

**IN THE MATTER OF AN OPPOSITION by Conrex Automation  
Oy to application No. 732,320 for the trade-mark ELREPHO  
filed by Datacolor AG**

---

On July 5, 1993, the applicant, Datacolor AG, filed an application to register the trade-mark ELREPHO based upon use of the trade-mark in Canada by the applicant's predecessor-in-title, Carl Zeiss Canada, since at least as early as 1968 in association with "Instruments for registration and processing of color data, namely: spectrophotometer for measuring color, color differences, whiteness and opacity".

The present application was advertised for opposition purposes in the *Trade-marks Journal* of April 6, 1994 and the opponent, Conrex Automation Oy, filed a statement of opposition on September 2, 1994, a copy of which was forwarded to the applicant on December 12, 1994. The applicant served and filed a counter statement on March 21, 1995 in which it effectively denied the opponent's grounds of opposition. The opponent submitted as its evidence the affidavits of Heidi Mikkola, Jean Misurec and Wolfgang Budde while the applicant filed as its evidence the affidavit of Richard Vogel, together with certified copies of registration Nos. 143,342 and 301,006. The opponent was granted an order to cross-examine Richard Vogel on his affidavit but did not proceed with the cross-examination.

The applicant submitted an amended application during the opposition proceeding which was accepted by the Opposition Board in which it asserted that the trade-mark ELREPHO had been used in Canada by it and by Carl Zeiss and Carl Zeiss Canada Limited, the predecessors-in-title of the applicant, since at least as early as 1968. The applicant alone filed a written argument and was represented at an oral hearing.

As its first ground, the opponent alleged that the present application does not satisfy the requirements of Section 30 of the *Trade-marks Act* in that the applicant did not use the trade-mark ELREPHO in Canada since 1968 in association with the wares defined in the present application, contrary to Subsection 30(b) of the *Act*. As its second ground, the opponent alleged that the applicant could not state that it was satisfied that it was entitled to use its trade-mark ELREPHO in

Canada since it was already aware of the opponent's and/or its predecessor's use and promotion of the trade-mark AUTOELREPHO in Canada in association with the same or similar instruments. Further, under this ground, the opponent asserted that the applicant was already aware that ELREPHO was the name of the wares and was understood to refer to such wares.

The first two grounds of opposition are based on Section 30 of the *Trade-marks Act* and, more specifically, on Subsections 30(b) and 30(i) of the *Act*. While the legal burden is upon the applicant to show that its application complies with Section 30 of the *Trade-marks Act*, there is an initial evidential burden on the opponent to establish the facts relied upon by it in support of its Section 30 grounds [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; and *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R.(3d) 293]. The material time for considering the circumstances respecting the issues of non-compliance with Section 30 of the *Act* is the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R.(3d) 469, at p. 475].

It would appear that the issue raised by the opponent with respect to the applicant's claimed date of first use of the trade-mark ELREPHO in Canada has been rectified by the applicant's amendment to its application relating to the identity of its predecessors-in-title. As the opponent's evidence does not challenge the use of the trade-mark ELREPHO in Canada by Carl Zeiss and Carl Zeiss Canada Limited since at least as early as 1968 nor does it raise an issue as to Carl Zeiss and Carl Zeiss Canada Limited being predecessors-in-title of the applicant, I find that the opponent has failed to meet the evidential burden upon it in respect of the Subsection 30(b) ground. I have therefore dismissed the first ground of opposition.

The second ground relates to the applicant's application being in compliance with Subsection 30(i) of the *Trade-marks Act*, the opponent alleging that the applicant could not have been satisfied that it was entitled to use the trade-mark ELREPHO in Canada in view of the opponent's use and promotion of the trade-mark AUTOELREPHO in Canada in association with the same or similar instruments. However, no evidence has been furnished by the opponent relating to use of the trade-mark AUTOELREPHO in Canada either by it or a predecessor-in-title. Moreover, no evidence has

been furnished by the opponent that the applicant was aware that ELREPHO was the name of its wares and was understood to refer to such wares. Thus, the opponent has failed to meet the evidential burden upon it with respect to the Subsection 30(i) ground which is also unsuccessful.

As no evidence has been furnished by the opponent relating to its alleged prior use or prior making known of its trade-mark AUTOELREPHO in Canada, I have also rejected the opponent's ground of opposition relating to the applicant's non-entitlement to registration of the trade-mark ELREPHO which is based on these allegations. The opponent also alleged that the applicant is not the person entitled to registration of the trade-mark ELREPHO in Canada in view of its previously filed application for registration of the trade-mark AUTOELREPHO, application No. 704,871. However, application No. 704,871 has since been abandoned by the applicant and, in any event, the opponent's application was filed subsequent to the applicant's claimed date of first use of 1968. As a result, the opponent has failed to meet the requirements of Paragraph 16(1)(b) of the *Trade-marks Act* in relation to this ground. Consequently, this ground is also unsuccessful.

The next two grounds of opposition are based on Paragraphs 12(1)(b) and 12(1)(c) of the *Act*, the opponent alleging that the applicant's mark is either clearly descriptive or deceptively misdescriptive of the applicant's wares or is the name thereof since the word ELREPHO is an abbreviation of "electric remission photometer", the wares identified in the present application. However, no evidence has been furnished by the opponent in support of either of these grounds and the opponent has therefore failed to meet the evidential burden upon it as it relates to these issues. I have therefore dismissed the Paragraphs 12(1)(b) and 12(1)(c) grounds of opposition.

As its final ground, the opponent also asserted that the applicant's trade-mark is not distinctive in that the mark ELREPHO is either clearly descriptive or deceptively misdescriptive of the applicant's wares or is the name thereof and, further, that the trade-mark is confusing with its trade-mark AUTOELREPHO which had allegedly previously been used or made known in Canada. As noted above, no evidence has been furnished in support of any of these allegations and I have therefore rejected this ground of opposition for failure of the opponent to meet its evidential burden.

Having been delegated authority by the Registrar of Trade-marks pursuant to Subsection 63(3) of the *Trade-marks Act*, I reject the opponent's opposition pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC THIS 22<sup>nd</sup> DAY OF SEPTEMBER, 1998.

G.W.Partington,  
Chairperson,  
Trade-marks Opposition Board.