



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

Citation: 2016 TMOB 139
Date of Decision: 2016-08-11

IN THE MATTER OF AN OPPOSITION

Metro Centre Ltd.

Opponent

and

GP Industries, LLC

Applicant

1,630,386 for ZIP ON, FLIP UP

Application

FILE RECORD

[1] On June 10, 2013, GP Industries, LLC filed an application to register the trade-mark ZIP ON, FLIP UP based on use of the mark in Canada, in association with the goods listed below, since at least as early as May 2013:

metal gutter downspout hinges, namely, two-piece hinges, hinges with a sandwich mechanism and hinges attached to a rain gutter downspout to allow the downspout to fold at the hinge

[2] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated April 23, 2014 and was opposed by Metro Centre Ltd. on August 22, 2014. The Registrar forwarded a copy of the statement of opposition to the applicant on August 28, 2014, as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[3] The opponent's evidence consists of a certified copy of its trade-mark registration for FLIP-UP HINGE & Design, shown below, for use in association with the goods listed below:



goods: downspout extensions for eavestroughs

[4] The applicant's evidence consists of the affidavits of Brian M. Beck and Angela Davies. Both parties submitted written arguments. Neither party requested an oral hearing.

STATEMENT OF OPPOSITION

[5] The grounds of opposition are stated concisely and are shown in full below:

(a) Having regard to Sections 38(2)(b) and 12(1)(d) of the *Act*, the Trade-mark [the applied-for mark ZIP ON, FLIP UP] is not registrable because it is confusing with the Opponent's trade-mark FLIP-UP HINGE & Design which is the subject of Registration No. TMA432,316 dated August 26, 1994, covering "downspout extensions for eavestroughs."

(b) Having regard to Sections 38(2)(c) and 16(1) of the *Act*, the Applicant is not the person entitled to registration in that as of the date of application[sic], the Trade-mark was confusing with Opponent's trade-mark FLIP-UP HINGE & Design which had been previously registered and used in Canada and continues to be used by the Opponent in association with covering[sic] "downspout extensions for eavestroughs."

(c) Having regard to Sections 38(2)(d) and 2 of the *Act*, the Trade-mark is not distinctive in Canada of the Applicant's wares/services[sic] in that the Trade-mark does not distinguish, nor was it adapted to distinguish the Applicant's wares/services[sic] from those of others, including those of the Opponent associated with the Opponent's trade-mark FLIP-UP HINGE & Design.

[6] The allegation of non-entitlement, pleaded in para. (b) above, also turns on the issue of confusion between the applied-for mark and the opponent's mark as pleaded in para. (a) above. The material times to assess the issue of confusion with respect to the allegations of non-registrability and non-entitlement are, respectively, (i) the date of decision in this proceeding and (ii) the date of first use of the applied-for mark, that is, May 31, 2013. The material date to assess

the issue of non-distinctiveness, pleaded under para. (c), above, is the date of opposition, that is, August 22, 2014: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 CPR(3d) 198 at 206 - 209 (FCTD).

[7] Before discussing the allegations in the statement of opposition, I will first review the applicant's evidence, the evidential onus on the opponent, the legal burden on the applicant, the meaning of confusion within the context of the *Trade-marks Act*, and the factors for assessing confusion under the framework of the *Trade-marks Act*.

APPLICANT'S EVIDENCE

Brian Beck

[8] Mr. Beck identifies himself as the CFO and VP of Sales for the applicant company. The applicant manufactures and sells a variety of gutter accessories including gutter downspout hinges. The hinge is attached to a rain gutter downspout to allow the downspout to fold upwards for convenience. The hinges are sold across Canada through various retailers including Home Hardware and Castle Building Centres. Sales of the applicant's hinges under the mark ZIP ON, FLIP UP have exceeded \$50,000 for the period May 2013 to June 2015. As shown in Exhibit A of Mr. Beck's affidavit, the applied-for mark is clearly featured on product packaging.

Angela Davies

[9] Ms. Davies identifies herself as an administrative assistant with the firm representing the applicant. Her evidence consists of (i) the first five pages of an Internet search for "downspout flip-up hinge," attached as Exhibit A to her affidavit, and (ii) a dictionary definition of the word "flip-up," attached as Exhibit B to her affidavit.

[10] I note from Exhibit A that hinged flip-up downspouts (that is, eavestrough extensions) appear to be popular consumer items. I note from Exhibit B that the term "flip-up" means (i) "having a movable part hinged so as to be capable of being flipped upward when necessary" when used as an adjective, and (ii) "a flip-up device" when used as a noun.

LEGAL BURDEN AND EVIDENTIAL ONUS

[11] The applicant bears the legal burden of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks Act* as challenged by the opponent in the statement of opposition. However, there is an initial evidential onus 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.

MEANING OF CONFUSION

[12] Trade-marks are confusing when there is a reasonable likelihood of confusion within the meaning of s.6(2) of the *Trade-marks Act*, shown below:

The use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the goods or services . . . associated with those trade-marks are manufactured . . . or performed by the same person, whether or not the goods or services . . . are of the same general class.

[13] Thus, s.6(2) does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by s.6(2) is whether potential customers for the applicant's downspout hinges, sold under the mark ZIP ON, FLIP UP, would believe that the hinges were made by the opponent or that the applicant was authorized or licensed by the opponent, whose related goods namely, downspout extensions, are sold under the mark FLIP-UP HINGE & Design. As indicated earlier, the legal burden is on the applicant to show, on the usual civil balance of probabilities standard, that there would be no reasonable likelihood of confusion.

TEST FOR CONFUSION

[14] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are "all the surrounding circumstances including" those specifically mentioned in s.6(5)(a) to s.6(5)(e) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the goods, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas

suggested by them. This list is not exhaustive and all relevant factors are to be considered. Further, all factors do not necessarily have equal weight as the weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 CPR(3d) 308 (FCTD). However, as noted by Mr. Justice Rothstein in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 CPR(4th) 361 (SCC), although the degree of resemblance is the last factor cited in s.6(5), it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

[15] It will be convenient to discuss the grounds of opposition in reverse order, beginning with the third ground, as follows.

THIRD GROUND OF OPPOSITION - NON-DISTINCTIVENESS

[16] In *Bojangles' International, LLC v Bojangles Café*, 2004 CanLII 71764 (CA TMOB) this Board considered where the bar must be set in order for the distinctiveness of one mark to negate the distinctiveness of another mark:

Spanada and *Motel 6*, above, are the leading cases to examine the extent to which a mark must be known if it is to negate the distinctiveness of another mark. The bar set by those cases is that the opponent's mark must be well known in at least one part of Canada or widely known.

[17] However, on appeal to the Federal Court, Trial Division (2006 FC 657 (CanLII) at para.34) Noel J. noted that the Board had applied an erroneous evidential standard and set the bar in the following terms:

A mark must be known to some extent at least to negate the established distinctiveness of another mark, and its reputation in Canada should be substantial, significant or sufficient.

[18] In the instant case the only evidence of record that the opponent's mark has been used in Canada is the indication in the opponent's registration that its mark was used since December 1, 1992. Such evidence, at best, permits me to conclude that at the material time August 22, 2014, the opponent's mark had a minimal reputation in Canada. It follows that the opponent has not met the evidential onus on it to support the allegation of non-distinctiveness of the applied-for mark. The third ground of opposition is therefore rejected.

SECOND GROUND OF OPPOSITION – NON-ENTITLEMENT

[19] As mentioned earlier, the allegation of non-entitlement turns on the issue of confusion between the applied-for mark ZIP ON, FLIP UP and the opponent's mark FLIP-UP HINGE & Design. To assess the issue of confusion I will next review the s.6(5) factors discussed in para. 14 above.

[20] The opponent's mark FLIP-UP HINGE & Design possesses a fairly low degree of inherent distinctiveness because the mark is highly suggestive of the character of the opponent's goods, that is, a downspout extension that flips upwards on a hinge. Similarly, the applied-for mark ZIP ON, FLIP UP possesses a fairly low degree of inherent distinctiveness because the mark is highly suggestive of the character of the applicant's goods, that is, a hinge that attaches easily and permits the attachment to flip upwards. At the material time May 31, 2013, the opponent's mark had acquired no more than a minimal reputation in Canada while the applied-for mark had not yet acquired any reputation in Canada. The first factor, which is a combination of inherent and acquired distinctiveness, at best marginally favours the opponent.

[21] The length of time that the parties' marks have been in use theoretically favours the opponent, however, in the absence of evidence of continued use of the opponent's mark since 1992, it is not a factor that has any meaningful significance. The second factor therefore favours neither party.

[22] The parties' goods are closely related and, in the absence of evidence to the contrary, I assume that the parties' channels of trade would be the same or overlap significantly. The third and fourth factors therefore favour the opponent.

[23] There is a fair degree of resemblance between the parties' marks in sounding and in ideas suggested owing to the term FLIP-UP comprising each mark. However, the overall visual impacts of the parties' marks are different owing to the serrated oval design feature comprising the opponent's mark. When all three aspects of resemblance are considered together, I find that the marks are somewhat more similar than different. Thus, the degree of resemblance favours the opponent, but only slightly.

Jurisprudence

[24] There are two principles of trade-mark law that, in the circumstances of the instant case, mitigate the advantage to the opponent under the last factor in s.6(5). The first principle is that comparatively small differences may suffice to distinguish between “weak” marks, that is, between marks of low inherent distinctiveness: see *GSW Ltd. v. Great West Steel Industries Ltd.* (1975), 22 CPR(2d) 154 (FCTD). Further, the opponent has not presented any meaningful evidence of use of its mark so as to entitle the opponent to a broadened scope of protection owing to acquired distinctiveness.

[25] The second principle has to do with whether there is a striking or unique aspect of the trade-marks in issue, as discussed in *Breville Pty Limited v Keuring Green Mountain, Inc.* 2014 TMOB 248 (CanLII). In that case, the owner of the marks YOUBREW and BREW IQ opposed the applied-for mark MYBREW for use in association with electric brewing machines. The Board noted as follows:

[27] In considering the degree of resemblance, the Supreme Court of Canada in *Masterpiece* [(2011), 2011 SCC 27 (CanLII); 92 CPR (4th) 361 (SCC)], *supra* sets out that resemblance is defined as the quality of being either like or similar (para 62) and that the approach to assessing resemblance should involve a consideration of whether there is an aspect of a trade-mark that is particularly striking or unique (para 64). In this case, there is nothing striking or unique about the word BREW given that the goods of each party relate to brewers and products to be used with them [see, for example, *Molson Companies Ltd v John Labatt Ltd* (1994), 58 CPR (3d) 527 (FCA)]. Similarly, the prefix component of the parties’ marks (a personal pronoun) is not particularly striking or unique given that consumers often use brewing machines to make beverages for themselves.

[28] The parties’ trade-marks therefore resemble each other to some extent in appearance and as sounded since they both share the suffix component BREW. While the parties’ trade-marks YOUBREW and MYBREW suggest the same idea, a brewer which allows for customizing of and individual’ s beverages, there can be no monopoly in this type of idea [*American Assn of Retired Persons v Canadian Assn. of Retired Persons/Assoc Canadienne des Individus Retraites* (1998), 84 CPR (3d) 198 at para 34 (FCTD)]. (emphasis added)

[26] Similarly, in the instant case, the prefix component (FLIP-UP) of the opponent’s mark and suffix component (FLIP UP) of the applicant’s mark are not particularly striking or unique given that the marks are used in association with downspouts, and there can be no monopoly for marks which suggest that downspouts can “flip up.”

Conclusion

[27] Considering the factors in s.6(5) as discussed above, and taking into account in particular that the opponent's mark is a weak mark and not entitled to a broad scope of protection, I find that the applicant has met the legal onus on it to show, on a balance of probabilities, that there was no reasonable likelihood of confusion between the applied-for mark and the opponent's mark as of May 31, 2013. The second ground of opposition is therefore rejected.

[28] I would also note that an opponent pleading s.16(1) and relying on use of its mark is required to show that it had not abandoned the mark it is relying on as of the date of advertisement of the applied-for mark: see s.16(5) and s.17(1) of the *Trade-marks Act*. In the instant case the opponent did not show that it had not abandoned its mark FLIP-UP HINGE & Design as of April 23, 2014. The second ground is rejected for that reason as well.

THIRD GROUND OF OPPOSITION - NON-REGISTRABILITY

[29] The allegation of non-registrability also turns on the issue of confusion between the applied-for mark ZIP ON, FLIP UP and the opponent's mark FLIP-UP HINGE & Design, but at the material date which is the date of my decision. The applicant's case is somewhat stronger at this later material date owing to some acquired distinctiveness through sales under the mark beginning in May 2013, thus making the first factor weigh slightly in the applicant's favour. Otherwise, the considerations for assessing confusion are the same as for non-entitlement, discussed above. It follows that the first ground of opposition is rejected.

DISPOSITION

[30] The opposition is rejected as each of the three grounds of opposition has been rejected. This decision has been made pursuant to a delegation of authority by the Registrar of Trade-

marks under s.63(3) of the *Trade-marks Act*.

Myer Herzig, Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office

APPEARANCES AND AGENTS OF RECORD

NO HEARING HELD

APPEARANCES

No One Appearing

FOR THE OPPONENT

No One Appearing

FOR THE APPLICANT

AGENTS OF RECORD

Ridout & Maybe LLP

FOR THE OPPONENT

Cassen Maclean

FOR THE APPLICANT