



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

Citation: 2012 TMOB 207
Date of Decision: 2012-11-15

**IN THE MATTER OF AN OPPOSITION
by Certiwood Technical Centre to
application No. 1,350,284 for the trade-
mark CERTI-WOOD in the name of
Cedar Shake & Shingle Bureau**

[1] On June 5, 2007 Cedar Shake & Shingle Bureau (the Applicant) filed an application to register the trade-mark CERTI-WOOD (the Mark), based on proposed use in respect of the following wares and services:

Wares: Printed publications, namely booklets, brochures, manuals, pamphlets, directories, guides, flyers and information sheets in the fields of shakes, shingles, roofing, siding, related services and insurance; and wood shingles and shakes

Services: Roofing services; roofing and siding installation, maintenance and repair services; roofing consultation; roofing contracting; roofing repair; educational services, namely training and seminars in the fields of shakes, shingles, roofing, siding, related services and insurance; association services, namely promoting the interests of wood shake and shingle producers, installation contractors, roof maintenance technicians, wholesalers, distributors and brokers; providing a website for use by members, consumers and others in the fields of shakes, shingles, roofing, siding, related services and insurance; coordinating quality assurance and warranty programs relating to shakes, shingles, roofing, siding, and related services; and providing information in the fields of shakes, shingles, roofing, siding, related services and insurance.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of June 18, 2008. A statement of opposition was filed by Certiwood Technical Centre (the Opponent) on January 27, 2009. The Applicant filed a counterstatement on July 29, 2009.

[3] The Opponent filed the affidavit of James F. Shaw sworn on November 25, 2009 with Exhibits A to T. The Applicant filed the affidavit of Lynne Christensen sworn on July 23, 2010 with Exhibits A to N, and the affidavit of Lisa Martz sworn on July 26, 2010. The cross-examination of Lynne Christensen took place on November 26, 2010. The transcript of the cross-examination and the materials provided by the Applicant as undertakings were filed on December 9, 2010. On November 30, 2010 the Opponent was granted leave to file an additional affidavit of James F. Shaw sworn on October 26, 2011 with Exhibit A.

[4] Both parties filed written arguments and were represented at an oral hearing.

Grounds of Opposition pursuant to the Trade-marks Act, R.S.C. 1985, c. T-13 (the Act)

[5] The grounds of opposition are summarized below:

- (a) Section 38(2)(a) - the opposed trade-mark application does not conform to the requirements of section 30(i) of the Act; the Applicant could not have been satisfied that it was entitled to use the Mark having regard to the allegations with respect to the grounds of entitlement (below),
- (b) Section 38(2)(b) and section 12(1)(b) - the Mark is not registrable as it is clearly descriptive of the character or quality of the wares and services with which it is intended to be used, since it clearly suggests features or traits of the wares and services in association with the Mark.
- (c) Section 38(2)(c) - the Applicant is not the person entitled to registration of the trade-mark in view of section 16(3)(a) and (c) because at the date of filing of the application the Mark was confusing with the Opponent's trade-mark CERTIWOOD and its trade-name CERTIWOOD TECHNICAL CENTRE, both of which had been previously used in Canada by the Opponent; and

- (d) Section 38(2)(d) - the trade-mark is not distinctive of the wares and services of the Applicant since the Mark does not actually distinguish the wares and services from the wares and services of others including those of the Opponent.

Onus and Evidential Burden

[6] The legal burden lies on the Applicant in an opposition proceeding; the Applicant must establish on a balance of probabilities that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent, which means that in order for a ground to be considered at all, there must be sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[7] The material dates that apply to the grounds of opposition in each case are as follows :

- Section 30 – the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- Section 12(1)(b) – the filing date of the application [see *Shell Canada Limited v. P.T. Sari Incofood Corporation* (2005), 41 C.P.R. (4th) 250 (F.C.T.D.); *Fiesta Barbeques Limited v. General Housewares Corporation* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)].
- Section 12(1)(d) – the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade-marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- Section 16(3) – the filing date of the application [see s. 16(3)];
- Non-distinctiveness – the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Grounds that may be summarily dismissed

[8] Section 30(i) of the Act requires that an applicant declare itself satisfied that it is entitled to use the applied-for mark. The jurisprudence suggests that non-compliance with section 30(i) can be found only where there are exceptional circumstances that render the applicant's statement untrue such as bad faith or non-compliance with a federal statute,. Mere knowledge of the existence of the Opponent's trade-mark does not in and of itself support an allegation that the Applicant could not have been satisfied of its entitlement to use the Mark [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 CPR (2d) 152 (TMOB) at 155; *Cerverceria Modelo, S.A. de C.V. v. Marcon* (2008), 70 CPR (4th) 355 (TMOB) at 369; *Interactiv Design Pty Ltd. v. Grafton-Fraser Inc.* (1998), 87 CPR (3d) 537 (TMOB) at 542-543]. Since no facts to support an allegation of exceptional circumstances have been provided, the Opponent has not met its evidential burden and this ground is summarily dismissed.

[9] Section 12(1)(b) of the Act prevents the registration of clearly descriptive or deceptively misdescriptive trade-marks. The Opponent alleged that the Mark offended section 12(1)(b); however in its allegation the Opponent reiterated the wording of the section without pleading any specific facts with regard to the Mark in question. As well, the Opponent did not advance any evidence or argument related to this ground. Accordingly I am of the view that not only did the ground fail to allege sufficient facts, but that, in any event, the Opponent has not met its evidential burden and this ground is summarily dismissed.

Opponent's Evidence

[10] The key elements of the Opponent's evidence relating to use of its trade-mark (pursuant to section 4 of the Act) and trade-name (as defined in the Act: *a name under which any business is carried on, whether or not it is the name of a corporation, a partnership or an individual*) are summarized below.

[11] The affidavit of James F. Shaw, President of the Opponent, explains that the Opponent is accredited, among others, by the International Accreditation Service Inc. (IAS) as an independent third-party certification body for many different wood based products; the Opponent is in the business of providing certification, testing, and quality auditing services to engineered

wood and wood product manufacturers. Manufacturers of plywood and other engineered wood products make these products for application in the construction of residential and commercial buildings, and which can be used on roofing, walls and well as other structural applications.

[12] Mr. Shaw states that the Opponent has used the CERTIWOOD mark and the trade-name CERTIWOOD TECHNICAL CENTRE in Canada in association with its services since May 2006.

[13] The affiant provides an example of a grade mark stamp (Exhibit H), which he states is licensed to members of the Opponent and used on engineered wood products manufactured by them. I note that the stamp displays the words CERTIWOOD TECHNICAL CENTRE together and in the same size and font.

[14] Mr. Shaw goes on to state that the Opponent has spent \$92,673 in 2006, \$32,252 in 2007, \$17,189 in 2008 and \$27,214 in 2009 in promotion and advertising of its trade-mark and trade-name.

[15] With respect to the manner of use of the trade-mark and trade-name in advertising of the Opponent's services, the affiant provides a May 31, 2006 letter from the Opponent to current and potential member companies in Canada, as well as forest product associations and research organizations, introducing the Opponent and its services and encouraging the recipients to select the Opponent as their first choice for engineered wood product testing and certification. The letter includes a DVD entitled the Certainty of Certification and a brochure entitled "Quality Auditing, Testing & Certification of Engineered Wood Products" (the Quality Brochure). Exhibit I collectively includes an example of the letter, the Quality Brochure and the DVD cover. All of these display CERTIWOOD TECHNICAL CENTRE with CERTIWOOD standing out in larger font and used with a check-mark design as shown below:



[16] In August 2007 the Opponent conducted a mail-out to product associations, home builder associations and research organizations, enclosing the aforementioned Quality Brochure marked as above.

[17] On December 19, 2007 the Opponent issued a letter to current and potential member companies, enclosing the brochure entitled “Certainty Through Certification”, which prominently displayed the Opponent’s trade-mark as shown above.

[18] In much of the material forwarded to potential customers and in the Quality Brochure, the mark shown above also appears directly above the corporate contact information for the Opponent, and accordingly I consider that some trade-name use has also been established.

[19] The Opponent attended various trade-shows, such as the Wood Solutions Fair wherein the Opponent alleges it had a booth prominently displaying its trade-mark and its trade-name, and distributed promotional items such as wooden coffee coasters bearing the Opponent’s trade-mark. An example of the coffee coaster is attached as Exhibit Q; it is marked with CERTIWOOD TECHNICAL CENTRE and design features as shown above.

[20] The Opponent has had a website available to its members and the public as early as May 2006, *www.certewood.com*.

[21] The affiant states that the Opponent has been a member of the Canadian Home Builders Association (CHBA) since September of 2006 and that it makes annual contributions to CHBA’s annual general meetings, which meetings attract 500 to 600 Canadian builders. The Opponent’s trade-mark and trade-name have been prominently displayed at these annual general meetings from 2007 to 2009.

[22] In order to demonstrate use in association with services, the Opponent must show that the trade-mark was used or displayed in the performance or advertising of those services. I agree with the Applicant that the evidence is not strong with respect to actual use of the Opponent’s trade-mark and trade-name on the services described by the Opponent; however, I am satisfied that there was some use in promotional literature to customers and potential customers at the respective material dates.

[23] The second affidavit of Mr. Shaw is directed towards establishing that the Opponent has a licensing agreement (dated April 12, 2007) with Synergy Pacific Engineered Timber Ltd. (Synergy). A review of the License Agreement indicates that the subject of the agreement is the Opponent's "Marking Devices". Schedule A to the Agreement displays two certification marks, one that can best be described as a large C encircling a fanciful TC design, and the other a label design, containing a number of trade-marks, including the aforementioned certification mark, a Synergy Pacific trade-mark and design, various numbers, two trade-marks that appear to related to the actual products for which the label is to be applied, namely posts, as well as CERTIWOOD TECHNICAL CENTRE (words only without the design features). Schedule B is product specification for the engineered wood posts.

Applicant's Evidence

[24] The affidavit of Lynne Christensen, Director of Operations of the Applicant, Cedar Shake & Shingle Bureau, provides evidence regarding the historical background of the Applicant. The Applicant's predecessor was founded in 1915 as the Red Cedar Shingle Bureau and was originally located in the State of Washington, in the USA. Subsequently, it merged with the Handsplit Shake Bureau and in 1988 the current name Cedar Shake & Shingle Bureau was adopted. The affiant provides that the Applicant's headquarters were moved to Mission, British Columbia; the date of this move is not provided.

[25] Ms. Christensen states that the Applicant is the principal business that represents both U.S. and Canadian producers of cedar shakes and shingles. The promotional literature provided indicates that the Applicant is a non-profit trade association that promotes the use of cedar for roofing and sidewall applications. The organization represents member manufacturers, distributors, wholesalers, brokers, retailers, approved installers, roof maintenance technicians and other industry associates. I note that the promotional material provided indicates that there is an office in Canada and that the member listing indicates members located in Canada.

[26] The affiant provides information about its marketing program, which uses various trade-marks bearing the CERTI prefix (the CERTI Label Program). These CERTI prefixed marks are used and licensed by the Applicant to numerous members. The CERTI Label program involves the labelling of cedar shake and shingle products produced by the Applicant's members, that

meet the quality control criteria; these labels all bear trade-marks with a CERTI prefix. I note that the evidence does not show that use of the applied for Mark had commenced at that time.

[27] The Applicant maintains control over the quality of the wares and services through inspections and other approvals. Unannounced inspections of the members' products are performed to ensure compliance with the Applicant's standards and the CERTI marks are only used on products that meet the quality assurance criteria. The Applicant is the only association that can print the CERTI labels and members are not allowed to print or reproduce them in any way. CERTI labels are withheld or removed from the premises if a member fails to meet the quality standards. Ms. Christensen also points out that members are not allowed to hold excessive inventories of CERTI labels.

[28] Exhibit C consists of copies of brochures describing the products available under the CERTI marks and offered by the Applicant's members. I note that the CERTI marks appear in conjunction with descriptions of the respective products in various places in the brochure. An original information kit for buyers was produced by the Applicant following the cross-examination of Ms. Christensen and I note that all the CERTI marks are displayed in the brochure along with an explanation of the CERTI Label program and specific product (by label) certification information.

[29] Ms. Christensen attaches as Exhibit D, particulars of the Canadian CERTI label trade-marks of the Applicant, which include CERTIGRADE (used in Canada since 1935), CERTIGROOVE (used in Canada since 1954), CERTI-SPLIT (used in Canada since 1955), CERTI-GUARD (used in Canada since 1988), CERTI-SAWN (used in Canada since 1988), CERTI-LAST (used in Canada since 1990), CERTI-RIDGE (used in Canada since 1992), CERTI-CUT (used in Canada since 2004) and CERTI-LABEL (used in Canada since 1999) (the CERTI marks). All of these are registered in Canada with the exception of CERTI-LABEL.

[30] Each CERTI label is used in association with products with specific characteristics. For example, CERTI-GUARD is used with products that have been impregnated with a fire-retardant, whereas CERTI-LAST is used with products that have been pressure impregnated with preservative treatment. CERTI-SPLIT is used with a handsplit and resawn shake; CERTI-SAWN

is used with a tapersawn shake that is sawn on both sides, etc. Specification sheets for each of the products used with the respective CERTI marks are attached as Exhibit F.

[31] Ms. Christensen provides that the CERTI Label program has been in operation since 1936; however, no information is given as to whether this includes use in Canada at that time.

[32] The Applicant has manufacturer members (who either produce the shakes and shingles, or treat them subsequently) and affiliated members (such as distributors, brokers, wholesalers retailers). Affiliated members distribute the certified products; associated members are businesses such as roofing hardware suppliers, independent building inspectors, engineers and architects, and the like. As of June 18, 2010, the Applicant had 81 manufacturer members and 176 affiliate members. Attached as Exhibit B is the Applicant's 2008 Buyers Guide listing the names of its members and the types of products available under the CERTI Label program. I note that the majority of manufacturers listed in the Buyer's Guide are Canadian. The Guide also includes a listing of the wares by CERTI label, as well as a list of Canadian installers.

[33] According to Ms. Christensen, by 2004, Canadian manufacturers accounted for 90% of the industry's total production in North American. In 2004, the Applicant's members produced 76.1% of the cedar shakes and shingles produced in all of Canada and the United States. As of 2004, members of the Applicant owned 62.9% of all shakes and shingles machines in the industry in North America. In 2005, the Applicant's members produced 1.17 million squares of shakes and shingles, almost all of which bore one or more of the Applicant's CERTI marks. It appears that, annually, in excess of 3 million labels bearing the CERTI marks were printed and delivered to the licensees for use on the certified products. The annual value of the products exported to the United States for the years 2003 to 2009 is, for most years, in excess of \$200 million dollars.

[34] With respect to the CERTI Label program, Ms. Christensen states that each of the CERTI marks is used on the products; sample labels bearing these trade-marks, as well as a photograph of packaging bearing the CERTIGROOVE mark, are attached as Exhibit E. Most of the CERTI marks are on the packaging of the products either on labels tucked under the bundle straps or stapled to the products; the CERTIGROOVE mark is printed on the box containing the products.

[35] Copies of representative advertising used by the Applicant between 1937 and 2010 are provided (Exhibit G). The advertising displays the CERTI-SPLIT, CERTIGRADE AND CERTI-SAWN trade-marks as well as CERTI-LABEL. I note that the Applicant also contributes articles to magazines (samples from between 1988 and 2008 are included in Exhibit H). Samples of brochures and publications from between 1936 and 2009 are included in Exhibit I.

[36] The affiant also provides that the CERTI marks are used in association with membership materials, such as newsletters and annual reports and the like; samples from between 1935 and 2009 are included in Exhibit J. The Applicant also attends trade-shows and details are provided from trade-shows attended in 1999 and from 2007 and 2009 (Exhibit K).

[37] Ms. Christensen attaches a copy of the Opponent's press release dated March 30, 2006 announcing the formation by the Canadian Plywood Association (CANPLY) of a new organization to service Canada's engineered wood products sector, to be known as CertiWood Technical Centre. A copy of the cease and desist letter sent on behalf of the Applicant to the Opponent on April 18, 2006 is attached as Exhibit M; I note that it lists the 8 Canadian CERTI marks as well as the corresponding U.S. registrations. Exhibit N sets out the particulars of the Applicant's U.S. trade-mark registration for the subject Mark - CERTI-WOOD, filed on June 5, 2007 and registered on April 14, 2009.

Ground of Opposition - Section 16(3)(a) and (c)

[38] Sections 16(3)(a) and (c) of the Act provide that any applicant who has filed an application for registration of a proposed trade-mark that is registrable, is entitled to secure its registration, unless at the date of filing of the application the proposed trade-mark was confusing with (a) a trade-mark that had been previously used in Canada or made known in Canada by another other person; or (c) a trade-name that had been previously used in Canada by any other person.

[39] I am of the view that the Opponent has met its burden with respect to section 16(3), as the evidence demonstrates that on the date of filing the application, namely June 5, 2007, the trade-mark CERTIWOOD TECHNICAL CENTRE (with check mark design) as shown above had been in use for just over 1 year (i.e. use in the mail out to the industry May 31, 2006), and does

not appear to have been abandoned at the date of advertisement of the Mark (June 18, 2008). I note that in some, but not all cases, the evidence demonstrates that the designation TM appeared at the right of the mark at the end of the word CERTIWOOD just above the letter “d”. In view of all of the foregoing, I consider that use of the CERTIWOOD TECHNICAL CENTRE (with check mark design) is use of both the trade-mark CERTIWOOD as well as the trade name CERTIWOOD TECHNICAL CENTRE. Accordingly, I consider that the Opponent has met its burden with respect to the trade-mark as well as the trade-name.

Confusion – Section 6(5) of the Act

[40] In order to determine whether there was a likelihood of confusion between the Opponent’s trade-mark or trade-name and the Mark as of the date of filing of the application, the criteria in section 6(5) of the Act must be considered.

[41] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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 wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[42] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 CPR (4th) 361 (SCC).]

[43] In the present case there is an additional surrounding circumstance, namely the long standing existence of the CERTI Label program, which must be considered. Consideration will be given to this issue following the analysis of the issues set out in section 6(5).

Section 6(5)(e) – the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[44] In most instances, the dominant factor in determining the issue of confusion is the degree of resemblance between the trade-marks in their appearance or sound or in the ideas suggested by them, and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145, conf. 60 C.P.R. (2d) 70 (F.C.T.D.)]. Recently, in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.), the Supreme Court of Canada considered the importance of the s. 6(5)(e) factor in conducting an analysis of the likelihood of confusion (see para 49):

...the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis ... if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar... As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start.

[45] In considering the resemblance between the trade-marks at issue, taking into consideration that the words “technical centre” are used to suggest the location or provider of the services, and taking into consideration that, as used, CERTIWOOD stands out from the mark as a whole, as noted above, I am satisfied, as stated previously, that there has been use of CERTIWOOD as a trade-mark. Accordingly, when considering the resemblance between trade-marks, pursuant to the ground of non-entitlement alleged under section 16(3)(a), the analysis under section 6(5) should consider the likelihood of confusion between CERTIWOOD and the subject Mark CERTI-WOOD (which includes a hyphen).

[46] The marks at issue are highly similar in appearance, differing only by a hyphen. They are identical when sounded, and with respect to the idea suggested, I am of the view that they both generate the same notion in association with their respective services, namely, certification services related to wood products. The Mark is also somewhat suggestive of the wares applied for, in that it conveys the idea of wood products that have been certified. In view of the foregoing, this factor favours the Opponent.

Section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known

[47] The trade-marks at issue are coined words, and as such both have some inherent distinctiveness. In addition, trade-marks can acquire distinctiveness through use or promotion. The subject application is based on proposed use and the notion of acquired distinctiveness of the Mark through use is not relevant here for this ground of opposition. Acquired distinctiveness of the Applicant's other related marks (the CERTI marks) will be discussed below.

[48] The Opponent's trade-mark was used in promotional material just over a year before the filing date of the instant application; however, no evidence of the actual provision of the services has been provided. Accordingly, I am only willing to infer that the Opponent's trade-mark had acquired a small amount of distinctiveness.

Section 6(5)(b)- The length of time each has been in use

[49] The instant application is based on proposed use; at the material date the Opponent's trade-mark had been in use for just over one year. Accordingly, this factor favours the Opponent.

Section 6(5)(c) and (d) - The nature of the wares, services or business; the nature of the trade

[50] The Applicant provides certification services related to cedar shakes and shingles, and the Opponent promotes services directed to wood products and engineered wood products (i.e. that do not appear to include products of solid wood). Although the services are provided to different industries at the manufacturing and wood treatment level, the labelled certified products are directed to the ultimate buyer of the products in the home building/construction industry. Consequently I find that there is an overlap in the services and the nature of the trade. This factor therefore favours the Opponent.

Other surrounding circumstances

[51] Although it is clear from the analysis above, that there is a likelihood of confusion when taking into consideration the Mark *per se* and the Opponent's trade-mark, as mentioned at the outset, the Applicant has advanced an additional surrounding circumstance that leads me to a different determination.

[52] The Applicant argues that it has established the adoption and use of a family of CERTI trade-marks and that consequently the relevant consumer would be more likely to form the impression that the Mark, having the same prefix and being used for the same services, would be that of the Applicant and not the Opponent.

[53] Trade-marks that have a common component or characteristic and that are all in the name of one owner, give rise to the presumption that these form a family of marks used by the one owner (see *McDonald's Corp. v. Alberto-Culver Co.* (1995), 61 C.P.R. (3d) 382_(T.M.O.B.); *McDonald's Corp. v. Yogi Yogurt Ltd.* (1982), 66 C.P.R. (2d) 101_(F.C.T.D.)). As pointed out by Cattanach J. in *McDonald's Corp. v. Yogi Yogurt Ltd.* (1982), 66 C.P.R. (2d) 101_(F.C.T.D.) at p. 114, the presumption of the existence of a family or series of trade-marks can only arise in opposition proceedings if the person seeking to establish the existence of such a series can show that it has used the trade-marks comprising the series to a sufficient extent as to constitute a family of marks.

[54] The Applicant has provided evidence of use in Canada of a family of CERTI marks that constitutes its CERTI Label Program as set out above. A detailed explanation of the CERTI Label program has been provided; sales figures for products for which the service has been provided have been provided for the years – 2003 to 2009; promotional material displaying the marks has been provided dating back to 1937. The evidence strongly demonstrates that the CERTI marks are used together in the promotional literature offering the services related to the marks, and that these trade-marks appear, individually referenced with their respective product descriptions in the promotional literature sent to prospective buyers, members, etc., in Canada.

[55] While it is true that the Applicant's figures regarding sales of products and marked with the CERTI marks are not broken down by specific trade-marks as the jurisprudence suggests, the fact is that the family of marks relates to the differing but specific services provided in relation to those wares. The Applicant has placed millions of labels bearing one or more of its CERTI marks, into the shake and shingle marketplace, and after careful consideration, I am satisfied, given the unique nature of the comprehensive labelling services the Applicant provides, that a family of marks has been established and furthermore that it has acquired some reputation in

relation to the certification services and the shakes and shingles themselves [*Vantage Computer Systems Inc. v. Sterling Software Inc.* (1997), 84 C.P.R. (3d) 366].

[56] Taking into consideration section 19 of the Act, it is true that the existence of such a family of marks does not *per se* justify my concluding that the Applicant's Mark should be permitted to proceed to registration (see *Société des Produits Nestlé S.A. v. U L Canada Inc.* (2000), 9 C.P.R. (4th) 119 (T.M.H.O.) at pp. 124-125). However, the existence of the family of marks sheds a different light on the analysis of the likelihood of confusion. That is to say, I am of the view that, given the reputation of the CERTI Label program, the relevant consumer would be more likely to assume that the Mark would belong to the Applicant rather than the Opponent [*Vantage*]. Further, since these consumers would be aware of the CERTI marks in association with cedar shakes and shingles and their certification, the effect of the overlap in the nature of the trade on the likelihood of confusion (between the subject Mark and the Opponent's mark and trade-name) is minimized.

Conclusion

[57] In view of the all of the foregoing, I find that, on balance, taking into consideration the CERTI family of trade-marks, the Opponent cannot be successful under this ground of opposition. I consider it self evident that this reasoning also applies to the ground of opposition under section 16(3)(c); this is more particularly the case since the differences are greater between the Mark and the Opponent's trade-name. The section 16 grounds of opposition are dismissed.

Non-Distinctiveness

[58] The Opponent has an initial burden to prove the allegations of fact supporting its ground of distinctiveness. The Opponent needs to have shown that as of the filing of the opposition, its trade-mark(s) had become known sufficiently to negate the distinctiveness of the applied-for Mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.), *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R.(2d) 126 (F.C.A.); *Bojangles International, LLC v Bojangles Café Ltd* (2006), 48 C.P.R. (4th) 427)]. Taking into consideration the findings and reasoning set out above, I am not satisfied that the Opponent has met its initial burden in this regard. In any event, it is self-evident that in this case, the differences in the material dates would

have no significant effect on a determination of confusion under the ground of non-distinctiveness. This ground of opposition is therefore dismissed.

Disposition

[59] In view of all of the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

P. Heidi Sprung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office