



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

**Citation: 2011 TMOB 99**  
**Date of Decision: 2011-06-28**

**IN THE MATTER OF THREE  
OPPOSITIONS by Henkel Corporation  
to application Nos. 1,285,513; 1,321,915;  
1,326,421 for the trade-marks THE  
ORIGINAL SUPER GLUE; THE  
ORIGINAL SUPER GLUE & Design;  
THE ORIGINAL SUPER GLUE,  
respectively, in the name of Pacer  
Technology, a California Corporation**

APPLICATION NO. 1,285,513

FILE RECORD

[1] On January 10, 2006, Pacer Technology, a California Corporation, applied to register the trade-mark THE ORIGINAL SUPER GLUE. The subject Canadian application is based on use and registration of the mark in the United States of America, and based on proposed use in Canada, in association with the following wares:

adhesive bonding agents for use in the industrial, commercial, and hobbyist fields; adhesive bonding agents for household, stationery and office use.

[2] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated December 19, 2007 and was opposed by Henkel Corporation on May 13, 2008. The Registrar forwarded a copy of the statement of opposition to the applicant on June 3, 2008, as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c.

T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[3] The opponent's evidence in chief consists of the affidavits of Monica Goyal, Mary P. Noonan, Roslyn Theodore-McIntosh, David Pinsonnault, Carol Adkins, Rosemary Coelho and Al D'Addese. The applicant's evidence consists of notarial copies of several trade-mark registrations. The opponent's evidence in reply consists of further affidavits of Mary Noonan and Roslyn Theodore-McIntosh, as well as a certified copy of the file wrapper for its registered mark THE ORIGINAL THREADLOCKER & Design.

[4] Both parties filed written submissions. On May 11, 2010, the Registrar advised the parties that they may request an oral hearing. The applicant advised that it did not require an oral hearing while the opponent did not respond. Accordingly, this decision has issued without the benefit of oral submissions from the parties.

#### STATEMENT OF OPPOSITION

[5] The first and second grounds of opposition are reproduced in full below:

(a) The opponent relies upon the ground of opposition provided by Section 38(2)(b) [of the *Trade-marks Act*] and Section 12(1)(b). The mark applied for is not registrable in that it is clearly descriptive of the wares applied for. The term "superglue" is defined in the Canadian Oxford Dictionary, Second Edition, as "any of various adhesives with an exceptional bonding capability", and the word "original" is defined in the same dictionary as "existing from the beginning or earliest stages" and "that is the original or source of something". The mark applied for clearly describes that the wares are a superglue which the applicant claims is "the original" superglue. The mark on the whole is clearly descriptive of the wares applied for, and accordingly is not registrable.

(b) The opponent relies upon the ground of opposition provided by Section 38(2)(b) and Section 12(1)(b). The mark applied for is not registrable in that it is deceptively misdescriptive of the wares applied for. The term "superglue" is defined in the Canadian Oxford Dictionary, Second Edition, as "any of various adhesives with an exceptional bonding capability", and the word "original" is defined in the same dictionary as "existing from the beginning or earliest stages" and "that is the original or source of something". The opponent disputes the applicant's claim that the applied-for wares are "the original" superglue; it is the opponent's position that superglue

wares were marketed by others, including the opponent and its predecessor-in-title Loctite Corporation, prior to the marketing of superglue wares by applicant. In view of this, the mark applied for is deceptively misdescriptive and therefore unregistrable.

[6] The third ground of opposition, pursuant to s.30(i), alleges that the applicant could not be satisfied that it is entitled to use the applied for mark in view of the fact that “other parties have marketed superglue wares prior to the marketing of such wares by the applicant . . .”

#### OPPONENT’S EVIDENCE

##### *David Pinsonnault*

[7] Mr. Pinsonnault identifies himself as the Development Manager for Henkel Canada Corporation (“Henkel Canada”), a wholly-owned subsidiary of the opponent Henkel Corporation. Mr. Pinsonnault has been involved in the research and development of adhesive products for over 30 years. His evidence is that cyanoacrylates are a class of glue products commonly referred to as “super glue” in the adhesives industry. Consumers respond to the term “super glue” by thinking of a glue that has strong adhesive properties, for example, able to glue a person’s fingers together or to suspend the weight of a man. It is not accurate to say that the applicant’s adhesive product is in fact the first commercially available super glue as Henkel Canada Corporation sold super glue products in Canada for many years prior to 2006.

[8] Mr. Pinsonnault further relies on findings of fact set out in a United States civil court case issued in 1981 to assert that several companies began selling cyanoacrylate glues in the United States in the 1970s. In particular, Permabond International Corporation (formerly Rexco Corporation) sold cyanoacrylates to the industrial market in 1969 and began marketing cyanoacrylates as a consumer product in 1971, the first company to do so. Krazy Glue began selling cyanoacrylates to the consumer market in 1973 while Woodhill Chemical Sales Corporation followed in early 1974. Super Glue Corporation entered the consumer market in 1977 with its product GRIPPER SUPER GLUE.

*Carol Adkins*

[9] Ms. Adkins identifies herself as a manager with the opponent company. Her affidavit serves to introduce into evidence, by way of exhibits, correspondence between the parties herein. In particular, Exhibit B is a copy of a letter dated September 25, 2006 from Ronald T. Gravette, Vice President-Sales of the applicant Pacer Technology.

Excerpts from the September 25<sup>th</sup> letter are shown below:

We believe that we have one of **the original super glue** formulations for general consumers on the market . . . Even if we did not believe in the truth of our statements, we believe our boasting is harmless to the consumer . . . I believe that no reasonable consumers would rely on it. . . . exaggerated advertising, blustering and boasting, all known as “puffing,” is not actionable.

(emphasis added)

[10] The opponent, at page 17 of its written argument, comments as follows in respect of Mr. Gravette’s above-noted correspondence:

This paragraph is noteworthy in that it involves the use of the words "the original super glue" by the applicant itself, not in any trade-mark sense, but simply as ordinary descriptive words forming part of an ordinary, grammatically-complete sentence. The fifth sentence of this paragraph reads:

We believe that we have one of the original super glue formulations for general consumers on the market. (our underlining)

Here the applicant itself is using the four words which comprise the subject of this application for trade-mark registration in their plain, ordinary descriptive meaning, not as a trade-mark, but simply as a descriptive portion of a complete sentence in a narrative paragraph. No stronger demonstration of the clear descriptiveness of the words "the original super glue" is possible.

In addition to using the words "the original super glue" in a clearly descriptive manner, Mr. Gravette also, in the seventh sentence of the paragraph, refers to the words as "statements" constituting "boasting":

Even if we did not believe in the truth of our statements, we believe our boasting is harmless to the consumer.

Not only does the applicant use the words in issue as clearly descriptive terms, but also refers to them as such.

*Monica Goyal*

[11] Ms. Goyal identifies herself as a student-at-law employed by the firm representing the opponent. In November 2008, Ms. Goyal visited four retail outlets in Toronto for the purpose of purchasing adhesive products which displayed the words “super glue” on their packaging. Her purchases are attached as Exhibits A to P of her affidavit. In addition to products sold by the parties herein, Ms. Goyal located three third parties describing their products as a “super glue” and another party describing its adhesive as “. . . won’t become brittle like super glues!”

[12] Ms. Goyal also accessed Internet websites for various retailers and located several references to adhesive products referred to as “super glue.” Printouts of her findings are attached to her affidavit as Exhibits Q to KK. Exhibit LL is a printout of the website of Super Glue Corporation. The website indicates that Super Glue Corporation sells a product under the trade-mark THE ORIGINAL SUPER GLUE.

[13] Exhibit KK is a printout of the website of Wikipedia discussing cyanoacrylate. An excerpt from the printout is shown below:

The inventor of cyanoacrylates, Harry Coover, said in 1966 that a **superglue** spray was used in the Vietnam war to retard bleeding in the wounded, whilst they were being transported to hospital. As it can irritate the skin the FDA did not approve **superglue's** civilian medical use until 1998 when a variant called 2-octyl-cyanoacrylate was developed. **Superglue's** use in the Vietnam War is referenced in the film Dog Soldiers.

(emphasis added)

*Al D’Addese*

[14] Mr. D’Addese identifies himself as a Director of Sales for Henkel Canada. His company is licensed to use the opponent’s trade-marks, including the mark LOCTITE used in association with a variety of adhesive products as well as cyanoacrylates commonly referred to in the adhesive industry as “super glue.” Henkel Canada sells cyanoacrylate adhesive products to Canadian retailers including Canadian Tire, Home Depot and Home Hardware. Adhesive products sold under the mark LOCKTITE are sold in packaging that feature the terms SUPERGLUE SUPERCOLLE or SUPER GLUE-COLLE. Sales in Canada of the opponent’s cyanoacrylate “superglue” product have averaged about \$880,000 annually in the four year period 2004 – 2007 and have averaged

about \$589,000 annually in the three year period 2001 – 2003. Paragraph 13 of Mr. D’Addese’s affidavit is reproduced in full below:

I have reviewed the affidavit of Monica Goyal previously filed in these proceedings. Ms. Goyal's affidavit illustrates that in late 2008 she found many different adhesive products, from numerous different companies, available for sale at Canadian retail stores which displayed the terms "Superglue" or "Super Glue" on their product packaging. On the basis of my own personal involvement in the Canadian adhesives industry since 2001, I can say that this is typical of the Canadian marketplace from 2001 to the present, and that throughout the time period from 2001 to the present, numerous different companies have been selling cyanoacrylate adhesives in Canada in association with the terms "Superglue" or "Super Glue".

*Mary P. Noonan*

[15] Ms. Noonan identifies herself as a trade-mark searcher employed by the firm representing the opponent. Her affidavit serves to introduce into evidence, by way of exhibits, (i) copies of three expunged trade-mark registrations, for adhesives, comprised in part of the term SUPER GLUE, and (ii) copies of extracts from *The Canadian Oxford Dictionary* (2<sup>nd</sup> ed.) for the words “the,” “original,” “super,” glue,” and “superglue.”

*Roslyn Theodore-McIntosh*

[16] Ms. Theodore-McIntosh identifies herself as an employee of the firm representing the opponent. Her affidavit serves to introduce into evidence, by way of an exhibit, a copy of a United States civil court case, which discusses, among other things, the chronology of the introduction of cyanoacrylate adhesives in United States. It is the case relied on by Mr. Pinsonnault in paragraph 8, above.

[17] At page 7 of its written argument, the opponent submits that:

While the events set out in the chronology may be hearsay in respect of Mr. Pinsonnault, in the circumstances of the passage of time reliance on hearsay is necessary, and the source is reliable.

We also note that, as a result of subsequent mergers and acquisitions, both the plaintiffs and the defendants from the 1981 United States District Court decision now form part of the opponent Henkel Corporation . . .

Accordingly, the chronology can be considered to be derived from the corporate records of entities which now form part of the opponent . . . We respectfully submit that the opponent has provided the

best evidence available to it in the circumstances of the long passage of time . . .

[18] I agree with the opponent that its evidence concerning the commercial introduction of cyanoacrylate glues to the consumer market in the United States meets the tests of necessity and reliability and therefore has some probative value as part of the evidence of record in this proceeding.

*Rosemary Coelho*

[19] Ms. Coelho identifies herself as a resident of Toronto and a craft hobbyist who uses various types of adhesives for different functional purposes. Her testimony is that if she saw a glue product with the words THE ORIGINAL SUPER GLUE on the package, those words would mean, to her, that the glue was a particularly strong glue and that it was the original, or first, such glue.

APPLICANT’S EVIDENCE

[20] The applicant’s evidence referred to in paragraph 3, above, is summarized below:

TRADE-MARK REGISTRATION	OWNER	WARES/SERVICES
ORIGINAL SHAVER	Bic Inc.	razers, razer blades
ORIGINAL	U L Canada Inc.	ice cream, frozen confection
THE ORIGINAL IRISH CREAM & Design	R & A Bailey & Co.	chocolate, ice cream, liqueurs
THE ORIGINAL POSTER COMPANY	The Original Poster Company Limited	various stationery supplies and associated retail services
AGAVERO EL ORIGINAL LEQUOR DE TEQUILA & Design	Tequila Cuervo, S.A. de C.V.	tequila liqueur
THE ORIGINAL THREADLOCKER & Design	Henkel Corporation	various adhesives and sealants

[21] I note that the word ORIGINAL is not disclaimed in any of the above noted registrations except for the last cited mark THE ORIGINAL THREADLOCKER & Design owned by the opponent Henkel Corporation. The applicant relies on the above registered marks to argue that trade-marks incorporating the word ORIGINAL are, in fact, registrable. In this regard, s.35 of the *Trade-marks Act* stipulates that:

The Registrar may require an applicant for registration of a trade-mark to disclaim the right to the exclusive use apart from the trade-mark of such portion of the trade-mark as is not independently registrable, but the disclaimer does not prejudice or affect the applicant's rights then existing or thereafter arising in the disclaimed matter, nor does the disclaimer prejudice or affect the applicant's right to registration on a subsequent application if the disclaimed matter has then become distinctive of the applicant's wares or services.

[22] In *R.J. Reynolds Tobacco Co. v. Rothmans, Benson & Hedges Inc.* (1993) 47 C.P.R.(3d) 439 (F.C.T.D.), Rothstein J. noted with approval the comments of Jerome A.C.J. in *Canadian Parking Equipment Ltd. v. Canada (Registrar of Trade Marks)* (1990), 34 C.P.R. (3d) 154 at 161 (F.C.A) explaining the effects of s.35:

Section 35 of the *Trade-marks Act* provides that unregistrable parts of a trade mark, descriptive words for example, may be disclaimed apart from use in the mark itself. This provision, therefore, may assist an applicant to overcome an objection based on descriptiveness. Despite the disclaimers associated with it, if a mark as a whole is considered distinctive, it may be registrable. The effect of a disclaimer then is to permit other persons to use the disclaimed material in trade marks of their own and thus prevents monopolization of the specific words.

[23] I would mention that, as of August 15, 2007, it became the policy of the Registrar to no longer require applicants to enter disclaimers of components of trade-marks, although voluntary disclaimers continue to be accepted. I have also noted, in reviewing the file record, that the subject application was approved for advertisement after the new policy came into effect.



OPPONENT'S REPLY EVIDENCE

*Mary P. Noonan*

[24] Ms. Noonan's affidavit serves to introduce into evidence copies of 13 trade-mark registrations disclaiming the term THE ORIGINAL and 18 registrations disclaiming the word ORIGINAL. The opponent relies on the state of the trade-marks register to argue that "The few instances [of registered marks] cited by the applicant [see paragraph 20, above] merely reflect the variability of examination [under the auspices of the Registrar] in a minority of cases."

[25] Of course, the trade-mark application examination process became uniform in not requiring disclaimers after August 15, 2007. In any event, this Board is not bound by decisions or administrative procedures in other sections of the Canadian Intellectual Property Office.

*File wrapper for the mark THE ORIGINAL THREADLOCKER & Design*

[26] As noted by the opponent in its written argument, prior to the Registrar adopting its new policy referred to in paragraph 23, above, the opponent acceded to a disclaimer request by the Registrar for the words ORIGINAL and THREADLOCKER.

*Roslyn Theodore-McIntosh*

[27] Ms. Theodore-McIntosh's affidavit serves to introduce into evidence further entries for the word "original" from two standard reference dictionaries.

LEGAL ONUS AND EVIDENTIAL BURDEN

[28] The legal onus is on the applicant to show that the application does not contravene the provisions of the *Trade-marks Act* as alleged by the opponent in the statement of opposition. However, there is also, in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at 298. The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there

must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

*First and Second Grounds of Opposition*

[29] The material date for considering a ground of opposition based on s.12(1)(b) of the *Trade-marks Act* is the date of decision: see *Lubrication Engineers, Inc. v. Canadian Council of Professional Engineers* (1992), 41 C.P.R. (3d) 243 (F.C.A.). As noted above, there is an initial evidential burden on the opponent to adduce sufficient evidence that would support the truth of its allegations. The issue as to whether the applicant's mark is clearly descriptive must be considered from the point of view of the average purchaser of those wares. Further, the mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression. The word "clearly" is not synonymous with "accurately" but rather "easy to understand, self-evident or plain:" see *Wool Bureau of Canada Ltd. v. Canada (Registrar of Trade Marks)* (1978), 40 C.P.R. (2d) 25 (F.C.T.D.) ; *Atlantic Promotions Inc. v. Canada (Registrar of Trade Marks)* (1984), 2 C.P.R. (3d) 183 (F.C.T.D.); *Canada (Registrar of Trade Marks) v. Provenzano* (1977), 37 C.P.R. (2d) 189 (F.C.T.D.).

[30] Considering in particular the evidence of record in respect of (i) the dictionary definitions of the components of the applied for mark, (ii) the promotion and sales of cyanoacrylate adhesives in Canada in association with the term "superglue" and "super glue" by various third parties and (iii) the applicant's own generic use of the term "the original super glue," I find that the opponent has demonstrated, on a balance of probabilities, that the average consumer would react to the phrase THE ORIGINAL SUPER GLUE by thinking that the product was the original formulation of a high strength glue commercially available to the general public, generically known as "super glue." The average consumer may not know that the term THE ORIGINAL SUPER GLUE refers to a cyanoacrylate product, but the consumer would understand its reference to the first high strength glue, generically known as "super glue," commercially available to consumers.

[31] As the opponent's evidence establishes that Henkel Canada Corporation sold super glue products in Canada for many years prior to the date of filing of the subject

application (based in part on proposed use in Canada) and that third parties sold super glue products in the United States before the applicant Pacer Technology (through a subsidiary Super Glue Corporation) did so, I find that the phrase THE ORIGINAL SUPER GLUE is deceptively misdescriptive, rather than clearly descriptive, of the applicant's wares. Accordingly, the opponent succeeds on the second ground of opposition.

*Third Ground of Opposition*

[32] With respect to the third ground of opposition, s.30(i) applies if fraud is alleged on the part of the applicant or if specific federal statutory provisions prevent the registration of the mark applied for: see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155 and *Canada Post Corporation v. Registrar of Trade-marks* (1991), 40 C.P.R. (3d) 221. In the instant case the pleadings do not support a ground of opposition based on s.30(i) and it is therefore rejected.

APPLICATION NO. 1,321,915

[33] Application No. 1,321,915 for the mark THE ORIGINAL SUPER GLUE & Design, illustrated below, was filed on October 27, 2006 based on use and registration of the mark in the United States of America, and based on proposed use in Canada, in association with the wares listed below:



- (1) adhesive bonding agents for use in the industrial, commercial and hobbyist fields; adhesive bonding agents for household, stationery and office use.
- (2) fingernail cosmetic products, namely nail glue.
- (3) adhesive bonding agents for use in the industrial, commercial, and hobbyist fields for general bonding and repair purposes, adhesive bonding agents for household use.

[34] The applicant claims a priority filing date of April 27, 2006, for the wares (2), above, pursuant to s.34 of the *Trade-marks Act*, based on the filing of a corresponding application in the United States. The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated January 23, 2008 and was opposed by Henkel Corporation on June 12, 2008. The issues for decision, material dates and the evidence of record are essentially the same as in the opposition concerning application no. 1,285,513 and the same result follows. That is, I find that the applied for mark is prohibited by s.12(1)(b) of the *Act* because the mark, considered in its entirety, is deceptively misdescriptive of the applicant's wares since the word components of the mark dominate the design features. In this regard, I am following the guidance of O'Reilly J. in *Canadian Council of Professional Engineers v. John Brooks Co.*, 35 C.P.R. (4th) 507 at 514 (F.C.T.D.), reversing 22 C.P.R. (4th) 547 (T.M.O.B.):

As I read the case law, the proper test is whether the deceptively misdescriptive words "so dominate the applied for trade mark as a whole such that . . . the trade mark would thereby be precluded from registration": *Chocosuisse Union des Fabricants -- Suisses de Chocolate v. Hiram Walker & Sons Ltd.* (1983), 77 C.P.R. (2d) 246 (T.M.O.B.), citing *Lake Ontario Cement Ltd. v. Registrar of Trade Marks* (1976), 31 C.P.R. (2d) 103 (F.C.T.D.).

#### APPLICATION NO. 1,326,421

[33] Application No. 1,326,421 for the mark THE ORIGINAL SUPER GLUE was filed on December 1, 2006 based on use and registration of the mark in the United States of America, and based on proposed use in Canada, in association with the wares  
fingernail cosmetic products, namely nail glue.

[34] The applicant claims a priority filing date of June 2, 2006, pursuant to s.34 of the *Trade-marks Act*, based on the filing of a corresponding application in the United States. The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated November 14, 2007 and was opposed by Henkel Corporation on April 14, 2008. The issues for decision, material dates and the evidence of record are essentially the same as in the opposition concerning application no. 1,285,513 and the

same result follows. That is, I find that the applied for mark is prohibited by s.12(1)(b) of the *Act* because the mark is deceptively misdescriptive of the applicant's wares.

DISPOSITION

[35] In view of the foregoing, application Nos. 1,285,513; 1,321,915; 1,326,421 are refused. These decisions have been made pursuant to a delegation of authority under s.63(3) of the *Trade-marks Act*.

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Myer Herzig  
Member  
Trade-marks Opposition Board