

Federal Court



Cour fédérale

**Date: 20140211**

**Docket: T-276-13**

**Citation: 2014 FC 140**

**Ottawa, Ontario, February 11, 2014**

**PRESENT: The Honourable Mr. Justice Boivin**

**BETWEEN:**

**SK CORPORATION**

**Applicant**

**and**

**SAFETY-KLEEN SYSTEMS, INC.**

**Respondent**

**REASONS FOR JUDGMENT AND JUDGMENT**

[1] This is an appeal by the SK Corporation (applicant) pursuant to section 56 of the *Trade-Marks Act*, RSC 1985, c T-13 (the “Act”) of a decision rendered by Mr. Jean Carrière, the Registrar of Trade-marks Opposition Board (the Registrar) dated December 3, 2012 in respect of the applicant’s application No. 1,273,765. Safety-Kleen Systems Inc. is the respondent in this appeal.

[2] The Registrar rendered a split decision in which the application for registration of the applied-for trade-mark SK with a butterfly design submitted by the applicant (see below) was

rejected with respect of the overlapping wares and the undefined wares. However, the application was allowed with respect to non-overlapping wares and the services covered in the application.

[3] The Registrar was satisfied that, based on the evidence, there is no risk of confusion between the applicant's applied-for mark and the respondent's trade-mark for non-overlapping wares and all the services. However, the Registrar found potential confusion with other overlapping or undefined wares.

[4] The applicant's filed trade-mark is illustrated as follows:



[5] The respondent Safety-Kleen's trade-marks are illustrated as follows:




Registration No. 517,866



Registration No. 516,956

[6] The associated wares and services for both the applicant's and the respondent's trade-marks are reproduced in Appendix A and B.

[7] The trade-mark identified by the Registrar to be the closest to the applicant's applied-for mark is SK Logo (Registration No. 517,866)  and, as such, the analysis was restricted to a comparison between the applicant's applied-for mark (illustrated at paragraph 4) and this Safety Kleen mark.

#### Background

[8] The applicant filed its Trade-mark application No. 1,273,765 on September 28, 2005 which was later amended on April 9, 2009. The application covers a broad range of chemical products as well as cable television broadcasting and cellular communications services. The application was advertised for opposition purposes pursuant to the Act on February 20, 2008. On March 27, 2008, the respondent filed a statement of opposition (which was forwarded to the Registrar on April 21, 2008) opposing the registration of the application. On June 15, 2010, the applicant filed a counter statement denying all grounds of opposition. Both parties filed evidence before the Board and the evidence was subject to cross-examination. The applicant filed evidence from Lynda Palmer (Trade-mark Searcher) and D. Jill Roberts (Assistant Bailiff with Cease Bailiff Services Inc.). The respondent filed evidence from Jennifer Stecyk (Trade-mark Searcher with Osler, Hoskin & Harcourt LLP) and Greg Clark (Vice-President – Marketing of Safety-Kleen) (two (2) affidavits for Mr. Clark: February 11, 2009 and October 23, 2009)

#### Registrar's decision

[9] The Registrar rendered a split decision, dated December 3, 2012. The Registrar rejected the opposition and accepted the application in association with non-overlapping wares – i.e. all the services covered in the application and with a number of wares included in the statement of wares.

The application was refused in association with overlapping and undefined wares. The Registrar based his conclusion on the fact that the overlapping and undefined wares of the applicant are very similar in nature to those of the respondent and the parties' trade-marks are identical phonetically.

[10] The use of different design portion was not sufficient for the Registrar to negate any likelihood of confusion between the applicant's applied-for mark and the respondent's trade-mark in so far as the "overlapping wares" are concerned. The lack of information on the "undefined wares" lead the Registrar to conclude as well, for those same reasons, that the applicant did not discharge its legal onus to prove that there is no likelihood of confusion.

[11] The Registrar recalled that (i) the respondent (opponent) bears an initial evidential burden to adduce sufficient admissible evidence to support the facts alleged in support of each ground of opposition and (ii) the applicant then bears the legal onus of establishing, on a balance of probabilities, that the application complies with the requirements of the Act and the particular grounds of opposition should not prevent registration of the mark.

[12] The Registrar checked the Register for the respondent's two (2) trade-marks and confirmed that the registrations are in existence. Thus, the Registrar concluded that the respondent met its initial burden. The material date for establishing registrability/confusion under s 38(2)(b)/12(1)(d) is the Registrar's decision date (December 3, 2012).

[13] The Registrar stated that, in applying the test for confusion outlined in s 6(2) of the Act, all surrounding circumstances, including those specifically enumerated in s 6(5) of the Act and

mentioned that these factors need not be attributed equal weight (*Clorox Co. v Sears Canada Inc.* (FCTD), [1992] 2 FC 579, 41 CPR (3<sup>d</sup>) 483 (FCTD) and also *Gainers Inc. v Marchildon* (FCTD), [1996] FCJ No 297 (QL), 66 CPR (3<sup>d</sup>) 308).

[14] The Registrar referred as well to the decision of the Supreme Court of Canada in *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, [2006] 1 SCR 824, and *Mattel, Inc v 3894207 Canada Inc.*, [2006] 1 SCR 772 where Justice Binnie provided direction on the assessment of the criteria enumerated under s 6(5) in order to determine if there is a likelihood of confusion between two (2) trade-marks.

*Inherent distinctiveness of the trade-marks and extent to which they have become known*

[15] The Registrar found that both the applicant's and the respondent's trade-marks have some degree of distinctiveness because of their respective design portion and that no mark is stronger than the other. The Registrar provided a brief summary of the evidence of Mr. Clark and concluded that the evidence presented shows that there is use of the respondent's trade-mark since at least 2007 and no use of the applicant's trade-mark. As such, the Registrar concluded that this first criterion favors the respondent.

*Length of time in use*

[16] The Registrar found that, based on the evidence, the respondent's mark has been in use for much longer.

*Nature of the wares, services or business / Nature of the trade*

[17] The Registrar found that there was no overlap between the applicant's services and the respondent's wares.

[18] However, there was an overlap between some of the applicant's wares and the respondent's wares. The overlapping wares are as follows:

antifreeze solution, brake solution, catalysts for treating engine exhaust, fluids for hydraulic circuits, power steering fluid, refrigerants and solvent, transmission fluid (the "overlapping wares").

[19] There were also some wares that the Registrar did not understand as he believed they were described in technical or chemical terms and no evidence of their meaning was provided by the applicant. These were considered as well to be overlapping:

diethyl malonate, disopropyl malonate, diketene, dimethyl malonate, dimethyl terephthalate, dimethyl formamide, dimethylamine, epichlorohydrine, ethoxylate, ethylene, ethylene amines, ethylene glycol, ethylene oxide, ethylene vinyl acetate, fatty amine, formic acid, fumed silica, furfuryl alcohol, hypochlorite of soda, isopropyl alcohol, methyl chloride, methyl metal acrylate, methylamine derivatives, methylene chloride, neopentyl glycol, photoresist, polycrystalline silicone, polyethylene terephthalate, polymethylmeta acrylate, polypropylene, polypropylene resins, polytetrafluoro ethylene, polyvinyl butyral film, polyvinyl chloride, potassium sorbate, propylene, purified terephthalic acids, sodium carboxymethyl cellulose styrene monomer, terephthalic acids, tetramethyl ammonium chloride, tetramethyl ammonium hydroxide, toluene, trimethylamine hydrochloric acid (the "undefined wares").

[20] The remaining wares were considered by the Registrar to be non-overlapping wares:

ammonia, anti-corrosive contact spray, chemicals used in industry, namely: caustic soda for industrial purposes; chemical preparations for the manufacture of paints; fertilizer, fire extinguishing compositions for fighting fires; melamine, microorganism cultures

for use in industry, science, agriculture, horticulture and forestry, plasticizer, polyester, polyethylene, polyethylene resins, semi-processed synthetic resins, silicones, surface-active chemical agents, synthetic resins, unprocessed acrylic resins, unprocessed artificial resins, unprocessed epoxy resins, unprocessed plastics, unprocessed synthetic resins, urea, urethane resins, UV chemical stabilizer, vulcanization accelerators, water treatment compositions for human use to inhibit scaling, phosphate formation and corrosion (the “non-overlapping wares”)

*Degree of resemblance*

[21] The Registrar referred to the Supreme Court of Canada’s decision in *Masterpiece Inc. v Alavida Lifestyles Inc.*, 2011 SCC 27, [2011] 2 SCR 387 [*Masterpiece*] where the Court decided that the most important factor among those listed under s 6(5) of the Act is often the degree of resemblance between the two (2) marks.

[22] The Registrar found that the respondent’s trade-mark and the applicant’s applied-for mark are identical phonetically but there is no resemblance between them.

[23] The Registrar analysed as well the additional surrounding circumstances regarding the state of the Register and the coexistence of the parties’ trade-marks in the United States.

*Other grounds of opposition*

[24] The material date for establishing entitlement/confusion under s 38(2)(c)/16(3)(a), 16(3)(b), 16(3)(c) is the application date (September 28, 2005). The Registrar mentioned that the respondent (opponent) has the initial burden to prove that it has used or made known its trade-marks SK and SK Logo in Canada prior to the filing of the application by the applicant. The respondent (opponent) admits that the trade-marks have not been used in Canada in association with some overlapping

wares (power steering, transmission fluids and motor oil). As such, the Registrar concluded that the overlapping wares for which the SK trade-marks were not used will be excluded from the basket of wares for the entitlement analysis. This, the Registrar found, would lead to a less favourable analysis than the registrability analysis, discussed earlier. This ground of opposition was thus not analysed by the Registrar.

[25] The material date for establishing distinctiveness under s 38(2)(d) is the filing date for the statement of opposition (March 27, 2008). The Registrar mentioned that the respondent (opponent) has the initial burden to prove that the SK trade-marks have become sufficiently known in Canada on March 27, 2008 so to negate the distinctiveness of the mark. Again, as concluded by the Registrar in the entitlement ground of opposition, there has been no use of the respondent's (opponent's) trade-marks in Canada in association with some overlapping wares (power steering, transmission fluids and motor oil). This ground of opposition was not analysed in details for the same reasons as in the ground of entitlement.

#### The appeal

[26] On February 11, 2013, the applicant filed a Notice of Application for an appeal of the Registrar's decision requesting that the decision of the Registrar regarding the overlapping and undefined wares be set aside.

#### Evidence filed in support of the appeal

[27] The applicant filed four (4) additional affidavits of D. Jill Roberts and an affidavit of Janice Kelland and submits that this additional evidence was provided to address issues raised by the



Registrar. The applicant argues that this additional evidence provides facts which, had they been before the Registrar, would have required further consideration and possibly altered the decision.

[28] The respondent did not file any additional affidavits but cross-examined both Ms. Roberts and Ms. Kelland.

#### Issues

[29] This case raises the following issues:

1. What is the standard of review?
2. Would the additional evidence filed in this Court have materially affected the Registrar's findings?
3. Was the Registrar's decision reasonable?

#### ***1. What is the standard of review?***

[30] The parties are in agreement that, in the absence of additional evidence produced on appeal under s 56 of the Act, the reasonableness standard of review applies. They also agree that, when new evidence is submitted, it is necessary to assess its significance. If the additional evidence would materially affect the Registrar's findings of fact or the exercise of its discretion, then the correctness standard of review applies and the application would be considered *de novo*. The Court recalls the observations of Justice Rothstein JA (as he then was) for the majority at paragraph 51 in *Molson Breweries v John Labatt Ltd (C.A.)*, [2000] 3 FC 145, 252 NR 91, regarding the standard of review:

[51] I think the approach in *Benson & Hedges* and in *McDonald's Corp* are consistent with the modern approach to standard of review. Even though there is an express appeal provision in the Trade-marks Act to the Federal Court, expertise on the part of the Registrar has been recognized as requiring some deference. Having regard to the Registrar's expertise, in the absence of additional evidence adduced

in the Trial Division, I am of the opinion that decisions of the Registrar, whether of fact, law or discretion, within his area of expertise, are to be reviewed on a standard of reasonableness simpliciter. However, where additional evidence is adduced in the Trial Division that would have materially affected the Registrar's findings of fact or the exercise of his discretion, the Trial Division judge must come to his or her own conclusion as to the correctness of the Registrar's decision.

[Emphasis added]

[31] Therefore, the first issue that the Court will consider is whether the additional evidence filed by the applicant “would have materially affected the Registrar’s findings of fact or the exercise of his discretion”.

***2. Would the additional evidence filed in this Court have materially affected the Registrar’s findings?***

[32] The applicant filed additional evidence and alleges that, had this information been provided to the Registrar at the hearing, its decision would have been materially different. The applicant therefore submits that the standard of review should be that of correctness as per the Supreme Court of Canada decision in *Dunsmuir v New-Brunswick*, 2008 SCC 9 at para 47, [2008] 1 SCR 190 [*Dunsmuir*].

[33] The Court recalls that the test for considering additional evidence is one of quality not of quantity. Upon reading the affidavits submitted by the applicant, the Court finds the following:

- Ms. Roberts’ affidavit # 1(March 15, 2013) is based on a reading of a website and does not contain new evidence;
- Ms. Roberts’ affidavit # 2(March 18, 2013) introduces updated results of a state of the Register search which was before the Registrar. The respondent’s SK Logo

remains the closest visually, phonetically and in idea to the applied-for mark. The Court does not find that this is new information;

- In her affidavit # 3 (March 21, 2013), Ms. Roberts provides information from the websites display the names of various entities such as SK Energy, SK Global Chemical, SK Global Chemical Co., and SK Lubricants but there is no explanation as to why this evidence should be regarded as relevant. The presentation document found on the internet cannot be afforded much weight. More importantly, there is no evidence provided on the use of the trade-mark SK & Design by the applicant in association with any of the wares or services covered by the application;
- Although Ms. Roberts's affidavit #4 (March 22, 2013) provides definition of the chemicals listed under the "undefined wares" from chemical dictionaries, internet sources and encyclopaedias, it is not exhaustive and fails to provide clarity and understanding with respect to the undefined wares. The ambiguity remains;
- Ms. Kelland's affidavit (March 22, 2013) does not remove the ambiguity surrounding the use of the undefined wares and there remains an issue as to whether she can qualify as a fact witness as opposed to an expert witness.

[34] Upon reading the applicant's additional affidavits, this Court is of the opinion that the new evidence adduced by the applicant is not sufficiently significant or reliable in light of the whole of the evidence. Accordingly, it would not have materially affected the Registrar's decision (*Bojangles' International, LLC et al v Bojangles Café Ltd.*, 2006 FC 657 at para 15, 48 CPR (4<sup>th</sup>) 427; see also *Wrangler Apparel Corp v The Timberland Co.*, 2005 FC 722 at paras 7 & 9, 41 CPR (4<sup>th</sup>) 223). The standard of review is therefore that of reasonableness.

### 3) *Was the Registrar's decision reasonable?*

[35] From the outset, it is important to keep in mind the role of a trade-mark in the marketplace in undertaking a review of the Registrar's decision:

[1] Trade-marks in Canada are an important tool to assist consumers and businesses. In the marketplace, a business marks its wares or services as an indication of provenance. This allows consumers to know, when they are considering a purchase, who stands behind those goods or services. In this way, trade-marks provide a "shortcut to get consumers to where they want to go", per Binnie J. in *Mattel, Inc. v. 3894207 Canada Inc.*, 2006 SCC 22, [2006] 1 S.C.R. 772, at para. 21. Where the trade-marks of different businesses are similar, a consumer may be unable to discern which company stands behind the wares or services. Confusion between trade-marks impairs the objective of providing consumers with a reliable indication of the expected source of wares or services. ...

[*Masterpiece*, above at para 1]

[36] Where a reasonableness standard is to be applied, the question is whether the decision can withstand "a somewhat probing" examination and is not "clearly wrong" (*Mattel*, above at 341).

[37] The Court's role when reviewing a decision under the reasonableness standard is described in *Dunsmuir*, above at para 47, as follows:

[47] Reasonableness is a deferential standard animated by the principle that underlies the development of the two previous standards of reasonableness: certain questions that come before administrative tribunals do not lend themselves to one specific, particular result. Instead, they may give rise to a number of possible, reasonable conclusions. Tribunals have a margin of appreciation within the range of acceptable and rational solutions. A court conducting a review for reasonableness inquires into the qualities that make a decision reasonable, referring both to the process of articulating the reasons and to outcomes. In judicial review, reasonableness is concerned mostly with the existence of justification, transparency and intelligibility within the decision-making process. But it is also concerned with whether the decision falls within a range of possible, acceptable outcomes which are defensible in respect of the facts and law.

[38] In the case at bar, the Court recalls that the Registrar dealt with the following wares: non-overlapping, overlapping and, undefined. It was reasonable for the Registrar to find that, with respect to the undefined wares, he was left in a state of doubt as to the likelihood of confusion which he resolved against the applicant and refused the application for the undefined wares. The Registrar thus drew a negative inference and assumed that there was overlap in the nature of the undefined wares.

[39] Before this Court, the parties' arguments focused on the issue of confusion. Both parties agree that there is no resemblance between the applicant's mark and that of the respondent. They also agree that the length of time in use (paragraph 6(5)(b) of the Act) is a factor favouring the respondent, as the respondent had used its trade-mark in Canada prior to the date of application.

[40] A closer look at the applicant's mark and the respondent's mark indicates that, other than the letters S and K, – which would constitute weak marks – , there is no visual similarity between the applicant's applied-for SK mark and the respondent's SK trade-mark.

[41] However, although both marks do not look alike they are identical phonetically: "SK". This important aspect was outlined by the Registrar in his decision at para 36 and 37:

[36] In its judgment in *Masterpiece Inc. v Alavida Lifestyles Inc et al* 2011 SCC 27, the Supreme Court of Canada has clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks.

[37] The Mark and the SK Logo trade-mark are identical phonetically. However they do not look alike. The Opponent dominant feature of its SK Logo trade-mark is the letter S while there is no dominant feature in the Mark. The Mark is comprised of two equal features namely the letters "SK" and a butterfly design.

[42] The Registrar therefore found that “the use of a different design portion is not sufficient to negate any likelihood of confusion between the Mark [applicant’s mark] and the Opponent’s trade-mark SK Logo [respondent’s mark] in so far as the Overlapping wares are concerned” (Registrar’s decision at para 47).

[43] The applicant submits that oral similarities should not overcome differences with respect to overlapping and undefined wares and the Registrar erred in finding otherwise. The Court cannot agree.

[44] The applicant argued that overlapping wares – with a strong emphasis on solvents – belong to a different industry, a different channel of trade, they are allegedly only used by sophisticated professional users in the performance of services; they are not bought at a store but only online and through a service call. Therefore, the applicant submits that this makes those solvents different from the respondent’s and as such non-overlapping. Again, the Court finds that there is no evidence to support these allegations. What is clear is that solvents are also overlapping wares and that the nature of the applicant’s business remains undefined. Hence, the phonetic aspect is important given the issue of overlapping wares in the present case. It was thus reasonable for the Registrar to find that there would be likelihood of confusion regarding the overlapping wares because the marks are identical phonetically – i.e. “SK”. The argument that the respective products of the parties are directed to sophisticated business clients is not supported by evidence. The Court cannot find that the products of the parties are necessarily always purchased by a sophisticated agent holding a PhD in chemistry.

[45] The applicant also submitted that when one calls the respondent's outlets in Canada, the phone is answered "Safety-Kleen" and not "SK". The consequence, for the applicant, is that it completely dissipates the confusion of oral similarities. The Court recalls that the applicant's argument relying on a survey has to be considered with caution (*Masterpiece*, above at para 93). In the case at bar, and on the basis of the evidence, the Court is not satisfied that the survey relied upon by the applicant is both reliable and valid (*R v Mohan*, [1994] 2 SCR 9 at para 45). As such, it carries little probative value.

[46] It was also submitted to the Court that a number of registered trade-marks which include the letters SK covering wares and services overlap with those covered in the respondent's registered trade-marks. However, the state of the Trade-mark Register demonstrates that other SK marks either have other letters in them as part of an acronym or do not relate to the wares at issue (e.g. SK & DESIGN; SKF & DESIGN; SKW BIOSYSTEMS DESIGN; SK8 and DESIGN – Applicant's record, vol. 7. p 1644-45).

[47] Finally, the applicant submits that the trade-marks of both parties in the United States have coexisted on the Register for a number of years. The applicant further argues that recent jurisprudence has held that long standing co-existence on the U.S. Register can be considered in addressing the issue of the likelihood of confusion in Canada. Evidence of a long standing co-existence on the U.S. Register (e.g. 13 years) has been found to favour a finding of non-confusion between the trade-marks (*McCallum Industries Ltd v HJ Heinz Co. Australia Ltd.*, 2011 FC 1216, 97 CPR (4<sup>th</sup>) 283). However, in the case at bar, there is no evidence regarding the context

surrounding the actual co-existence of both marks in the United States which, in turn, could support a comparison with the present case.

[48] For all of these reasons, the Court is satisfied that the Registrar considered all relevant factors and came to a reasonable conclusion (*Dunsmuir*, above; *Newfoundland and Labrador Nurses' Union v Newfoundland and Labrador (Treasury Board)*, 2011 SCC 62, [2011] 3 SCR 708).



**JUDGMENT**

**THIS COURT’S JUDGMENT is that**

1. The appeal is dismissed;
2. With costs.

“Richard Boivin”

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Judge

**RELEVANT LEGISLATION**

*Trade-marks Act, RSC, 1985, c T-13*

INTERPRETATION	DÉFINITIONS ET INTERPRÉTATION
Definitions	Définitions
2. In this Act,	2. Les définitions qui suivent s'appliquent à la présente loi.
...	[...]
“distinctive” « <i>distinctive</i> » “distinctive”, in relation to a trade-mark, means a trade-mark that actually distinguishes the wares or services in association with which it is used by its owner from the wares or services of others or is adapted so to distinguish them;	« distinctive » “ <i>distinctive</i> ” « distinctive » Relativement à une marque de commerce, celle qui distingue véritablement les marchandises ou services en liaison avec lesquels elle est employée par son propriétaire, des marchandises ou services d'autres propriétaires, ou qui est adaptée à les distinguer ainsi.
...	[...]
When mark or name confusing	Quand une marque ou un nom crée de la confusion
6. (1) For the purposes of this Act, a trademark or trade-name is confusing with another trade-mark or trade-name if the use of the first mentioned trade-mark or trade-name would cause confusion with the last mentioned trade-mark or trade-name in the manner and circumstances described in this section.	6. (1) Pour l'application de la présente loi, une marque de commerce ou un nom commercial crée de la confusion avec une autre marque de commerce ou un autre nom commercial si l'emploi de la marque de commerce ou du nom commercial en premier lieu mentionnés cause de la confusion avec la marque de commerce ou le nom commercial en dernier lieu mentionnés, de la manière et dans les circonstances décrites au présent article.
Idem	Idem
(2) The use of a trade-mark causes	(2) L'emploi d'une marque de

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.

...

#### What to be considered

(5) In determining whether trade-marks or trade-names are confusing, the court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including

(a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;

(b) the length of time the trade-marks or trade-names have 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 or trade-names in appearance or sound or in the ideas suggested by them.

commerce crée de la confusion avec une autre marque de commerce lorsque l'emploi des deux marques de commerce dans la même région serait susceptible de faire conclure que les marchandises liées à ces marques de commerce sont fabriquées, vendues, données à bail ou louées, ou que les services liés à ces marques sont loués ou exécutés, par la même personne, que ces marchandises ou ces services soient ou non de la même catégorie générale.

[...]

#### Éléments d'appréciation

(5) En décidant si des marques de commerce ou des noms commerciaux créent de la confusion, le tribunal ou le registraire, selon le cas, tient compte de toutes les circonstances de l'espèce, y compris :

a) le caractère distinctif inhérent des marques de commerce ou noms commerciaux, et la mesure dans laquelle ils sont devenus connus;

b) la période pendant laquelle les marques de commerce ou noms commerciaux ont été en usage;

c) le genre de marchandises, services ou entreprises;

d) la nature du commerce;

e) le degré de ressemblance entre les marques de commerce ou les noms commerciaux dans la présentation ou le son, ou dans les idées qu'ils suggèrent.

REGISTRABLE TRADE-MARKS

MARQUES DE COMMERCE  
ENREGISTRABLES

When trade-mark registrable

Marque de commerce enregistrable

**12.** (1) Subject to section 13, a trade-mark is registrable if it is not

**12.** (1) Sous réserve de l'article 13, une marque de commerce est enregistrable sauf dans l'un ou l'autre des cas suivants :

...

[...]

(d) confusing with a registered trade-mark;

d) elle crée de la confusion avec une marque de commerce déposée;

...

[...]

PERSONS ENTITLED TO  
REGISTRATION OF TRADE-MARKS

PERSONNES ADMISES À  
L'ENREGISTREMENT DES  
MARQUES DE COMMERCE

...

[...]

Proposed marks

Marques projetées

**16.** (3) Any applicant who has filed an application in accordance with section 30 for registration of a proposed trade-mark that is registrable is entitled, subject to sections 38 and 40, to secure its registration in respect of the wares or services specified in the application, unless at the date of filing of the application it was confusing with

**16.** (3) Tout requérant qui a produit une demande selon l'article 30 en vue de l'enregistrement d'une marque de commerce projetée et enregistrable, a droit, sous réserve des articles 38 et 40, d'en obtenir l'enregistrement à l'égard des marchandises ou services spécifiés dans la demande, à moins que, à la date de production de la demande, elle n'ait créé de la confusion :

(a) a trade-mark that had been previously used in Canada or made known in Canada by any other person;

a) soit avec une marque de commerce antérieurement employée ou révélée au Canada par une autre personne;

(b) a trade-mark in respect of which an application for registration had been previously filed in Canada by any other person; or

b) soit avec une marque de commerce à l'égard de laquelle une demande d'enregistrement a été antérieurement produite au Canada par une autre personne;

(c) a trade-name that had been previously used in Canada by any other person.

<p>...</p> <p>Previous use or making known</p> <p><b>16.</b> (5) The right of an applicant to secure registration of a registrable trade-mark is not affected by the previous use or making known of a confusing trade-mark or trade-name by another person, if the confusing trade-mark or trade-name was abandoned at the date of advertisement of the applicant's application in accordance with section 37.</p>	<p>(c) soit avec un nom commercial antérieurement employé au Canada par une autre personne. [...]</p> <p>Emploi ou révélation antérieur</p> <p><b>16.</b> (5) Le droit, pour un requérant, d'obtenir l'enregistrement d'une marque de commerce enregistrable n'est pas atteint par l'emploi antérieur ou la révélation antérieure d'une marque de commerce ou d'un nom commercial créant de la confusion, par une autre personne, si cette marque de commerce ou ce nom commercial créant de la confusion a été abandonné à la date de l'annonce de la demande du requérant selon l'article 37.</p>
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APPLICATIONS FOR  
REGISTRATION OF TRADE-MARKS

DEMANDES D'ENREGISTREMENT  
DE MARQUES DE COMMERCE

<p>Contents of application</p> <p><b>30.</b> An applicant for the registration of a trade-mark shall file with the Registrar an application containing</p> <p>...</p> <p>(e) in the case of a proposed trade-mark, a statement that the applicant, by itself or through a licensee, or by itself and through a licensee, intends to use the trade-mark in Canada;</p> <p>...</p> <p>Statement of opposition</p> <p><b>38.</b> (1)</p> <p>...</p>	<p>Contenu d'une demande</p> <p><b>30.</b> Quiconque sollicite l'enregistrement d'une marque de commerce produit au bureau du registraire une demande renfermant :</p> <p>[...]</p> <p>e) dans le cas d'une marque de commerce projetée, une déclaration portant que le requérant a l'intention de l'employer, au Canada, lui-même ou par l'entremise d'un licencié, ou lui-même et par l'entremise d'un licencié; [...]</p> <p>Déclaration d'opposition</p> <p><b>38.</b> (1)</p> <p>[...]</p>
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## Grounds

(2) A statement of opposition may be based on any of the following grounds:

(a) that the application does not conform to the requirements of section 30;

(b) that the trade-mark is not registrable;

(c) that the applicant is not the person entitled to registration of the trade-mark; or

(d) that the trade-mark is not distinctive.

...

## Decision

(8) After considering the evidence and representations of the opponent and the applicant, the Registrar shall refuse the application or reject the opposition and notify the parties of the decision and the reasons for the decision.

## LEGAL PROCEEDINGS

...

## Appeal

**56.** (1) An appeal lies to the Federal Court from any decision of the Registrar under this Act within two months from the date on which notice of the decision was dispatched by the Registrar or within such further time as the Court may allow, either before or after the expiration of the two months.

## Motifs

(2) Cette opposition peut être fondée sur l'un des motifs suivants :

a) la demande ne satisfait pas aux exigences de l'article 30;

b) la marque de commerce n'est pas enregistrable;

c) le requérant n'est pas la personne ayant droit à l'enregistrement;

d) la marque de commerce n'est pas distinctive.

[...]

## Décision

(8) Après avoir examiné la preuve et les observations des parties, le registraire repousse la demande ou rejette l'opposition et notifie aux parties sa décision ainsi que ses motifs.

## PROCÉDURES JUDICIAIRES

[...]

## Appel

**56.** (1) Appel de toute décision rendue par le registraire, sous le régime de la présente loi, peut être interjeté à la Cour fédérale dans les deux mois qui suivent la date où le registraire a expédié l'avis de la décision ou dans tel délai supplémentaire accordé par le tribunal, soit avant, soit après l'expiration des deux mois.

Procedure

(2) An appeal under subsection (1) shall be made by way of notice of appeal filed with the Registrar and in the Federal Court.

Notice to owner

(3) The appellant shall, within the time limited or allowed by subsection (1), send a copy of the notice by registered mail to the registered owner of any trade-mark that has been referred to by the Registrar in the decision complained of and to every other person who was entitled to notice of the decision.

Public notice

(4) Federal Court may direct that public notice of the hearing of an appeal under subsection (1) and of the matters at issue therein be given in such manner as it deems proper.

Additional evidence

(5) On an appeal under subsection (1), evidence in addition to that adduced before the Registrar may be adduced and the Federal Court may exercise any discretion vested in the Registrar.

Procédure

(2) L'appel est interjeté au moyen d'un avis d'appel produit au bureau du registraire et à la Cour fédérale.

Avis au propriétaire

(3) L'appelant envoie, dans le délai établi ou accordé par le paragraphe (1), par courrier recommandé, une copie de l'avis au propriétaire inscrit de toute marque de commerce que le registraire a mentionnée dans la décision sur laquelle porte la plainte et à toute autre personne qui avait droit à un avis de cette décision.

Avis public

(4) Le tribunal peut ordonner qu'un avis public de l'audition de l'appel et des matières en litige dans cet appel soit donné de la manière qu'il juge opportune.

Preuve additionnelle

(5) Lors de l'appel, il peut être apporté une preuve en plus de celle qui a été fournie devant le registraire, et le tribunal peut exercer toute discrétion dont le registraire est investi.

GENERAL

DISPOSITIONS GÉNÉRALES

Registrar

Registraire

**63.** (1)

**63.** (1)

...

[...]

Assistants

Adjoints

(3) The Registrar may, after consultation with the Minister, delegate to any person he deems qualified any of his powers, duties and functions under this Act, except the power to delegate under this subsection.

...

(3) Le registraire peut, après consultation avec le ministre, déléguer à toute personne qu'il estime compétente les pouvoirs et fonctions que lui confère la présente loi, sauf le pouvoir de déléguer prévu au présent paragraphe.

[...]



**APPENDIX A**

SK Corporation's Application No. 1,273,765

**WARES:**

(1) Ammonia, anti-corrosive contact spray, antifreeze solution, phenolic antioxidants, brake solution, butadiene, chemicals used in industry, namely: catalysts for treating engine exhaust, caustic soda for industrial purposes, chemical preparations for the manufacture of paints, diethyl malonate, diisopropyl malonate, diketene, dimethyl malonate, dimethyl terephthalate, dimethyl formamide, dimethylamine, epichlorohydrin, ethoxylate, ethylene, ethylene amines, ethylene glycol, ethylene oxide, ethylene vinyl acetate, fatty amine, fertilizer, fire extinguishing compositions for fighting fires, fluids for hydraulic circuits, formic acid, fumed silica, furfuryl alcohol, hypochlorite of soda, isopropyl alcohol, melamine, methyl chloride, methyl metal acrylate, methylamine derivatives, methylene chloride, microorganism cultures for use in industry, science, agriculture, horticulture and forestry, neopentyl glycol, photoresist, plasticizer, polycrystalline silicone, polyester, polyethylene, polyethylene resins, polyethylene terephthalate, polymethylmeta acrylate, polypropylene, polypropylene resins, polytetrafluoro ethylene, polyvinyl butyral film, polyvinyl chloride, potassium sorbate, power steering fluid, propylene, purified terephthalic acids, refrigerants, semi-processed synthetic resins, silicones, sodium carboxymethyl cellulose styrene monomer, solvent, surface-active chemical agents, synthetic resins, terephthalic acids, tetramethyl ammonium chloride, tetramethyl ammonium hydroxide, toluene, transmission fluid, trimethylamine hydrochloric acid, unprocessed acrylic resins, unprocessed artificial resins, unprocessed epoxy resins, unprocessed plastics, unprocessed synthetic resins, urea, urethane resins, UV chemical stabilizer, vulcanization accelerators, water treatment compositions for human use to inhibit scaling, phosphate formation and corrosion.

**SERVICES:**

(1) Cable television broadcasting; cellular telephone services; text messaging, voice and video communication services by computer; communication by facsimile; text messaging, voice and video communication services by satellite; communication by telegram; electronic mail services; news agencies; radio broadcasting; text messaging, voice and video communication services by radio; radio telephone paging services; rental of broadcasting equipment; television and radio broadcasting services by satellite; text messaging, voice and video communication services by telephone; television broadcasting; video conferencing services.

## APPENDIX B



Safety-Kleen's Registration No. 517, 866

### **WARES:**

(1) Mechanical parts washers, including washers for cleaning components of automobiles, aircraft, industrial and agricultural machines and parts thereof used in manufacturing, service and repair facilities, and brushes, filters and replacement parts for such parts washers; cleaning and degreasing solvents for parts washing machines used in service, maintenance and repair and manufacturing, and cleaning emulsions and solvents used in immersion type cleaners for cleaning carburetors and other automotive, marine and agricultural vehicle parts.

(2) Automotive fluids and motor oil, including automotive oils, heavy duty motor oil, non-detergent motor oil, motor oil for severe service, diesel truck motor oil, tractor motor oil, high performance motor oil, two cycle motor oil, and refined motor oil; multi-purpose gear oil, snowmobile oil, red chain oil, transmission fluid, multi-purpose grease, hydraulic oil, oil for hydraulic jacks, power steering fluid, undercoating oil for prevention of rust corrosion, automatic transmission fluids, industrial oils and universal tractor fluids; anti-freeze, ethylene glycol, anti-freeze windshield washer liquid.

(3) Refined motor oil.

### **SERVICES:**

(1) Cleaning and recycling services, namely, the leasing of mechanical parts washers used in service, maintenance, repair and manufacturing facilities, providing solvent for such washers, periodically collecting, cleaning and replacing such solvent and the maintenance of such mechanical parts washers



Safety-Kleen's Registration No. 516,956

**WARES:**

(1) Mechanical parts washers, including washers for cleaning components of automobiles, aircraft, industrial and agricultural machines and parts thereof used in manufacturing, service and repair facilities, and brushes, filters and replacement parts for such parts washers.

(2) Cleaning and degreasing solvents for parts washing machines used in service, maintenance and repair and manufacturing, and cleaning emulsions and solvents used in immersion type cleaners for cleaning carburetors and other automotive, marine and agricultural vehicle parts.

(3) Automotive fluids and motor oil, including automotive oils, heavy duty motor oil, non-detergent motor oil, motor oil for severe service, diesel truck motor oil, tractor motor oil, high performance motor oil, two cycle motor oil, and re-refined motor oil; multi-purpose gear oil, snowmobile oil, red chain oil, transmission fluid, multi-purpose grease, hydraulic oil, oil for hydraulic jacks, power steering fluid, undercoating oil for prevention of rust corrosion, automatic transmission fluids, industrial oils and universal tractor fluids; anti-freeze, ethylene glycol, anti-freeze windshield wash liquid.

(4) Refined motor oil.

**SERVICES:**

(1) Cleaning and recycling services, namely, the leasing of mechanical parts washers, used in service, maintenance, repair and manufacturing facilities, providing solvent for such apparatus, periodically collecting, cleaning and replacing such solvent and the maintenance of such mechanical parts washers.

## APPENDIX C

A summary of the Kelland and Roberts' affidavits in relation to the use of the chemicals in the "undefined wares".

### KELLAND AFFIDAVIT

<b>PRODUCT</b>	<b>USE</b>
Ethyl malonate/Diethyl malonate (para 12)	Manufacture of barbiturates Reagents in the synthesis of organic compounds
Diketene (para 13)	Production of pigments, toners, pesticides, food preservatives and pharmaceutical intermediates Reagent in organic synthesis
Dimethyl terephthalate/Terephthalic acid (para 14)	Production of polyesters, including polyethylene terephthalate Used to make plastic films and sheets Used in analytical chemistry
Dimethyl formamide (para 15)	Solvent in the synthesis of organic compounds Reagent in synthetic organic reactions
Dimethylamine (para 16)	Accelerator in vulcanizing rubber, tanning, manufacture of detergent soaps and as an exterminating agent Organic base and reagent in organic chemistry
Epichlorohydrin (para 17)	Solvent for natural and synthetic resins, gums, cellulose esters and ethers, paints, varnishes, nail enamels and lacquers Cement for celluloid Production of glycerol and epoxy resins Reagent in organic chemistry
Polyoxyethylene alcohols (ethoxylated fatty alcohols) (para 18)	Non-ionic surfactant, emulsifier, wetting agent, antistat, solubilizer, defoamer, detergent, and lubricant in industrial applications

Ethylene (para 19)	Fuel for welding and cutting metals, and as a reagent in the manufacture of alcohol, mustard gas and other organic compounds Manufacture of plastics such as polyethylene, and the accelerate ripening of fruits
Ethyleneamines (para 20)	Variety of uses including as additives for lubricants, fuels, asphalts and pulp and paper, epoxy curing agents, bleach activators, chelating agents, surfactants, emulsifiers, dewormers, fabric softeners, fungicides, and polymers
Ethylene glycol (para 21)	Antifreeze in cooling and heating systems Ingredient in brake fluids and electrolytic condensers Solvent in the paint and plastics industries and in the formulation of inks Reagent in organic synthesis
Ethylene oxide (para 21)	Fumigant for foodstuffs and textiles, to sterilize surgical instruments, as an agricultural fungicide Reagent in organic synthesis
Ethylene vinyl acetate (para 22)	Hot melt adhesives, drug delivery devices, expanded foam rubber for use as padding in sports footwear and equipment and for applications where light weight or buoyancy is important
Fatty amine (para 23)	Soaps, plasticizers, tire cords, fabric softeners, water-resistant asphalt, hair conditioners, cosmetics and medicinals
Formic acid (para 24)	Silage additive, prophylactic in the treatment of animal feeds, acidulant in the dyeing of natural and synthetic fibers and leather tanning, in rubber production, and in chemical synthesis Organic acid
Fumed silica (para 25)	Thickener. Reinforcing agent in inks, resins, rubber, paints and cosmetics

	Used in high temperature mortars
Furfuryl alcohol (para 26)	Solvent Manufacture of wetting agents and resins
Sodium hypochlorite (hypochlorite of soda) (para 27)	Bleach and disinfectant
Isopropyl alcohol	Ingredient in antifreeze compositions, solvents in quick drying inks and oils, hand lotions, body rubs, and other cosmetics Antiseptic
Methyl chloride (para 29)	Refrigerant Local anesthetic Reagent in organic synthesis
Methyl methacrylate (methacrylic acid) (para 30)	Manufacture of methacrylate resins and plastics, and polymerizes to form a clear plastic known as Lucite <sup>TM</sup> or Plexiglas <sup>TM</sup> .
Poly(methyl methacrylate) (para 30)	Alternative to glass, used in daylight redirection Used in eye surgery as intraocular lenses for the treatment of cataracts, in orthopedics as a component of bone cement, and in dentures and in dental filling material
Methylamine (para 31)	Tanning Organic bases and reagent for organic synthesis
Methylene chloride (para 32)	Solvent in paint removers and for cellulose acetate Degreasing and cleaning fluids, solvent in food processing, aerosol propellant and insecticide Solvent for organic chemicals and reactions
Neopentyl glycol (para 33)	Manufacture of plasticizers, polyesters and as a modifier of alkyd resins
Photoresist (para 34)	Light sensitive material used in several industrial processes such as photolithography and photo engraving. Fabrication of printed circuit boards, sand

	carving and microelectronics
Polycrystalline silicon (para 35)	Electronics and solar cells
Polyethylene terephthalates (para 36)	Fabric manufacturing, as films, as base for magnetic coatings and in surgical arterial grafts
Propylene (para 37)	Chemical intermediate in the manufacture of other chemicals, and in polymerized form for plastics and carpet fibers
Polypropylene (para 37)	Fishing gears, ropes, filter cloths, laundry bags, protective clothing, blankets, fabrics and yarns
Polypropylene resin (para 37)	Manufacture of various plastic products for consumer and industrial use
Polytetrafluorethylene (para 37)	Tubing and sheets for chemical lab and process work, for lining reaction vessels, for gasket and pump packing Electronic insulator, filtration fabrics, protective clothing and prosthetics. Non-stick coatings for cookware
Polyvinyl butyral/polyvinyl acetal (para 38)	Adhesive, paints, lacquers and films. Used in sheet form as an interlayer in safety glass and shatter-resistant protection in aircraft
Polyvinyl chloride (para 39)	Plastic and rubber substitute in a variety of applications, including electric wire and cable-coverings, pliable thin sheeting, film finishes for textiles, non-flammable upholstery, raincoats, tubing, belting, gaskets and shoe soles Sewer and plumbing pipes
Potassium sorbate/sorbic acid (para 40)	Mold and yeast inhibitor and food preservative
Carbowymethylcellulose sodium/sodium carboxymethyl cellulose (para 41)	Drilling muds, detergents as a soil-suspending agent, resin emulsion paints, adhesives, printing inks, stabilizer in foods and as a pharmaceutical excipient

	Additive used to increase viscosity
Styrene/styrene monomer (para 42)	Production of plastics, synthetic rubber and resins, insulator
Tetramethylammonium chloride (para 43)	Chemical intermediate, catalyst or inhibitor General laboratory reagent
Tetramethylammonium hydroxide (para 44)	Strong organic base. Chemical reagent
Toluene (para 45)	Manufacture of explosives, dyes and many other organics compounds Solvent for paints, lacquers, gums and resins, thinner for inks, perfumes and dyes, gasoline additive Solvent for organic chemicals and reactions
Trimethylamine (para 46)	Manufacture of quaternary ammonium compounds, insect attractant and as a warning agent for natural gas Precursor from which trimethylamine can be generated when needed



**ROBERTS AFFIDAVIT #4**

NB The following terms were not discussed in the Kelland affidavit. Some of the terms discussed in the Kelland affidavit were also discussed in the Roberts Affidavit #4.

<b>PRODUCT</b>	<b>USE</b>
Dimethylformamide (para 14)	Solvent for liquids and gas. In the synthesis of organic compounds Solvent for Orlon and similar polyacrylic fibers Universal organic solvent
Formic acid (para 18)	Silage additive, prophylactic in treatment of animal feeds, acidulant in dyeing of natural and synthetic fibers, leather tanning, coagulating latex in rubber production Chemical synthesis
Methyl acrylate (para 21)	Manufacture of leather finish resins, textile and paper coatings, and plastic films Resin
Polymethyl methacrylate (para 40)	Used as an alternative to glass

**FEDERAL COURT**  
**SOLICITORS OF RECORD**

**DOCKET:** T-276-13

**STYLE OF CAUSE:** SK CORPORATION  
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**APPEARANCES:**

Adele J. Finlayson FOR THE APPLICANT

Vincent M. de Grandpré FOR THE RESPONDENT  
Alexander Monic

**SOLICITORS OF RECORD:**

Macera & Jarzyna LLP FOR THE APPLICANT  
Ottawa, Ontario

Osler, Hoskin & Harcourt LLP FOR THE RESPONDENT  
Ottawa, Ontario