way of renewal) protection of a trademark registration.

[39] The test, as set out above, is whether the trademark's features are primarily designed to perform a function and whether registration would grant a trader a monopoly on their functional features. A trademark's features are dictated primarily by a utilitarian function if those features are

essential to the use or purpose of the goods or services listed in the application.

[40] The doctrine of functionality is also important when assessing whether non-traditional trademarks are registrable. As stated in the article *Protecting Non-Traditional Trademarks in Canada*, *Practical Law Canada Practice Notice*, *supra*:

Moreover, under Trademarks Act, section 12(2), a trademark is not registrable if, in relation to its goods or services, its features are dictated primarily by a utilitarian function. The Supreme Court of Canada has described the doctrine of functionality as “a logical principle of trade-marks law. It reflects the purpose of a trade-mark, which is the protection of the distinctiveness of the product, not of a monopoly on the product” (see *Kirkbi AG v. Ritvik Holdings Inc. / Gestions Ritvik Inc.*, 2005 CarswellNat 3631 (S.C.C.), at paragraph 42). The doctrine of functionality will be a particularly significant factor when assessing whether non-traditional trademarks are registrable.

Has the Opponent Met its Initial Evidential Burden?

[41] In considering whether the Mark is not registrable pursuant to section 12(2) of the Act, the two primary questions to be asked in this case are as follows:

1. Is the Mark physically essential to the Applicant's Goods (*i.e.* filters for paint booths) [see *IVG Rubber Canada Ltd v Goodall Rubber Co* (1980), 48 CPR (2d) 268 (FCTD)]?; and;
2. Does the Mark contain functional elements? That is, is the pattern of generally diamond-shaped apertures in which a column of generally diamond shaped apertures is slightly offset from another column to either side functional or simply an ornamental feature of the Mark [see *Samann v Canada's Royal Gold Pinetree Mfg Co Ltd* (1986), 9 CPR (3d) 223 (FCA)]?

[42] The Opponent's position, as I understand it, is that the printouts from the Applicant's website assist in explaining the purpose of the generally diamond shaped apertures which appear as part of the Applicant's Mark. In this regard, many materials on the Applicant's website refer to the "unique design" of the Applicant's filters that are able to "hold up to 5X more overspray than other filters." Further, Exhibit C.1 states "the three dimensional "pockets" embedded in the front face of the Paint Pockets more than double its surface area, allowing the arrestor to capture and hold very large quantities of overspray".

[43] The Applicant's position, on the other hand, is that there are no facts pled nor evidence on record to support the allegation that "generally diamond shaped apertures in which a column of generally diamond shaped apertures is slightly offset from another column to the either side" is a structural feature of the Applicant's filters. The Applicant maintains that it seeks protection of a position of a sign. It does not seek protection of any structural or functional aspect of the Goods.

[44] In my view, the statements from the Paint Pockets website regarding the functional benefits of the apertures in the Applicant's product are sufficient to at least raise the question of whether the Mark as claimed is primarily functional. In particular, these statements refer specifically to the "superior wet tensile strength", and at least suggest that the apertures embedded in the Applicant's product provide this strength. These statements also refer to the increased surface area and overspray capacity of the Applicant's product, and again suggest that the apertures embedded in the Applicant's product provide these functional advantages. At a minimum, these statements at least suggest that the reason the apertures are positioned on the Applicant's product is to provide the functional advantages

described therein. In other words, the apertures at least appear essential to the use or purpose of the Applicant's filters.

[45] In *Parke Davis & Co Ltd v Empire Lab (1963)*, 41 CPR 121 (Ex. Ct.), 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 trademark has a functional use. In this case, there is no evidence of a patent. However, upon review of the printouts from the Applicant's website, Exhibit B.3 to the second Walters Affidavit refers to Paint Pockets' patented design working because it provides superior depth loading of the filter. In my view, while not as strong as the evidence of a patent itself, I still find this evidence relevant to the assessment of whether the Mark is primarily functional.

[46] In view of the above, I am satisfied that the Opponent has met its initial evidential burden under this ground of putting into issue the primarily functional nature of the Mark. The onus therefore now shifts to the Applicant to satisfy the Registrar, on a balance of probabilities, that the Mark is registrable.

#### Has the Applicant Met its Onus?

[47] In its written representations, the Applicant maintains that its generally diamond shaped apertures are a unique non-functional design feature of the goods.

[48] In making these submissions, the Applicant primarily relied on the following pertinent points from the affidavit of Mr. Beier:

- His confirmation that in the Mark's description, the goods shown with a dashed outline do not form part of the Mark but is merely to show the positioning of the Mark; and

- His statement that the diamond shaped apertures are non-functional with respect to any other shape and the diamond shape does not offer any functional benefit over any other shape.

[49] However, while the diamond shape of the aperture may not have any functionality, the Mark is not directed to *only* the shape of the apertures. Rather, the Mark is for the *positioning* of a series of apertures across the face of the Applicant's filter product. In view of the statements from the Paint Pockets website discussed above, which suggest that the apertures in the Applicant's filter products are responsible for multiple functional benefits, it is at best unclear whether the *positioning* of these apertures across the face of the Applicant's filter product, as shown in the drawing provided in the application, provide the functionality described on the website. For at least this reason, the Applicant has not met its onus of demonstrating that the Mark is not unregistrable by reason of section 12(2) of the Act.

[50] In addition, I find it useful to review the history of the prosecution of this application, as set out in the certified copy of the file wrapper attached to Ms. Walters' first affidavit. I reproduce below how the Mark was initially described for ease of reference:

The mark consists of a configuration of a filter design which includes columns of generally diamond-shaped apertures in which a column of generally diamond-shaped apertures is slightly offset from another column to either side.

[51] The description of the Mark was later amended to overcome the Examiner's objections. In this regard, the Applicant responded both by amending the description of the Mark, indicating that the Mark consists of the *positioning* of the diamond-shaped apertures on the filter product, and stating that the goods shown in the dashed outline did not form part of the Mark. The Applicant also provided a statement that the Mark was not functional.

[52] While the Mark was approved for advertisement, I wish to point out that the onus and evidence before an Examiner differs from that in an opposition proceeding [*Cortefiel, SA v Doris Inc*, 2013 FC 1107 at paras 37-38]. For example, in this case the Examiner did not have before it the evidence from the Applicant's own website which, as noted above, refers to the functional features of the positioning of the diamond shaped apertures that comprise the Applicant's filters.

[53] Further, all the Applicant has essentially done to meet the higher onus in this opposition proceeding is provide evidence of its affiant simply repeating the statement that was provided to the Examiner, *i.e.* that the Mark is not functional. However, as mentioned above, while this evidence relates to the shape of the apertures, the Mark appears to be somewhat more broad than this. In particular, the Mark includes the *positioning* of the apertures on the Applicant's filter product which, in view of the statements from the Paint Pockets website, may provide a functional benefit.

[54] In view of the above, I am not satisfied that the Applicant has met the legal onus upon it under this ground. It is at best not clear whether the Mark is primarily functional. As stated by MacGuigan J.A. at p. 475 of the decision in *Remington Rand Corp v Philips Electronics NV, supra*:

If functionality goes either to the trade mark itself (Imperial Tobacco, and Parke, Davis) or to the wares (Elgin Handles), then it is essentially or primarily inconsistent with registration. However, if it is merely secondary or peripheral, like a telephone number with no essential connection with the wares, then it does not act as a bar to registration.

[55] The section 12(2) ground of opposition therefore succeeds.

***Section 38(2)(d) Ground of Opposition***

[56] Under the non-distinctiveness ground of opposition, the Opponent has pleaded as follows:



Pursuant to Section 38(2)(d), the Applicant's Trademark is not distinctive within the meaning of Section 2 of the Act. In particular, the Applicant's Trademark does not, and is not adapted to, distinguish the Applicant's Goods from the goods of others, and in particular, of air filters for furnaces, air conditioners, room air purifiers, air humidifiers and dehumidifiers, and other industrial and commercial uses and installations namely filters for paint booths, which have been sold by the Opponent and which appear with "generally diamond-shaped apertures in which a column of generally diamond-shaped apertures is slightly offset from another column to either side", including those shown in Schedule "A", and which have been sold in Canada since at least as early as prior to the 26 September 2018 filing date and the alleged 5 September 2018 priority date of the Applicant's Application, and have been continuously sold to date.

Pursuant to Section 38(2)(d), the Applicant's Trademark is not distinctive within the meaning of Section 2 of the Act. In particular, the Applicant's Trademark does not, and is not adapted to, distinguish the Applicant's Goods from the goods of others, and in particular, of air filters for furnaces, air conditioners, room air purifiers, air humidifiers and dehumidifiers, and other industrial and commercial uses and installations namely filters for paint booths, which have been sold by the Third Party Manufacturers and which appear with "generally diamond-shaped apertures in which a column of generally diamond-shaped apertures is slightly offset from another column to either side", including those shown in Schedules "B" to "I", and which have been sold in Canada since at least as early as prior to the 26 September 2018 filing date and the alleged September 2018 priority date of the Applicant's Application, and have been continuously sold to date.

[57] The material date for assessing non-distinctiveness is the filing date of the opposition, *i.e.*, February 2, 2023 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185 (CanLII), 34 CPR (4th) 317 (FC)].

[58] Under the terms of section 2 of the Act, the term "distinctive", in relation to a trademark, describes a trademark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or that is adapted so to distinguish them". To prove the distinctiveness of a trademark, the three conditions set out in

*Philip Morris Inc v Imperial Tobacco Ltd* (1985), 7 CPR (3d) 254 (FCTD) at page 270; upheld by (1987), 17 CPR (3d) 289 (FCA) must be met:

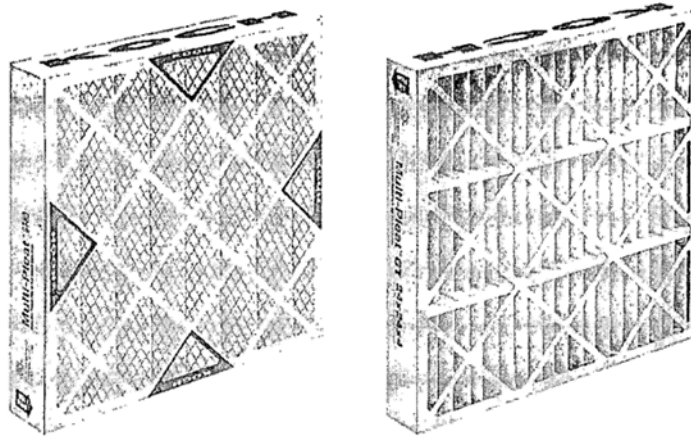
(1) that a mark and a product (or ware) be associated; (2) that the « owner » uses this association between the mark and his product and is manufacturing and selling his product; and (3) that this association enables the owner of the mark to distinguish his product from that of others.

Has the Opponent Met its Initial Evidential Burden?

[59] The Opponent's position is that the Mark is not adapted to distinguish the Applicant's Goods from those of others which had been sold both by the Opponent and by third party manufacturers as set out in Schedules B – I and N - W of Ms. Walters' first affidavit.

[60] The Applicant's position is that the Opponent has provided an abundance of evidence that shows various filters, all of which consist of structural covers, support frames or some other diagonal or diamond grid pattern that is separate from the filter itself, none of which are similar to the Goods of the Applicant. The Applicant adds that many of the filters depicted by the Opponent are basic pleated air filters with a wave pattern used to increase the surface area of the filter. The filters include paper frames and mesh grids which include diagonal based support structures (both paper and wire mesh), which add strength to the related filters.

[61] For example, the following filter from Exhibit U of the first Walters' affidavit is generally representative of all of the third party manufactured filters depicted in the Opponent's evidence:



[62] The Applicant's filter, on the other hand, was depicted as follows in the evidence of Mr. Beier:



[63] The Applicant maintains that the Opponent has failed to show any connection or association or similarity between its filters and those of the third party manufacturers and those of the Applicant. The Applicant further submits that it amended its application to narrow the description of goods to "air filters for industrial and commercial uses and installations namely filters for paint booth", in an attempt to further distinguish the Applicant's goods from the goods of the Opponent or other third party manufacturers.

[64] I agree with the Applicant that the Opponent has not met its initial burden under this ground for the following reasons.

[65] First, while the Opponent has relied upon numerous other filters in its statement of opposition and in its evidence, the submission that these filters are similar to the Mark is tenuous. In this regard, none of the Opponent's nine trademark registrations relate to diamond shapes or designs in any manner whatsoever. Further, none of the printouts from the Opponent's website nor those of any of the third parties show any products similar to the Mark. While some of the photos depict filters with diagonal or diamond shapes, these are within structural covers or support frames for those filters. None are actually shown to have embedded diamond shaped apertures in which a column of generally shaped apertures is slightly offset from another column to either side.

[66] As pointed out by the Applicant, the online article entitled "How to Pick the Best 16x25x4 Air Filter for the Furnace" attached as Exhibit Y to Ms. Walters' first affidavit suggests that air filters have frames separate from the filter material itself used for strength. In this regard, the article states the following at section 1 Frame Strength:

16x25x4 furnace filters will have a variety of filter frame strength and a grid over the front. The front grid usually has a diamond-shaped pattern or has a type of metal mesh.

[67] Further, the photos of the third party filters also show filters with structural covers, support frames or some other diagonal or diamond grid pattern that is separate from the filter itself. Exhibit Z, for example, shows photos of filters which have a paper frame and a metal diamond grid, likely used to add strength to the filter (as set out in the article attached as Exhibit Y). While these diagonal support structures could be viewed as diamond shaped, they are different from the Applicant's diamond shaped apertures. In this regard, unlike the filters evidenced by Ms. Walters, the offset columns of diamond shaped apertures are embedded in the Applicant's filter media

itself and are not separate structural covers or support frames as is the case with third party filters.

[68] Finally, as no sales figures for any of these filters has been provided (other than evidence of one purchase of two Filtrete air filters at a Canadian Tire store after the material date for this ground) it is not possible to determine the effect, if any, the sales of filters manufactured by others have had on the distinctiveness of the Mark as of the filing date of the statement of opposition.

[69] In view of the above I am not satisfied that the Opponent has produced sufficient evidence that trademarks for filters with the positioning of diamond shaped apertures similar to those of the Applicant had been used or made known by the Opponent or third parties, to such an extent and in such a manner that they had become known sufficiently to negate the distinctiveness of the Mark. This ground is therefore unsuccessful.

[70] I note, *in obiter*, that a trademark that is merely functional and utilitarian is not able to distinguish the goods or services in association with which it is used by its owner from the goods or service of others. In this case, and as shown above, the Opponent met its initial burden of showing that the Mark was intended to perform a utilitarian function under the section 12(2) ground of opposition.

[71] The Opponent did not, however, plead nor make this argument under this ground [see, for example, paras. 27- 29 of the *Massif Inc v Station Touristique Massif du Sud* (1993) Inc (2011), 95 CPR (4th) 249 (FC)]. Further, it is not apparent from the Applicant's written representations that the Applicant understood this ground to include an allegation that the Mark was not distinctive because it was intended to perform a utilitarian function.

Thus, it would not appear that the Applicant was aware of the case it had to meet under this ground .

[72] On the other hand, the Federal Court of Appeal has directed, in *Novopharm Ltd v Astrazeneca AB* (2002), 21 CPR (4th) 289, that pleadings must be considered in conjunction with the evidence when assessing the case that the Applicant has to meet. A review of the Opponent's statement of opposition as a whole, along with the Opponent's evidence, could suggest that the Opponent was also relying on this argument under its distinctiveness ground.

[73] If I were to consider this argument under this ground, I would have been satisfied that the Opponent had met its initial burden of putting into issue whether the Mark, being functional and utilitarian, was able to distinguish the goods or services in association with which it is used by its owner from the goods or service of others. The onus would have then shifted to the Applicant to show that its Mark did distinguish or was able to distinguish its Goods from those of others.

#### Would the Applicant Have Met its Onus?

[74] Had the Opponent met its initial evidential burden, the Applicant would have had to show that consumers had recognized the Mark as a trademark, not just as a filter with a functional element [*Novopharm Ltd v Astra AB*, 2000 CanLII 28645 (TMOB), 6 CPR (4th) 16 (FCTD)] , such that it had become distinctive of the Applicant in Canada as of the filing date of the statement of opposition.

[75] Having considered the evidence and arguments of record, I am not satisfied that the Applicant would have shown this, for the following reasons.

[76] First, while the Applicant produced extensive sales associated with Goods bearing the Mark, that by itself does not necessarily result in

distinctiveness. As noted in *Novapharm Limited v Astra AB, supra*, impressive sales figures alone do not satisfy the burden on the Applicant for a trademark of proving distinctiveness.

[77] Further, there is no direct evidence from consumers which would provide any assistance as to ascertaining how consumers perceive the Mark. In fact, as previously noted, there is no evidence that the Mark has been identified as a trademark to potential purchasers at all. The Applicant has therefore not established that a significant number of consumers would have related the Mark to a single source as opposed to comprising a functional and utilitarian filter.

[78] Accordingly, the distinctiveness ground of opposition would have also succeeded on this basis, had the Opponent's initial burden been met.

#### **REMAINING GROUNDS OF OPPOSITION**

[79] Having already refused the application under at least one ground of opposition, 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 application pursuant to section 38(12) of the Act.

Cindy R. Folz  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office



## Appearances and Agents of Record

No hearing held.

### **AGENTS OF RECORD**

**For the Opponent:** Riches, McKenzie & Herbert LLP

**For the Applicant:** Bennett Jones LLP

## **SCHEDULE A**

### ***Opponent's Grounds of Opposition***

(a) Section 38(2)(b) of the Trademarks Act that the Applicant's DESIGN Mark is not registrable having regard to Section 12(2), in that generally diamond-shaped apertures have a utilitarian function such that they are intended to maximize structural support and rigidity while also maximizing airflow.

(b) Section 38(2)(b) of the Act - that the Applicant's DESIGN Mark is not registrable having regard to Section 18.1 in that it is likely to limit the development of industry related to the Applicant's Goods; goods which have been sold by the Opponent prior to the relevant dates, as per Schedule B.

(c) Section 38(2)(b) of the Act - that the Applicant's DESIGN Mark is not registrable having regard to Section 18.1 in that it is likely to limit the development of industry related to the Applicant's Goods; goods which have been sold by third-party manufacturers prior to the relevant dates, as per Schedules B to I.

(d) The Applicant's DESIGN Mark is not distinctive within the meaning of Section 38(2)(d) of the Act in that the Applicant's DESIGN Mark does not, and is not adapted, to distinguish the Applicant's Goods from the others, including the goods of the Opponent, as listed in Schedule A.

(e) The Applicant's DESIGN Mark is not distinctive within the meaning of Section 38(2)(d) of the Act in that the Applicant's DESIGN Mark does not, and is not adapted, to distinguish the Applicant's Goods from the goods of others, including the goods sold by third-party manufacturers, as listed in Schedules B to I.

(f) The Applicant's DESIGN Mark is not registrable and was filed in bad faith in view of the provisions of Section 38(2)(a.1) of the Act in that the application prevents the Opponent from incorporating functional aspects of the Applicant's DESIGN Mark in the Opponent's goods, as listed in Schedule A.

(g) The Applicant's DESIGN Mark is not registrable and was filed in bad faith in view of the provisions of Section 38(2)(a.1) of the Act in that the application prevents third-party manufacturers from incorporating functional aspects of the Applicant's DESIGN Mark in the goods of third-party manufacturers, as listed in Schedules B to I.

(h) Pursuant to Section 38(2)(b) of the Act, the Applicant's DESIGN Mark is not registrable having regard to Section 18.1 and filed in bad faith in view of the Applicant improperly seeking to obtain a monopoly of trademark protection over a key utilitarian feature already widely used in the design of air filters, both generally and those falling within the categories of the Applicant's Goods to allow for strength and/or desired airflow, and improperly directed to a trade dress that provides functionality, and in particular, rigidity and structure to the Applicant's Goods and the design of structurally equivalent goods (as shown in Schedule A).

(i) Pursuant to Section 38(2)(b) of the Act, the Applicant's DESIGN Mark is not registrable having regard to Section 18.1 and filed in bad faith in view of the Applicant improperly seeking to obtain a monopoly of trademark protection over a key utilitarian feature widely used in the design of air filters, both generally and those falling within the categories of the Applicant's Goods to allow for strength and/or desired airflow, and improperly directed to a trade dress that provides functionality, and in particular, rigidity and structure to the Applicant's Goods and the design of

structurally equivalent goods (as shown in Schedule B to I).

(j) The Applicant's DESIGN Mark is not registrable in view of the provisions of Section 12(1)(b) of the Act in that the Applicant's DESIGN Mark is clearly descriptive of the character or quality of the Applicant's Goods in that it is merely a graphical depiction of the general appearance of the Applicant's Goods, which includes structural and design features that are intended to provide rigidity and support and/or desired air flow to the Applicant's Goods.

(k) The Applicant's DESIGN Mark is not registrable having regard to Section 30(2)(c) of the Act in that the Applicant's DESIGN Mark does not contain a representation or descriptions, or both, that permits the trademark to be clearly defined and which does not reflect the visual representation of the Applicant's DESIGN Mark as illustrated.

(l) The Applicant's DESIGN Mark is not registrable having regard to Section 30(2)(c) of the Act in that the Applicant's application does not contain a representation or description, or both, and is contrary to Rule 8 in that it does not include an illustration of the Applicant's DESIGN Mark which is clear, legible and capable of being reproduced, nor does it accurately reflect the described features nor illustrate the size, position and/or shape of the claimed generally diamond-shaped apertures in a manner capable of reproduction.

(m) The Applicant's DESIGN Mark is not registrable having regard to Section 30(2)(c) of the Act in that the Applicant's DESIGN Mark does not contain a representation or description, or both, and is contrary to Rule 30(c) in that it does not include a two-dimensional graphic or photographic representation of the DESIGN Mark.

(n) The Applicant's DESIGN Mark is not registrable having regard to Section 30(2)(c) of the Act in that the Applicant's DESIGN Mark is not clear, legible

or capable of being reproduced, and is contrary to Rule 30(g) in that the drawing included with the Applicant's Application does not depict shapes or symbols that are "generally diamond-shaped apertures in which a column of generally, diamond-shaped apertures is slightly offset from another column to either side", as described in the Applicant's description of its DESIGN Mark.

(o) Pursuant to Section 38(2)(e) of the Act, the Applicant's DESIGN Mark was not registrable as of the relevant dates in that the Applicant was not using and did not propose to use the Applicant's DESIGN Mark in Canada in association with the Applicant's Goods