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Consumer and  
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Marques de commerce

Trade-marks

Ottawa-  
Hull  
K1A 0C9

**Mai 291991**

Fetherstonhaugh & Co.  
P.O. Box 2999, Station D  
Ottawa, Ontario  
K1P 5Y6

Votre reference Your file  
24241-D  
Notre reference Our file  
200,383

Dear Sir/Madam:

RE: SECTION 45 PROCEEDINGS  
Registration No. UCA31369  
Trade-mark: CINTEL

At the request of the firm of Rogers, Bereskin & Parr, the Registrar issued a S.45 Notice dated October 9, 1987 to The Rank Organization Limited of London, England, the registered owner of the above referenced trade-mark registration.

The mark CINTEL was registered under the Unfair Competition Act on August 23, 1948 for use in association with the following wares:

(1) Oscilloscopes and accessories, metal detectors, electronic counters, electronic timers, tubes for counting radiation and particles, oscillators, cathode ray tube recording equipment, photo-electric cells, cathode ray tubes and radio and television receiving and transmitting apparatus and instruments.

In response to the Registrar's Notice, the registrant furnished the affidavit of the Director and General Manager of Rank Cintel Limited, Mr. Jack Raynold Brittain, along with exhibits A, Band C thereto. Further to the filing of this evidence, the requesting party filed a written submission to which the registrant did not see fit to respond.

In his affidavit, Mr. Brittain declares that his company (Rank Cintel Limited), by virtue of a business sale agreement dated February 21, 1984, acquired from the Rank Organization plc (formerly the Rank Organization Limited) the beneficial interest, in Canada, in and to trade-mark CINTEL, even though such change in ownership was not recorded on the register at that time.

Mr. Brittain further asserts that his company is currently using its trade-mark in Canada, as at and shortly before the issuance of the S.45 Notice herein, in association with "television transmitting apparatus and instruments including telecines, still stores, sound followers, graphic devices and pre-programmers".

To substantiate his allegation of use, Mr. Brittain annexed to his affidavit several brochures and leaflets illustrating and describing wares of the type on which his company uses its said trade-mark in Canada, adhesive backed labels featuring the mark, and specimen invoices showing the sale of such trade-marked wares in Canada.

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In its written submission, the requesting party essentially criticizes this evidence on two main grounds:

1. that any use of the trade-mark shown by evidence is not use by the registered owner or a duly recorded registered user, as discussed in Marcus v. Quaker Oats Co. of Canada (1988) 20 C.P.R. (3d) 46; and
2. that the exhibits filed in support of the Brittain affidavit, namely A and C "clearly show use of the mark RANK CINTEL rather than CINTEL alone representing a substantial deviation from the registered trade-mark as discussed in The Molson Companies Ltd. v. Mitches & Co. et al (1980) 50 C.P.R. 2d 180, and the Registrar of Trade-marks v. Compagnie Internationale Pour l'Informatique CII Honeywell Bull, S.A. et al (1985) 4 C.P.R. (3d) 523.

On the first ground of attack, I must agree with the requesting party that the principle enunciated by the Federal Court of Appeal in the Marcus case, supra, needs to be considered in this instance. However, apparently unknown to the requesting party, counsel for the registrant filed an application on October 21, 1988 to record a change of name and an assignment of the subject registration. I have reviewed the documents filed with this application and I am satisfied that they show a change of name of the registered owner from The Rank Organization Limited to The Rank Organization Public Limited Company through a Certificate of Incorporation on Re-registration as a public company (distributing company), dated March 17, 1982. I am also satisfied that the said documents show an assignment of the subject registration from The Rank Organization Public Limited Company to Rank Cintel Limited, which assignment was effected on February 21, 1984 was therefore properly recorded nunc pro tunc by the Registrar on January 13, 1989. Therefore, I am satisfied that for the purposes of the present proceedings, Rank Cintel Limited was the registered owner of the trade-mark CINTEL as of the notice date herein, so that the evidence filed was properly furnished and any use of the trade-mark shown thereby is use by the registered owner.

On the second ground, I must agree with counsel for the requesting party that the CII Honeywell Bull case, supra, is on all fours with the present case. Obviously, the new owner is suing its mark CINTEL as a distinctive element of its corporate name. On all exhibits filed to show the manner in which the trade-mark CINTEL is used in association with the wares, it is always preceded by the word "RANK" and sometimes the pictorial of a man hitting a gong. This is clearly the use of a composite mark.

In the CII Honeywell case, supra, the learned judges came to the following conclusion:

"The problem to be resolved is not whether CII deceived the public as to the origin of the goods. It clearly did not. The real and only question is whether, by identifying its goods as it did, CII made use of its trade mark "BULL". That question must be answered in the negative unless the mark was used in such a way that the mark did not lose its identity and remained recognizable in spite of the differences between the form in which it was registered and the form in which it was used. The practical test to be applied in order to resolve a case of this nature is to compare the trade mark as it is registered with the trade mark as it is used and determine whether the differences between these two marks are so unimportant that an unaware purchaser would be likely to infer that both, in spite of their differences, identify goods having the same origin.

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Viewing the problem in that light and applying that test we cannot escape the conclusion that, in using the composite mark "CII Honeywell Bull", CII did not use its mark "BULL".

The conclusion to be drawn in the instant case is analogous, the use of the composite mark "RANK CINTEL" is not the use of the trade-mark "CINTEL".

Therefore, by reason of the evidence filed in these proceedings, I have no alternative but to conclude that the subject trade-mark is not in use in Canada and, in the absence of excusing circumstances, must be expunged from the register.

Registration UCA 31369 will be expunged accordingly, in compliance with the provisions of s-s. 45(5) of the Trade-marks Act.

Yours truly,

J.P. D'Aoust  
Senior Hearing Officer  
for Registrar of Trade-marks

JPD:sal

c.c. Messrs. Rogers, Bereskin & Parr  
Your ref.: 849-056