

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

Citation: 2015 TMOB 149
Date of Decision: 2015-08-31

Canadian Tire Corporation, Limited

Opponent

and

Western Steel and Tube Ltd.

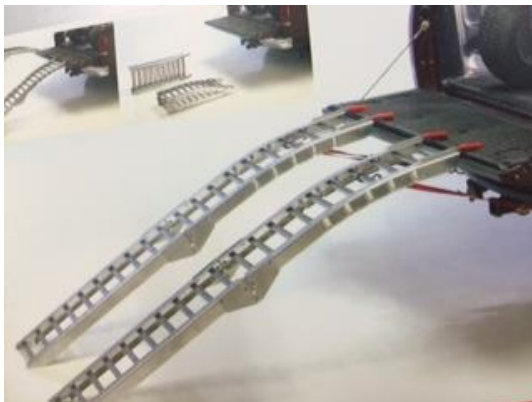
Applicant

1,452,547 for Ramp & DESIGN

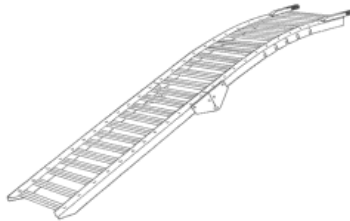
Application

Introduction

[1] Western Steel and Tube Ltd. (“Western Steel” or the Applicant) is a supplier of loading and utility ramps and has been described as a pioneer behind the ramp business in Canada. Since 2001, Western Steel has sold the arched 7 and 8 foot ramps shown below which are used to load equipment into pickup trucks:



[2] In 2009, Western Steel applied for a distinguishing guise covering the design of the arched ramp set out below (the Distinguishing Guise) for use in association with ladders, loading ramps and utility ramps (the Goods) based on its use of the Distinguishing Guise since January 2004. The description of the Distinguishing Guise is set out below the drawing.



The mark is a distinguishing guise and is shown in the attached drawing. In particular, the designs consists of a shaping of wares, namely a loading ramp, to include an arched shape having smooth dome fasteners along the upper surface of the wares to create a riveted beam appearance, a series of crimps arranged along the lateral surface of the rails of the loading ramp and brightly coloured ramp support tipped fingers at one end of the loading ramp.

[3] Section 2 of the *Trade-marks Act*, RSC, 1985, c T-13 (the Act), defines a distinguishing guise, in part, as the shaping of goods the appearance of which is used to distinguish the goods from those manufactured, sold or leased by others. In order for a distinguishing guise to be registrable, it must have been used so as to become distinctive as of the filing date of the application (section 13(1) of the Act). There is an onus on an applicant to establish that a distinguishing guise has become distinctive and that onus is particularly severe where the guise is inherently weak such as where it has significant ornamental or utilitarian function.

[4] Further, while a distinguishing guise may possess a functional element or elements, it cannot be registered if it is primarily functional. A distinguishing guise which goes beyond distinguishing the goods of its owner to the functional structure of the goods themselves transgresses the legitimate boundary of a trade-mark [*Remington Rand Corp v Phillips Electronics NV* (1995), 64 CPR (3d) 467 at 478 (FCA)]. If the guise's functionality is

secondary or peripheral to the role it plays in distinguishing the owner's goods from those of others, then there is no bar to registration [*Remington Rand, supra* at 475].

[5] Canadian Tire Corporation, Limited has opposed this application on a number of different grounds including that (i) the Distinguishing Guise is not distinctive because it does not serve to identify the source of the Goods and (ii) that it is not registrable since it is functional.

[6] For the reasons that follow, I find in favour of the Opponent with respect to these two grounds of opposition. The application is refused on the basis that the evidence does not support the conclusion that consumers understand that the Distinguishing Guise is a trade-mark and indicates a single source of the Goods. The application is also refused on the basis that the Distinguishing Guise is primarily functional in nature. Having refused the application on the basis of two of the grounds of opposition, it is unnecessary for me to consider the remaining grounds of opposition.

File History

[7] On September 11, 2009, Western Steel applied to register the Distinguishing Guise for use in association with the Goods based on its use of the Distinguishing Guise since January 2004.

[8] On March 30, 2010, an office action issued requiring the Applicant, pursuant to section 13 of the Act, to file evidence showing that the Distinguishing Guise had been so used in Canada as to have become distinctive at the application filing date. In response to the office action, the Applicant filed the affidavit of Duane Lucht dated March 30, 2011. The application was approved and advertised on September 14, 2011.

[9] Canadian Tire Corporation, Limited (the Opponent) filed a statement of opposition to the application on February 10, 2012 based on sections 38(2)(a), 38(2)(b), 38(2)(c) and 38(2)(d) of the Act. The grounds of opposition are summarized at Schedule A to this decision.

[10] The Applicant filed and served a counter statement in which it denied all of the grounds of opposition.

Opponent's Evidence

[11] As its evidence, the Opponent filed affidavits from the following individuals:

Andrew Davies

[12] Mr. Davies is Vice-President, Automotive Merchandising at Canadian Tire (Davies affidavit, para 1). From 2004-2009, Canadian Tire purchased arched loading ramps in a boxed kit which could then be assembled by consumers from the Applicant (Davies affidavit, para 14). After 2009, it began purchasing a ramp with the same design from other suppliers (Davies affidavit, paras 10, 13-15).

Caitlin Russell

[13] Ms. Russell is a student-at-law employed by the Opponent's agent (Russell affidavit, para 1). She purchased a two piece seven foot arched ramp manufactured by the Applicant featuring the Distinguishing Guise and delivered it to Mr. Fabbroni (Russell affidavit, paras 2,6; Exhibit 2). She also attaches print-outs from various websites (Exhibits 3-16).

Mark Fabbroni

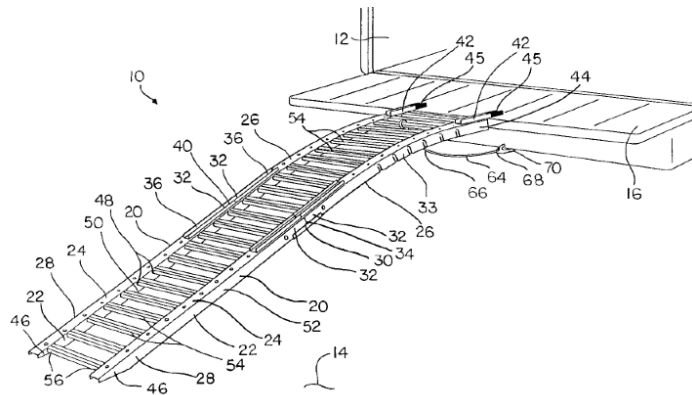
[14] Mr. Fabbroni is a licensed professional engineer and is an associate at Giffin Koerth Inc., a forensic engineering firm (Fabbroni affidavit, paras 1-2). Mr. Fabbroni assembled a sample of the Applicant's loading ramp bearing the Distinguishing Guise (Fabbroni affidavit, Exhibit 2). Upon examination of the loading ramp, Mr. Fabbroni commented that each of the features of the Distinguishing Guise were functional (Fabbroni affidavit, Exhibit 2, pg 7).

Alexanda Scot

[15] Ms. Scot is a trade-mark agent and certified translator employed by the Opponent's agent. She attaches documents from the prosecution file of the application including the affidavit of Duane Lucht sworn March 30, 2011 (the Lucht Examination affidavit) filed in response to the official action.

Carly Cohen

[16] Ms. Cohen is a student-at-law with the Opponent's agent who visited the United States Patent and Trademarks Office and Canadian Intellectual Property Office's websites to confirm that each of the 73 patent references appearing in her affidavit were in fact true copies of the corresponding patent applications/registrations appearing on the websites (Cohen affidavit, paras 4-5). While I have reviewed all of the patents, I find US Patent 6,139,249 listing Duane W. Lucht as an inventor to be particularly relevant since it depicts a loading ramp which has some of the same features as the Distinguishing Guise and describes the functionality of these features (Cohen affidavit, Exhibit 27). The drawing from the first page of the patent appears below.



Like the Distinguishing Guise, this patent describes a ramp which includes a pair of parallel rails being connected by bars which define the ramp surface and rubber coated fingers which grip the truck gate. Also like the Distinguishing Guise, the patent describes that the ramp can be shipped as a kit of small parts and assembled by consumers using conventional tools.

[17] Mr. Davies, Ms. Russell and Mr. Fabbroni were cross-examined and the transcripts and answers to undertakings were filed.

Applicant's Evidence

[18] As its evidence, the Applicant filed the affidavits of the following individuals:

Duane Lucht

[19] Mr. Lucht, the Applicant's President and CEO filed an affidavit on February 13, 2013 providing a history of the Applicant, discussing the features of Distinguishing Guise including its arch shaped support arms, carriage bolts, crimps and dimples and brightly coloured support fingers and commenting on the evidence of Mr. Fabbroni and Mr. Davies (Lucht Applicant's Evidence affidavit). Leave was also granted for the filing of an affidavit of Mr. Lucht sworn December 19, 2013 (the Lucht Supplemental affidavit) which comments on the undertakings provided by Mr. Fabbroni and Mr. Davies.

Wayne Tennesey

[20] Mr. Tennesey, a professional engineer and a principal of Testlabs International Ltd., a Canadian mechanical and metallurgical engineering company (Tenessey affidavit, paras 1-3), provides pictures or depictions of a number of different ramp designs sold at a variety of retailers (Tenessey affidavit, Exhibit A, Appendix A) and concludes that the Distinguishing Guise has a unique look (Tenessey affidavit, Exhibit A, page 6). Mr. Tennesey also assembles and reviews one of the Applicant's loading ramps featuring the Distinguishing Guise (Tenessey affidavit, Exhibit A, page 4). Mr. Tennesey concludes that the design of the ramp is ornamental in nature, that the use of the dimples and crimps provides a strong visual element, the arch creates a unique look and the use of the smooth dome fasteners is an aesthetic detail (Exhibit A).

[21] Mr. Tennesey and Mr. Lucht were cross-examined and transcripts, exhibits and answers to undertakings were filed. Mr. Lucht was cross-examined twice. The July 19, 2013 examination pertained to the Lucht Applicant's Evidence affidavit, and the March 24, 2014 examination pertained to the Lucht Supplemental affidavit.

[22] Both parties filed detailed written arguments. A hearing was held on April 24, 2015 at which both parties were represented.

Legal and Evidentiary Onus

[23] In an opposition, an applicant bears the legal onus of establishing, 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 to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exists [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD)].

[24] In its written submission, the Applicant submits the following regarding the Opponent's evidential burden (at paras 14-15):

... The burden is on the Opponent and the Opponent cannot meet the burden of disallowing the application by merely establishing a contest between opposing views of experts. The Opponent's evidence must strongly redirect the decision making process of the Trade-marks Opposition Board.

The Opponent's evidence must be sufficiently probative as to persuade the Opposition Board that an error was made in issuing an approval notice and publishing [the application].

[25] There is no such burden on the Opponent. A decision by the examination section of the Trade-marks Office does not have precedential value for the Trade-marks Opposition Board such that the Opponent's evidence must "redirect the decision making process". First, the examination section does not have before it the evidence that is filed by the parties in an opposition. Second, the burden on an applicant differs depending on whether the application is at the examination stage or at the opposition stage [*Lutron Electronics Co v Litron Distributors Ltd*, 2013 TMOB 129 at para 59].

Striking Paragraphs Out in Counter Statement

[26] The Opponent requests that paragraphs 5-7, 21-29 and 31 of the counter statement be struck since they are not responsive to the allegations made in the statement of opposition (Opponent's Written Argument, paras 6-7). I decline to do so as the appropriate time to strike pleadings is prior to evidence being filed [*Novopharm Ltd v AstraZeneca AB*, (2002), 21 CPR (4th) 289 (FCA) at para 9]. Further, as there are no provisions in the Act or the *Trade-marks*

Regulations that govern the content of a counter statement similar to the provisions of sections 38(2), 38(3) and 38(4) of the Act, which establish certain guidelines as to the content of a statement of opposition, it is not clear what basis I would have for striking the particular paragraphs objected to by the Opponent.

Admissibility of Benchmark Study

[27] Mr. Lucht's Examination affidavit attaches a market audit of the Canadian ramp marketplace performed by the Benchmark Consulting Group Inc. which purports to look at the range of products which are available through Canadian retailers and to assess the characteristics of products which are most similar to those offered by the Applicant (Lucht Examination affidavit, paras 24-27, Exhibit F). The Benchmark study is inadmissible as it is hearsay and there is no information as to why the filing of the evidence in this manner was necessary. In these circumstances, I am not prepared to find it admissible albeit with diminished weight [*R v Khan*, [1990] 2 SCR 531 (SCC); *Anheuser-Busch Inc v Daum* (2010), 88 CPR (4th) 300 (TMOB) at paras 10-16]. Had I considered it, however, I would not have reached a different conclusion on either of the grounds of opposition discussed in this decision.

Evidence of Mr. Fabbroni and Mr. Tennesey

[28] Both the Opponent and the Applicant have filed expert evidence with respect to the functionality and the uniqueness of the Distinguishing Guise. In *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 at para 75, it was emphasized that the following four requirements [as set out in the decision *R v Mohan*, [1994], 2 SCR 9] must be met before expert evidence may be accepted: relevance; necessity in assisting the trier of fact (i.e. if it is likely to be outside the experience and knowledge of the judge); the absence of any exclusionary rule; and a properly qualified expert.

[29] In the present case, both Mr. Fabbroni and Mr. Tennesey describe their respective backgrounds and work experience in detail and provide an opinion about various features of the Distinguishing Guise. Both provide evidence which appears to involve a degree of specialized knowledge with respect to the function of various ramp components and appear qualified to

provide such evidence despite the objections to their expertise with respect to background of Mr. Tennesseey and the background and inaccurate gauge measurements taken by Mr. Fabbroni. While Mr. Fabbroni and Mr. Tennesseey offer contrasting opinions on whether the Distinguishing Guise is functional, Mr. Tennesseey's evidence appears to be influenced by his assumption that if there is more than one way to do something, for example, to create an arched or curved shape in a ramp or, to use a particular type of fastener, the choice to do it in a particular way is an ornamental feature as opposed to a functional one (Tennesseey affidavit, pages 6; Tennesseey cross-examination, Qs 163-172; 345-348).

Overview of the Applicant's Activities with Respect to the Distinguishing Guise

[30] The Applicant is a leading supplier of steel products including a variety of loading and utility ramps (Lucht Examination affidavit, para 2) and has been described by the Opponent as the pioneer behind the growing ramp business in Canada (Lucht Examination affidavit, Exhibit E).

[31] Since 2001, the Applicant has sold a series of arched 7 and 8 foot ramps with the Distinguishing Guise (Lucht Examination affidavit, para 5). The ramps are sold in pairs in the packaging shown below (Tennesseey affidavit, Exhibit A, page 9) and consumers have to assemble the ramps with an electric drill, adjustable wrench and pliers. Once assembled the ramps can be folded for easy storage.



[32] From their introduction in 2001 to March 2011 over 200,000 pairs of the Applicant’s ramps have been sold in Canada (Lucht Examination affidavit, para 28). Mr. Lucht further states on March 30, 2011 that “sales of truck ramps have been steady for the last five years and consistently exceed [\$1.7 Million] per annum with the majority of sales being arched ramps of the kind that are the subject of this application for a distinguishing guise” (Lucht Examination affidavit, para 30).

[33] The evidence is that the Applicant’s arched ramps with the Distinguishing Guise are or have been sold at numerous retailers including Canadian Tire (Lucht Examination affidavit, paras 21-23); Northern Tool + Equipment (Lucht Examination affidavit, para 34; Exhibit I), Princess Auto (Lucht Examination affidavit, para 35; Exhibit J) and TSC Stores (Lucht Examination affidavit, para 36; Exhibit K). The Applicant also sells mail-order product to customers (Lucht Applicant’s Evidence affidavit, para 8).

[34] Photographs of ramps featuring the Distinguishing Guise appear in the Applicant’s brochures and in retailer catalogues (Lucht Examination affidavit, Exhibits A, I-K). Assembled ramps featuring the Distinguishing Guise are also on display at select retailer locations and at trade shows (Lucht Applicant’s Evidence affidavit, paras 73, Exhibit F; Lucht Examination affidavit, Exhibit M).

[35] None of the materials in evidence including the artwork for the packaging, the photographs of displays, the catalogues, or the brochures appear to educate consumers that the design of the ramp is functioning to indicate the source of the Goods to consumers.

Overview of the Opponent's Activities with Respect to the Distinguishing Guise

[36] Loading ramps of various lengths are and have been offered by Canadian Tire within its automotive merchandising division since at least as early as 1980 (Davies affidavit, para 6). Canadian Tire purchased arched loading ramps in kit format from the Applicant from 2004-2009 (Davies affidavit, para 14). After 2009, it began purchasing a ramp with the same distinguishing guise from other suppliers (Davies affidavit, paras 10, 13-15). At Exhibit 1 and 2 of Mr. Davies affidavit, he includes screen shots from the Canadian Tire website of advertisements for loading ramps featuring the Distinguishing Guise which he says are not manufactured by the Applicant (Davies para 13). The Applicant disputes this and provides evidence which it says shows that the screen shots display its ramps (with the WEST brand removed) (Lucht Supplemental affidavit, Exhibit G).

Action Brought by Applicant in Ontario Court

[37] In its written arguments at para 6, the Applicant explains that it has brought an action against the Opponent in Ontario:

At some date following the application [for the Distinguishing Guise], Canadian Tire Corporation began to import into Canada point by point copies of the Applicant's wares that were manufactured in Canada. Canadian Tire Corporation used images of the Applicant's own ramps to advertise or sell the infringing ones that were substituted into the Canadian Tire inventory at a date that has never been disclosed by Canadian Tire Corporation. These infringing wares are now subject to litigation in the Ontario Superior Court ... on the basis that they are infringing the Applicant's intellectual property rights in a variety of manners [(Lucht Applicant's Evidence affidavit, paras 26-29)].

The relevance of this action will be discussed during the analysis of the grounds of opposition.

Analysis of the Grounds of Opposition

[38] I will now begin my analysis of the grounds of opposition by starting with the ground of opposition which alleges that the Distinguishing Guise is not distinctive.

First Ground of Opposition: Distinguishing Guise is Not Distinctive

[39] The Opponent has pleaded that the Mark is not distinctive contrary to section 38(2)(d) of the Act. The Opponent alleges at para 9(b)(ii):

The [Distinguishing Guise] has not been used by the Applicant as to have become distinctive as at the date of the filing of the application ... or at any other material date, in that it comprises a drawing of a utilitarian and functional ramp per se, and is simply an aggregation of the utilitarian and functional ramp component items [in particular]:

- a. The ramp is bi-folded;
- b. The bi-fold is accomplished by a knee hinge for which no claim of registrability or distinctiveness is made in the narrative of the application;
- c. The ramp rails are intended to communicate between two surfaces at different levels;
- d. The arch in the ramp rails serves to orient the upper half of the bi-fold rail assembly to the same plane as the upper surface against which the ramp assembly rests. The arch in the ramp rails also lessens the transition angle between the ramp surface and the loading surface. The arch does not serve an ornamental or decorative purpose;
- e. The crimps in the upper half of bi-fold rail are a result of, or are made to avoid the result of, the bend in the upper bi-fold portion of the rail, and also serve to structurally reinforce the bend in the rail. The crimps do not serve an ornamental or decorative purpose;
- f. The series of cross-bars between ramp rails are part of the structural integrity of the ramp device, by maintaining the parallel orientation of the ramp rails. They do not serve an ornamental or decorative purpose;
- g. The dome fasteners are disclosed in the Lucht affidavit as being carriage bolts, a common mechanical fastening device, and are employed to functionally fasten each cross-bar member to the ramp rails, and not for an ornamental or decorative purpose;
- h. The brightly coloured ramp support tipped fingers are intended to prevent damage to the loading surface that might otherwise occur in consequence of the metal-on-substance contact between the fingers of the upper end of the ramp device and the loading surface on which the upper end of the device rests. The brightly coloured ramp support tipped fingers also serve to warn of, and identify to the user, a potential pinch hazard between the ramp and loading surface. The alleged brightly coloured ramp support tipped fingers do not serve an ornamental or decorative purpose.

[40] If the Opponent meets its initial evidential burden with respect to its allegation that the Distinguishing Guise is functional and, as such, lacks inherent distinctiveness, the Applicant must then meet its legal onus of proving consumers recognize the Distinguishing Guise and associate it with a single source.

Material Date

[41] The material date for distinctiveness with respect to grounds of opposition based on sections 38(2)(d) and 2 of the Act is the date of the statement of opposition [*Canadian Generic Pharmaceutical Association v Glaxo Group Limited*, 2013 TMOB 36 at para 73; *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 at 324-325 (FC)]. While the Applicant addresses its arguments and evidence to the date the application was filed, regardless of whether distinctiveness is assessed as of the date of filing the statement of opposition or the filing of the application, the result does not differ.

Distinguishing Guise Must be Assessed as Whole

[42] When assessing distinctiveness it is the whole of the trade-mark which is to be considered and the over-all impression upon the members of the public to whom the goods are offered for sale [*Calumet Manufacturing Ltd v Mennen Canada Inc* (1992), 40 CPR (3d) 76 at 89 (FCTD)].

The Opponent Meets Its Evidential Burden

[43] The basis for the Opponent's allegation that the Distinguishing Guise is not distinctive is that it does not indicate source due to the fact that it is an aggregation of utilitarian and functional ramp components. The evidence summarized in the next paragraph is sufficient to meet the Opponent's initial evidential burden that the Distinguishing Guise is functional and, as such, is not inherently distinctive.

[44] The arched design allows for loading of low clearance equipment which prevents the undercarriage of vehicles such as ATVs from becoming "hung up" with one set of wheels on the ramp and the other on a pick up truck (Lucht Examination affidavit, Exhibit A, descriptions of 7

Foot and 8+ Foot Arched Folding Ramps; Tennesey affidavit, Exhibit A, pg 4; Fabbroni affidavit, Exhibit A, pg 5; Lucht Examination affidavit, Exhibit J). At the top of the ramp, the support fingers rest on the tailgate of a pick up truck and prevent the ramp from slipping out of position and protect the tailgate from damage (Lucht affidavit, February 13, 2013, paras 50-51). The beams between the rails function to form the surface of the ramp and transmit the loads applied to the ramp. The beams are held to the rails by smooth dome fasteners which can be assembled by consumers with a wrench alone (Tennesey cross-examination, Qs219-220, 247-248, 345-348; Fabbroni, Exhibit A pages 5-6). The five dimples along the side and five crimps along the bottom appear as the result of a manufacturing technique to arch the ramp where by upper straight beams are bent (Tennesey affidavit, Exhibit A, para 5; Tennesey cross-examination, Qs148-151; Lucht Applicant's Evidence affidavit, para 40). Finally, the hinge which is featured in the drawing allows the ramp to be folded for easy storage (Lucht Applicant's Evidence affidavit, Exhibit A).

The Applicant's Legal Onus to Prove the Distinguishing Guise is Distinctive

[45] As the Opponent has met its initial evidential burden with respect to its allegations regarding functionality, I must now consider whether the Applicant has met its legal onus of proving that the Distinguishing Guise is distinctive despite the fact that it has a significant utilitarian function and as such lacks inherent distinctiveness.

[46] The Applicant's position is summarized at paragraph 5 of its Written Argument.

Western Steel ramps have a unique appearance as compared to all other manufacturers and sellers of ramps in Canada. There are no other similar loading ramps commercially available in Canada and at the time [of] the Application, no other company in Canada manufactured for sale in Canada or for sale by export a loading ramp which was arched and folding and possessed a similar appearance to the wares of the Applicant for which a registration is sought by the Applicant. No other company in North America produced a competing product with the same functional and aesthetic features.

[47] Although there may have been extensive sales and some advertising associated with Goods bearing the Distinguishing Guise that alone does not necessarily result in distinctiveness. Rather, a distinguishing guise must be perceived or understood by the public to perform the

function of distinguishing the goods of an applicant from those of others [*Adidas (Canada) Ltd v Colins Inc* (1978), 38 CPR (2d) 145 (FCTD)]. The Applicant must therefore show that consumers recognize the Distinguishing Guise as a trade-mark, not just as being a functional element or consisting of ornamental and functional elements [*Novopharm Ltd v Astra AB* (2000), 6 CPR (4th) 101 at (TMOB) at 112]. The Canadian Intellectual Property Office's Practice Notice on Three-dimensional Marks explains:

For a distinguishing guise which is inherently weak (e.g. if it has a significant ornamental or utilitarian function), it will normally be necessary to provide more direct evidence that purchasers in the marketplace have come to recognize the guise as distinguishing the wares or services of its owner from those of others; for this purpose survey evidence or affidavits from actual purchasers may be necessary. In order to establish acquired distinctiveness, the evidence submitted need not show that 100% of potential purchasers recognize the guise as serving to distinguish; however, in general the evidence would have to be sufficient for it to be concluded that a high proportion of potential purchasers recognize the guise as serving to distinguish.

The Applicant's Evidence of Distinctiveness

[48] At the outset I note that there is no direct evidence from consumers which would provide any assistance as to ascertaining how consumers perceive the Distinguishing Guise.

[49] Mr. Lucht states that ramps featuring the Distinguishing Guise are distinct as a result of their appearance, the manner in which the ramps are packaged for sale and the appearance of the packaged kit itself (Lucht Applicant's Evidence affidavit, para 8). Consumers are exposed to the Distinguishing Guise in the following ways: (i) there is a photograph of the Distinguishing Guise on the packaging; (ii) it is featured in advertising contained in retailer flyers and the Applicant's brochures (Lucht Examination affidavit, Exhibits A, I-K) and (iii) it is on display at certain retailers such Princess Auto and at trade shows (Lucht Applicant's Evidence affidavit, para 73, Exhibit F; Lucht Examination affidavit, Exhibit M).

[50] I consider the Applicant's evidence far from sufficient to show that the relevant public has been educated as to the trade-mark status of the Distinguishing Guise. Overall, it does not appear to me that the photograph of the ramp on the box, display of assembled ramps in stores or at trade shows or the depiction of the ramps in catalogues and advertising would serve to educate consumers that the Distinguishing Guise indicates a single source of ramps. Rather, the evidence appears to suggest to consumers that the Distinguishing Guise signifies functional aspects of the

trade-mark as opposed to indicating source. For example, the Princess Auto catalogue states that the “arched design allows clearance for loading low-profile equipment”, the Northern Tool & Equipment catalogue states that the “unique folding design let’s you use the ramp in two ways” and the Applicant’s brochures states that the “arched design allows for loading of low clearance equipment” (Lucht Examination affidavit, Exhibits A, I and J). Further, the use of the WEST trade-mark on the packaging and label on the loading ramps themselves and in some advertisements is not sufficient for me to find that the consumers associate the Distinguishing Guise with a particular manufacturer.

[51] In the absence of evidence that consumers interpret the Distinguishing Guise as indicative of source, I am not prepared to conclude that this would necessarily be their understanding.

Sales of Ramps with the Distinguishing Guise by Others

[52] While Canadian Tire has carried third party manufactured folding ramps featuring the distinguishing guise and has done so since sometime in 2009, as no sales information for these ramps has been provided it is not possible to determine the effect, if any, the sales of ramps manufactured by others and sold by Canadian Tire have had on the distinctiveness of the Distinguishing Guise. Having found that the Opponent’s sales of ramps with the distinguishing guise does not impact this ground of opposition, it is unnecessary for me to decide whether the Opponent is entitled to rely on use of the distinguishing guise which the Applicant describes as unlawful and has brought an action against [see *McCabe v Yamamoto & Co (America) Inc* (1989), 23 CPR (3d) 498 for a discussion of when unlawful use by an opponent cannot be relied upon to succeed in an opposition].

Not Sufficient That the Ramps Have a Unique Appearance

[53] In his cross-examination, Mr. Lucht states that “a distinctive product is a product different than everybody else” (Lucht cross-examination, Q84, July 19, 2013). The evidence of Mr. Lucht and Mr. Tennessee provides an overview of the loading ramp market and sets out that the Distinguishing Guise is unique in its appearance (Lucht Examination affidavit, Exhibit C; Tennessee affidavit, Exhibit A, Appendix A). Having a product which is unique or different from others, however, is not necessarily sufficient to establish that a particular trade-mark is distinctive. In this case, the absence of evidence that consumers find that the Distinguishing Guise indicates source, means that even if I found the Distinguishing Guise to be unique this would not necessarily result in a finding that it is distinctive. In *Royal Doulton Tableware Ltd v Cassidy’s Ltd* (1986), 1 CPR (3d) 214 at 225 (FCTD), the Federal Court explains that a trade-mark may be recognized as unique but not distinctive:

It is to be noted that a distinctive trade mark is one which links, e.g., goods with a vendor so as to distinguish them from the goods of other vendors. It is not distinctive if it simply distinguishes one design of goods from another design of goods even though if one had special trade knowledge one might know that these two kinds of goods are sold respectively by two different vendors. Such a concept of distinctiveness would run counter to a basic purpose of the trade mark which is to assure the purchaser that the goods have come from a particular source in which he has confidence...

The Federal Court commented on this issue more recently in *Apotex Inc v Canada (Registrar of Trade-marks)* 2010 FC 291; aff’d 91 CPR (4th) 320 (FCA) (**emphasis is mine**):

[37] GSK also emphasizes the point that in terms of appearance, the Advair Diskus inhaler is one-of-a-kind in Canada and widely used. This evidence of uniqueness and market exposure, it argues is what has led to a distinct brand identity and the public recognition of the GSK Mark.

[38] All of this is relevant evidence but it is not of itself persuasive. In *Molson Breweries v John Labatt Ltd* (2000), 2000 CanLII 17105 (FCA), 5 CPR (4th) 180 (FCA), Justice Marshall Rothstein writing for the majority, discounted evidence of extensive sales and advertising expenditures in proving distinctiveness where the claimed word-mark “Export” was never used in isolation (see para. 79). In *Ciba-Geigy Canada Ltd v Novopharm Ltd* (1994), 56 CPR (3d) 289 at 313 (FCTD), Justice Rothstein also held that **the existence of a**

monopoly did not itself imply that the appearance of a product had given it a secondary meaning. This decision was varied for other reasons at (1994), 56 CPR (3d) 289 and at (1994), 56 CPR (3d) 344....

Conclusion Regarding Distinctiveness

[54] The evidence does not enable me to conclude on a balance of probabilities that the Distinguishing Guise was distinctive as of the date of filing of the statement of opposition. The fact that the Distinguishing Guise may be unique within the marketplace is not sufficient for a finding of distinctiveness. The Applicant has not clearly established that a significant number of consumers relate the Distinguishing Guise to a single source as opposed to a functional and utilitarian ramp. Accordingly, the distinctiveness ground of opposition succeeds on this basis.

Second Ground of Opposition: Distinguishing Guise Is Primarily Functional

The Ground of Opposition

[55] The statement of opposition pleads at para 7(a)(ii) that the Distinguishing Guise is not registrable since it comprises a drawing of a utilitarian and functional ramp per se, and is simply an aggregation of the utilitarian and functional ramp component items set out in paragraph 39 of this decision.

Material Date

[56] I consider the material date to be the filing date of the application since this is the date set out in section 13 of the Act.

Functional Distinguishing Guises are Not Registrable

[57] While distinguishing guises may necessarily possess a functional element(s) or component(s), and some functionality is permissible in a trade-mark [*Thomas & Betts, Ltd v Panduit Corp et al* (2000), 4 CPR (4th) 498 (FCA) at 505-507; *Crocs Canada Inc v Holey Soles Holdings Ltd*, (2008), 64 CPR (4th) 467 (FC) at para 18], to the extent that such functionality relates primarily or essentially to the goods themselves it will render the distinguishing guise unregistrable [*Remington Rand, supra* at 478]. The Federal Court of Appeal explained the rationale behind this in *Kirkbi AG v Ritvik Holdings Inc* 2003 FCA 297 at para 59 aff'd *Kirkbi AG v Ritvik Holdings Inc*, [2005] SCR 302 at para 60:

It follows that if a distinguishing guise is wholly or primarily functional, then the public is not constrained from using the distinguishing guise in its entirety. Thus a distinguishing guise which is primarily functional provided no rights to exclusive use and hence no trade-mark protection.

[58] In *WCC containers sales Ltd v Haul-All Equipment Ltd*, 2003 FC 962 at paras 39-41, Kelen J explains it must be decided whether a distinguishing guise is primarily functional, or whether the distinguishing guise's functionality is secondary to the role it plays in distinguishing its owner's goods from those of others. If the functionality goes either to the trade-mark itself or to the goods, then it is inconsistent with registration. However, if it is merely secondary or peripheral, like a telephone number with no essential connection with the goods, then it does not act as a bar to registration. In *Crocs Canada Inc, supra* (2008), 64 CPR (4th) 467 (FC) at para 12, the Federal Court frames the inquiry as asking whether the functional role of the design at issue can be viewed as separate from the distinguishing role of the design.

The Opponent's Position

[59] The Opponent submits that the Distinguishing Guise is nothing more than a depiction of a ramp which is an aggregation of utilitarian and functional components and as such cannot satisfy the requirements of showing acquired distinctiveness set out in section 13(1) of the Act.

The Applicant's Position

[60] The Applicant's position is that the design of the Distinguishing Guise is not primarily dictated by functionality and that none of the ornamental features claimed in the guise such as the arched shape, pattern of crimps and dimples, smooth dome fasteners, or brightly coloured support fingers are functional (Applicant's Written Argument, para 174). The Applicant submits at 111, 113-114 of the Written Argument that:

111 [There is] strong evidence that there would be no functional difference to the consumer if he or she were to use a ramp without crimps or dimples introduced in the fabrication process or a ramp with a smooth curve instead of a segmented arch. To the consumer, crimps and dimples are part of the ornamentation of the product. This was referred to by Mr. Tennesey when he advised "the use of a series of five dimples along the side and five crimps along the bottom of the rail is an elaborate method of producing an arch in the ramp while providing an

extremely strong visual design element.”

- 113 The Opponent advances the position through the report of Mr. Fabbroni that functionality in a finished product extends to all aspects of the manufacturing process, as well as the individual analysis of the components or sub components that make up the product. The Opponent concludes that an assessment of functionality for the individual parts can be made independently without consideration of the final form.
- 114 Analysis by this methodology and performed in a vacuum could inaccurately categorize virtually any ware for which a distinguishing guise is sought as “functional”. It ignores the proper test of a trade-mark which is the overall impression of a consumer of the mark or guise in its final form. The ultimate consumer sees the shape and appearance of the ramp and does not observe the manufacturing process of the ware.

The Distinguishing Guise is Primarily Functional

[61] After a review of the evidence, I find that although the Distinguishing Guise has some ornamental features, it provides practical advantages and is primarily functional when considered as a whole. Mr. Lucht appears to concede this when he explains that when he designed the Distinguishing Guise he “[looked] at all the product out there and came up with a design that was better and different” (Lucht cross-examination, July 19, 2013, Q87).

[62] My findings on functionality of the Distinguishing Guise are set out below. For ease of reference and in response to the parties’ written arguments and submissions at the hearing, I have set out my findings by feature. However, in reaching my conclusion that the Distinguishing Guise is primarily functional, I have considered it as a whole.

- The arched design of the ramp allows for loading of low clearance equipment and prevents vehicles from being “hung up” on the ramp (Lucht Examination affidavit, Exhibit A, descriptions of 7 Foot and 8+ Foot Arched Folding Ramps, Tennessee affidavit, Exhibit A, pg 4).
- Although they appear ornamental to consumers, the five dimples along the side and five crimps along the bottom are a result of a manufacturing technique to arch the ramp where

by upper straight beams are bent (Tennessee affidavit, Exhibit A, para 5; Tennessee cross-examination, Q151; Lucht Applicant's evidence affidavit, para 40). In its written argument, the Applicant explains at para 76(d):

That in the manufacturing process wherein steel of the sort used in the Applicant's ramp is bent, material is displaced or kinked. One way of making a place for the displaced material to during the bending process is to make indents on one side of the metal.

First, although the five dimples may appear to be ornamental in nature to consumers when considering the guise as a whole these dimples do not have a large impact. Second, where a change in appearance of the goods in relation to which a distinguishing guise is to be used is the normal result of a process that has a functional use or characteristic, in this case the arching of the metal, such a change in appearance cannot be a trade-mark [*Elgin Handles Ltd v Welland Vale Mfg. Co. Ltd.*, [1965] 1 Ex CR 3].

- The support fingers at the top of the ramp rest on the tailgate of a pick up truck and prevent the ramp from slipping out of position and protect the tailgate from damage (Lucht affidavit, February 13, 2013, paras 50-51; Cohen affidavit, Exhibit 27 - US Patent 6,139,249 – page 3, lines 50-60). While the description specifies these are brightly coloured, I do not find this to be a significant ornamental feature when considering the guise as a whole.
- The beams between the rails function to form the surface of the ramp and are held together by smooth dome fasteners which can be assembled by consumers with a wrench alone (Tennessee cross-examination, Qs219-220, 247-248, 345-348; Fabbroni, Exhibit A pages 5-6).

Applicant's Arguments Regarding Functionally Equivalent Designs

[63] The Applicant's submissions that it would be possible for a ramp to have the same functional attributes using a design other than the Distinguishing Guise does not persuade me that it is not primarily functional. At para 184 of its Written Argument, the Applicant sets out:

There would be no functional difference if the consumer were to use a ramp without crimps or dimples, a ramp with a smooth curve instead of a segmented arch, a ramp with any other style of fastener or a ramp with any other coloured support finger.

[64] The Applicant's evidence is that that the introduction of curvature to allow for loading of equipment with low ground clearance such as lawn tractors and motorcycles can be accomplished through the use of hinges, side notches, or a curved shape (Lucht Applicant's Evidence affidavit, para 19, 22-24) or, even if crimps and dimples are used to bend the metal in an arched shape, any number of crimps or dimples can be used to achieve the desired arching effect (Lucht's Applicant's Evidence affidavit, para 47). Mr. Fabbroni also acknowledges this when he indicates that there are an infinite number of different ways a manufacturer could reduce the angle of a ramp (Fabbroni cross-examination, Q207) to facilitate loading. Also by way of example, both Mr. Lucht and Mr. Fabbroni agree that it is not necessary to use smooth dome fasteners to hold the ramp together and other fasteners could be used (such as welds, bolts or rivets) (Lucht Applicant's evidence affidavit, para 31; Fabbroni cross-examination, Qs304,312).

[65] Evidence that the function of a distinguishing guise could be replicated through the use of a different design has been considered by the Federal Court and Federal Court of Appeal. In *WCC containers sales Ltd., supra* at paras 50-52, Kelen J noted evidence from one witness that that "other inclinations and combinations of sloping surfaces are freely available to any designer to use in functional or purely aesthetic arrangements" but found that the distinguishing guise design registration for a sloped bin refuse container invalid as being primarily functional. In *Remington Rand Corp, supra* at 476-477, the Federal Court of Appeal considered that the distinguishing guise at issue would only cover a triple-headed triangular configuration which was a very small part of the shaving market but still found the distinguishing guise at issue functional:

Moreover, I am not persuaded by the Trial Judge's alternative conclusion that there was no evidence that "utilitarian functionality dictated the design of the triple headed shaver." Shaver heads in general are utilitarian in nature, and the Trial Judge found that the "equilateral triangular configuration is one of the better designs for a triple headed shaver." Here, the shaver heads are functional and the three-headed equilateral triangular configuration is functional. The design mark, by depicting those functional elements, is primarily functional.

The respondent attempted to make much of the Trial Judge's finding about the breadth of the Canadian market for shavers (395):

Philips is the only company marketing a triple headed shaver in Canada and, between 1983 and 1990, it had an average annual advertising cost of approximately \$5.7 million dollars for this product. However, the market for electric shavers in Canada is extensive, comprising both reciprocating and rotary shavers. Within this market, a number of manufacturers promote and sell a large variety of products, including models with one or more foil heads with reciprocating cutters, foil heads with rotary cutters, clipper heads with reciprocating cutters and slotted metal discs with rotary cutters.

The respondent argued that the inhibition on the appellants' ability to compete would be only as to the triple-headed shaver market, by implication a smaller part of the Canadian market. To my mind this is irrelevant to the public policy consideration invoked by Pratte J.A. Whatever the portion of the sales market in question, registration of a primarily functional mark is a restraint on manufacturing and trade, since it effectively amounts to a patent or industrial design in the guise of a trade mark.

Conclusion

[66] I find on a balance of probabilities that the Distinguishing Guise when considered as a whole is primarily functional. In *Remington Rand Corp supra* at 476, the Federal Court of Appeal when assessing the functionality of a shaver head claimed as a distinguishing guise commented “Here, the shaver heads are functional and the three-headed equilateral triangular configuration is functional. The design mark, by depicting those functional elements, is primarily functional.” The evidence in this case leads to a similar conclusion. Here, the loading ramp is functional and the Distinguishing Guise depicting it is functional. While some of the minor features of the Distinguishing Guise may be regarded as ornamental in nature by consumers such as the brightly coloured support fingers and number of dimples and crimps, these are not sufficient to result in a finding that the Distinguishing Guise as a whole is not functional. Further, the focus on these particular items when none of the other parts of the Distinguishing Guise, such as the arched shape, hinge and beams and rails, have been disclaimed is contrary to the consideration of the Distinguishing Guise as a whole. I note that the Registrar considers that a distinguishing guise may include the shaping of a part of the goods, as opposed to the goods in their entirety [see, for example, *Intergold Limited v Doherty*, 2002 CanLII 61444

(TMOB)], and my findings on functionality may well have been different if the Distinguishing Guise applied-for contained only the shaping of a part of the Applicant's loading ramps as opposed to the ramp as a whole.

Remaining Grounds of Opposition

[67] Having already refused the application under two grounds, I will not discuss the remaining grounds of opposition.

Disposition

[68] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse application No. 1,452,547 pursuant to section 38(8) of the Act.

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Hearing Date: 2015-04-24

Appearances

Shane D. Hardy
Steven Kennedy

For the Opponent

David Seed

For the Applicant

Agents of Record

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For the Opponent

Borges & Associates

For the Applicant

Schedule A

Summary of the Grounds of Opposition

Section 38(2)(a) of the Act

- The application does not comply with section 30(a) of the Act since the Applicant has failed to state the Goods in ordinary commercial terms.
- The application does not comply with section 30(b) of the Act since the Applicant has not used the Mark in Canada in association with the Goods since the alleged date of first use.
- The application does not comply with section 30(h) of the Act. The description and drawing contained in the application are not an accurate representation of the Distinguishing Guise. The drawing and description are not accurate in that the description is imprecise and indefinite as it uses the word “including”, the number and location of the crimps is not provided, the precise bright colours used for the support fingers are not set out, the design and drawing do not disclose that the Distinguishing Guise is for a bi-fold ramp, and the drawing and description do not disclose that the Distinguishing Guise is sold unassembled.
- The application does not comply with section 30(i) of the Act since the Applicant could not have been satisfied that it was entitled to use the Distinguishing Guise. The Applicant was aware at the time the application was filed of the technical deficiencies in the application, of the utilitarian and functional features of the Distinguishing Guise and that it was not distinctive. Moreover, the affidavit filed during the examination stage contained statements of fact and conclusions of law not supported by the evidence and was misleading by material omission.

Section 38(2)(b) Ground of Opposition

- The application is not registrable pursuant to section 12(1)(b) of the Act. The Distinguishing Guise is either clearly descriptive or deceptively misdescriptive of the character and quality of the Goods, namely, the Mark is nothing more than a literal depiction of a utilitarian and functional ramp and an aggregation of utilitarian and functional components.

- The application is not registrable pursuant to sections 10 and 12(1)(e) of the Act. The Distinguishing Guise has become recognized in Canada as designating the kind, quality or quantity of the Goods, namely ramps.
- The application is not registrable pursuant to section 13(1) of the Act. The Distinguishing Guise has not been used by the Applicant so as to have become distinctive as of the date of filing the application and the registration is likely to unreasonably limit the development of art in the ramp industry.

Section 38(2)(c) of the Act

- The Applicant is not the person entitled to register the Distinguishing Guise pursuant to section 16 of the Act since on January 2004 the application did not comply with section 30 of the Act and the Distinguishing Guise was not registrable.

Section 38(2)(d) of the Act

- The Distinguishing Guise is not distinctive within the meaning of section 2 of the Act because:
 - It does not distinguish and is not adapted to distinguish the Applicant's Goods from the goods of the Applicant's competitors and other ramp suppliers in Canada.
 - The Distinguishing Guise has not been used by the Applicant to have become distinctive at the date of filing the application in that (a) the Goods are sold in a boxed kit unassembled form at the time of transfer of property and (b) the Distinguishing Guise comprises a drawing of a utilitarian and functional ramp.
 - The Distinguishing Guise has been abandoned by the Applicant.