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Svetlana Dobrota (SS)		
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Court File No.

FEDERAL COURT

B E I W E E N:

PRODUCTS UNLIMITED, INC.

Applicant

- and -

FIVE SEASONS COMFORT LIMITED

Respondent

NOTICE OF APPLICATION

(under Section 56 of the *Trademarks Act* and
Rule 300(d) of the *Federal Court Rules*)

TO THE RESPONDENT:

A LEGAL PROCEEDING HAS BEEN COMMENCED by the Applicant. The relief claimed by the Applicant appears on the following pages.

THIS APPLICATION will be heard by the Court at a time and place to be fixed by the Court or the Judicial Administrator. Unless the Court orders otherwise, the place of hearing will be as requested by the Applicant. The applicant requests that this application be heard at Edmonton, Alberta.

IF YOU WISH TO OPPOSE THIS APPLICATION, to receive notice of any step in the application or to be served with any documents in the Application, you or a solicitor acting for you must prepare a Notice of Appearance in Form 305 prescribed by the *Federal Courts Rules* and serve it on the Applicant's solicitor, **WITHIN 10 DAYS** after being served with this Notice of Application.

Copies of the *Federal Courts Rules*, information concerning the local offices of the Court and other necessary information may be obtained on request to the Administrator of this Court at Ottawa (telephone 613-992-4238) or at any local office.

IF YOU FAIL TO OPPOSE THIS APPLICATION, JUDGMENT MAY BE GIVEN IN YOUR ABSENCE AND WITHOUT FURTHER NOTICE TO YOU.

DATED at Edmonton, Alberta, Canada, this 2nd day of April, 2025

Issued by:

Address of local office:
Scotia Place
10060 Jasper Avenue
Tower 1, Suite 530
Edmonton AB T5J 3R8

TO: THE ADMINISTRATOR
Federal Court of Canada
Edmonton Local Office
Scotia Place
10060 Jasper Avenue
Tower 1, Suite 530
Edmonton AB T5J 3R8

AND TO: RICHES, MCKENZIE & HERBERT LLP
Suite 1800
2 Bloor Street East
Toronto, Canada M4W 3J5
Tel: (416) 961-5000

Solicitors/Agents for the Respondent, Five
Seasons Comfort Limited

AND TO: REGISTRAR OF TRADEMARKS
50 Victoria Street
Place du Portage 1
4th Floor
Gatineau, Quebec, K1A 0C9
Attention: Opposition Proceedings

APPLICATION

1. **THIS IS AN APPLICATION** to the Federal Court pursuant to Section 56 of the *Trademarks Act*, RSC 1985, c T-13 as amended (the “**Act**”) and Rule 300(d) of the *Federal Courts Rules*, SOR/98-106 (the “**Rules**”) appealing the decision of the Trade Mark Opposition Board (“**TMOB**”) for the Registrar of Trademarks (the “**Registrar**”) dated January 31, 2025 and issued February 3, 2025 (the “**Decision**”) allowing the Respondent’s opposition to the Applicant’s trademark application no. 1922128, as amended, (the “**Trademark Application**”) for registration of a trademark FILTER DESIGN (the “**Trademark**”) represented visually and described as:

Position

The trademark consists in whole or in part of the positioning of a sign.

Visual representation:



Full Description

The trademark consist of the position of generally diamond-shaped apertures in which a column of generally diamond-shaped apertures is slightly offset from another column to either side, the goods are shown with a dashed outline and do not form part of the trademark but is included merely to show the positioning of the trademark.

2. The Applicant makes an application for an Order:
 - a. granting this Appeal;
 - b. setting aside the Decision;
 - c. directing the Registrar to allow the Trademark Application and to register the Trademark;
 - d. awarding costs of this appeal in favour of the Applicant; and
 - e. such further and other relief as counsel may advise and this Honourable Court deems appropriate.

3. The grounds for this Application are:
 - a. On September 26, 2018, the Applicant filed an initial application for registration which was the subject of several amendments culminating in the Trademark Application to register the Trademark for use in association with “Air filters for industrial and commercial uses and installations namely filters for paint booths” based on actual use in Canada since at least as early as 1998-01-08;
 - b. The Respondent opposed the Trademark Application on a variety of grounds, including that Applicant’s Trademark was not registrable because the Trademark was dictated primarily by a utilitarian function contrary to Sections 38(2)(b) and 12(2) of the *Act*. As stated in the Respondent’s Statement of Opposition:

Pursuant to Section 38(2)(b), the Applicant’s Trademark is not registrable having regard to Section 12(2) in that the “generally diamond-shaped apertures in which a column of generally diamond-shaped apertures is slightly offset from another column to either side” shown and featured in the Applicant’s Trademark (and as described in the Applicant’s Application) are dictated primarily by a utilitarian function. These “generally diamond-shaped apertures”, as shown and described in the Applicant’s Trademark, are a structural feature of the Applicant’s Goods (e.g., air filters) that are intended to maximize structural support and rigidity while also maximizing airflow.

- c. The Registrar upheld the Respondent's opposition on this ground finding that the Respondent had "met its initial evidential burden under this ground of putting into issue the primarily functional nature of the Mark" (Para 46 of the Decision) and that the Applicant had not demonstrated on a balance of probabilities that the Trademark was registrable finding that "it is at best not clear whether the Mark is primarily functional" (Para 54 of the Decision);
- d. The Registrar erred in fact and/or law in refusing the Trademark Application by finding that Section 12(2) of the *Act* prohibited the registration of the Trademark;
- e. More particularly, but without limitation, the Registrar erred in fact and/or law by:
 - i. Applying the incorrect legal test to determine whether the Respondent had met its initial evidentiary onus. The Respondent did not, in substance, tender any evidence of its own in support of its opposition under Section 12(2) of the *Act*. Rather, the Respondent relied exclusively on print-outs from the Applicant's website, which the Respondent conceded could not be authenticated for the truth of their contents by the Respondent's affiant. Despite this, the Registrar, in error, gave the printouts "full weight" (Para 22 of the Decision) because the Applicant ostensibly participated in their creation. In a further error, given the Respondent's reliance on what was effectively the Applicant's evidence, the Respondent needed to demonstrate that the Applicant's evidence was "clearly inconsistent" with the Applicant's claim for registration. The Registrar erred in applying a lower threshold, requiring only that the Respondent show the evidence from the Applicant's website had "put into issue" whether the Trademark was primarily functional in nature (Para 46 of the Decision);
 - ii. Finding that the Respondent had met its initial evidentiary burden with respect to its asserted Section 12(2) ground of opposition. In particular, the Registrar erred:

1. In conflating claims on the Applicant's website relating to the performance of pockets embedded in the Applicant's filter product (i.e. the shape of three-dimensional features embedded inside the product) with the two-dimensional shape of the pattern of apertures on the surface of the filter product. There was no evidentiary basis to draw any conclusion or relationship between claims associated with the function of the pockets in the filter (which were not the subject of the Trademark Application) and the pattern of generally diamond-shaped apertures on the surface of the filter (which was); and
 2. In failing to compare any evidence of function associated with the Trademark to the functionality that was alleged in the Statement of Opposition. The Respondent's Statement of Opposition asserted that the pattern of apertures comprising the Trademark was selected because it was intended to "maximize structural support and rigidity while also maximizing airflow". None of the evidence tendered by the Respondent demonstrated any relationship between the pattern or positioning of features on the surface of the filter with these (or any other) functional criteria or, in the alternative, that the pattern of apertures was primarily dictated by those functional criteria;
- f. In the alternative, the Registrar's decision should be reversed because the additional evidence that will be adduced on this appeal by the Applicant is sufficient to meet any legal burden on the Applicant to establish that the features of the Trademark are not dictated primarily by a utilitarian function to the extent the Applicant is required to discharge that legal burden;
 - g. In view of the foregoing, the Decision should be set aside, the Respondent's opposition should be rejected, and the Application should be allowed;
 - h. The Applicant relies on the *Act* and the *Rules*; and

- i. Such further and other grounds as counsel may advise and this Honourable Court may permit.
4. This Application will be supported by:
- a. The materials before the Registrar in reaching the Decision, including the Trademark Application and the materials of record in the opposition proceeding being appealed from;
 - b. Such further and other supporting affidavits and documentary exhibits that the Applicant may serve and file pursuant to Section 56(5) of the *Act* and Rule 306 of the *Rules*;
 - c. Such further and other materials as counsel may advise and this Honourable Court may permit.
5. **Pursuant to Rule 317 of the *Federal Court Rules*, the Applicant hereby requests that the Registrar send a certified copy of all documents on file relating to trademark application No. 1922128, including the opposition proceedings, to the Applicant and to the Registry of the Federal Court.**

DATED at Edmonton, Alberta, this 2nd day of April, 2024



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