



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

Citation: 2016 TMOB 72
Date of Decision: 2016-05-04

IN THE MATTER OF OPPOSITIONS

**Construction Research & Technology
GmbH**

Opponent

and

SIMPSON STRONG-TIE COMPANY

Applicant

1,521,651 for SET-XP

Applications

1,521,658 for SET-HP

Introduction

[1] Construction Research & Technology GmbH (the Opponent) opposes registration of the trade-marks SET-HP and SET-XP (the Marks).

[2] The applications were filed by SIMPSON STRONG-TIE COMPANY (the Applicant) on March 30, 2011 on the basis of proposed use of the Marks in association with construction industry adhesives, namely, adhesives for mechanical anchors (the Goods) in Canada.

[3] In so far as application No. 1,521,658 for the trade-mark SET-HP is concerned, the Applicant claimed a priority date of January 27, 2011, based on an application filed on that date in the United States of America under No. 85/228,096 for the registration of the same or substantially the same trade-mark for use in association with the same kind of goods as those covered by the present applications.

[4] The Opponent filed a statement of opposition on October 21, 2014 under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) in each of these files. The grounds of opposition pleaded are based on sections: 30(b) and (i) (requirements), 12(1)(d) (registrability), 16(3)(a) (non-entitlement), and 2 (distinctiveness). Except for the grounds based on section 30 of the Act, they all turn on the issue of likelihood of confusion with the Opponent's trade-marks SET and SET 45.

[5] For the reasons explained below, I reject both oppositions.

The Record

[6] The applications were advertised in the Trade-marks Journal on May 21, 2014. The Opponent filed its statements of opposition on October 21, 2014. The Applicant filed and served a counter statement in each of these files on December 8, 2014 in which it denied each ground of opposition pleaded by the Opponent.

[7] The Opponent filed as evidence in both files a certified copy of registration TMA184,899 for the trade-mark SET.

[8] The Applicant chose not to file evidence.

[9] Only the Applicant filed a written argument and no hearing was requested.

Preliminary remarks

[10] The Applicant requested an interlocutory ruling on the sufficiency of certain paragraphs of the statements of opposition. The Registrar issued a decision on February 6, 2015, in both files, granting in part the interlocutory ruling which was clarified by letters dated March 11 and March 26 2015. The Registrar ordered the striking of the ground of opposition raised under section 30(i) of the Act in each file. Accordingly, I do not need to assess such ground of opposition.

[11] No matter what interpretation to be given to the Registrar's interlocutory ruling, the issue is now moot. The clarifications provided by the Registrar had to do with the section 16 (entitlement) and distinctiveness grounds of opposition. For the reasons detailed later and

unrelated to the clarifications sought by the Applicant, those grounds of opposition are dismissed.

[12] As mentioned before, the Opponent did not file a written argument and no hearing was held. Therefore it is difficult to assess the Opponent's position with respect to each of the grounds of opposition it raised. I will assess them on the basis of the evidence in the record which is simply a certified copy of registration TMA184,899 for the trade-mark SET.

[13] Finally, I shall refer to the trade-marks applied for (SET-HP and SET-XP) as the Marks.

The grounds of opposition summarily dismissed

[14] The legal onus is on the Applicant to show that its application does not contravene the provisions of the Act as alleged in the statements of opposition. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* 2002 FCA 291, 20 CPR (4th) 155; and *Wrangler Apparel Corp v The Timberland Company* 2005 FC 722, 41 CPR (4th) 223].

Section 30(b) ground of opposition

[15] The Opponent has an initial burden to file some evidence to support this ground of opposition. The initial burden of proof incumbent on the Opponent regarding this ground of opposition is less onerous than under other grounds of opposition given that the relevant facts to support such ground are more readily available to the Applicant [see *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. Finally, the Opponent may rely on the Applicant's evidence to meet its initial burden.

[16] There is no evidence in the record that could support this ground of opposition. Consequently it is dismissed for failure by the Opponent to meet its initial burden.

Ground of opposition based on section 16(3)(a) of the Act

[17] Under this ground of opposition, the Opponent had the initial burden to prove that its trade-marks SET and SET 45, alleged in support of this ground of opposition, were known in Canada prior to the filing date (priority date in application No. 1,521,658) of the applications.

[18] As the Opponent did not file any evidence of use of those marks, again this ground of opposition is dismissed for failure by the Opponent to meet its initial burden.

Ground of opposition based on lack of distinctiveness of the Marks (Section 2 of the Act)

[19] In *Bojangles' International, LLC v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427 the Federal Court determined that:

- A mark needs to be known in Canada to some extent at least to negate another mark's distinctiveness;
- Alternatively, a mark could negate another mark's distinctiveness if it is well known in a specific area of Canada.

[20] The Opponent had therefore the initial burden to prove that its marks SET and SET 45 relied upon under this ground of opposition were known in Canada to some extent or they were well known in a specific area of Canada. As there is no evidence of that nature in the record, I conclude that the Opponent has failed to meet its initial burden.

[21] Therefore, this ground of opposition is also dismissed.

Ground of opposition based on Section 12(1)(d) of the Act

[22] This ground of opposition must be assessed at the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 at 424 (FCA)].

[23] As mentioned before, the Opponent filed a certified copy of registration TMA184,899 for the trade-mark SET. I exercised the Registrar's discretion and checked the register. I confirm that this registration is extant. Therefore, the Opponent has met its initial burden.

[24] The registration covers: Building materials namely packaged concrete mixes; packaged mixtures of cement, sand, and aggregate; cement and sand; sand and mortar cement (the Opponent's Products).

[25] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between two trade-marks are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks or trade-names have been in use; the nature of the goods, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [see *Mattel Inc v 3894207 Canada Inc*, 2006 SCC 22 (CanLII), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 623(CanLII), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc et al*, 2011 SCC 27 (CanLII), 92 CPR (4th) 361 (SCC)].

[26] The test under section 6(2) of the Act 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 section 6(2) is whether a consumer, with an imperfect recollection of the Opponent's SET mark, who sees the Applicant's Goods in association with the Marks, would think they emanate from, or are sponsored by, or approved by the Opponent.

[27] As stated in *Masterpiece, supra*, in most instances the degree of resemblance is considered to be the most important factor. As such, I shall begin my analysis with this factor.

The degree of resemblance

[28] The parties' marks share the same first component namely, the word SET. The Marks have an additional element: XP and HP. There is therefore some visual resemblance.

[29] 'Set' is a common English word. It has been ruled that the first portion of a mark is somewhat more important for the purposes of distinction; however, when the first component is a common, descriptive or suggestive word, the significance of the first component decreases.

[see *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD)].

[30] In particular, in the context of the Opponent's trade-mark SET registered for use in association with the Opponent's Products, the term "set" can be defined as "harden or solidify" as in "the concrete has set" [*The Canadian Oxford Dictionary*]. Similarly, in the context of the Marks applied for use in association with the Goods, the term "set" can be defined as "join, attach, or fasten" [*The Canadian Oxford Dictionary*]. Thus, while there are similarities between the Opponent's mark SET and the first portion of the Marks, I do not consider the term "set" to be particularly striking or unique as it is at least suggestive of the character of the goods offered by the parties.

[31] In the absence of evidence on the meaning of the components '-XP' and '-HP', I am inclined to conclude that the Marks, in their totalities, are likely to be viewed as fanciful trade-marks when used in association with the Goods.

[32] Although there are some similarities between the parties' marks due to the descriptive term SET, I do not consider there to be a high degree of resemblance when the parties' marks are assessed in their entirety. In this regard, there are sufficient differences visually, phonetically and in ideas suggested in the latter portions of the Marks, which is arguably the relatively more unique portion of the Marks, to outweigh any similarities between the Opponent's mark and the first portion of the Marks, which merely suggests the character of the goods offered by the parties.

[33] Overall, when all three aspects of resemblance are considered together, I find that the parties' marks are more different than alike.

Inherent distinctiveness and the extent the trade-marks are known

[34] As discussed previously, the word 'set' is somewhat suggestive of the character of the parties' goods. Consequently, the Opponent's trade-mark SET is not highly distinctive. Accordingly, it would be entitled to a narrow ambit of protection.

[35] As for the Marks, the addition of '-XP' and '-HP' makes the Marks more distinctive than the Opponent's mark SET.

[36] There is no evidence of use of any of the parties' marks in the record. Consequently, I cannot measure the extent to which these marks are known in Canada.

[37] Overall, this factor favours the Applicant.

The length of time the marks have been in use

[38] There is no evidence of use of the parties' marks in the record. Even if I were to consider the fact that the registration of the Opponent's mark makes reference to its use since at least as early as April 1960, the mere existence of a registration can establish no more than *de minimis* use and cannot give rise to an inference of significant and continuous use of a trade-mark [see *Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB) at 430].

[39] Consequently, this factor favours no one.

The nature of the goods and their channels of trade

[40] I must compare the Opponent's Products with the Goods [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)].

[41] The Applicant pleads that the Marks relate to adhesives for mechanical anchors. There is no indication in the registration of the Opponent of any relationship between building materials such as concrete and mechanical anchors and adhesives for mechanical anchors. I may add that I have no evidence that would support a contention that such connexion exists.

[42] There is no evidence of a potential overlap in the parties' channels of trade.

[43] Consequently, these two factors favour the Applicant.

Conclusion

[44] From the evidence in the record, I conclude that a person with an imperfect recollection of the Opponent's trade-mark SET used in association with the Opponent's Products, who sees the Goods in association with the Marks, would not, on a balance of probabilities, think that the Goods originate from the Opponent or that there is a connexion between the Goods and the Opponent.

[45] I reach this conclusion based on the fact that the Opponent's trade-mark is an inherently weak trade-mark with no evidence of acquired distinctiveness that is entitled to a narrow ambit of protection; that the Marks have additional distinctive elements namely, '-XP' and '-HP'; and that the parties' products and their channels of trade do not overlap.

[46] For all these reasons, I dismiss this ground of opposition.

Disposition

[47] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject both oppositions pursuant to section 38(8) of the Act.

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

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No hearing

Agents of Record

Gowling Lafleur Henderson LLP

FOR THE OPPONENT

Riches, McKenzie & Herbert LLP

FOR THE APPLICANT