

**IN THE MATTER OF AN OPPOSITION  
by National Research Council of Canada to  
application No. 1,010,588 for the trade-mark  
ÉVIDENCE filed by Randox Laboratories Limited**

**On March 31, 1999, the applicant, Randox Laboratories Limited, filed an application to register the trade-mark ÉVIDENCE based on use and registration in the United Kingdom (registration No. 2,181,179) and on proposed use in Canada for the following wares:**

- (1) Chemical reagents for scientific or medical research and detection and monitoring of disease states in vitro; biochemical preparations, namely, enzyme and protein preparations for use in scientific and/or medical research applications and in the detection and monitoring of disease states in vitro.
- (2) Clinical chemistry and immunology test kits consisting primarily of reagents for use in the detection and monitoring of disease states in vitro, all for medical or veterinary use.
- (3) Computer software for use in conjunction with clinical chemistry immunoassay analysers to control sample handling, sample processing, sample result reporting and test system robotics, all for medical or veterinary use.
- (4) Clinical chemical / immunoassay analysers for medical and veterinary use; detectors, being analytical systems, instruments or equipment that facilitates the detection of a chemical or immunological response.

**The applicant claimed priority based on its corresponding U. K. application and thus the effective filing date of the present application is November 4, 1998. The application was advertised for opposition purposes on February 23, 2005.**

**The opponent, National Research Council of Canada ("NRC"), filed a statement of opposition on July 8, 2005, a copy of which was forwarded to the applicant on August 9,**

**2005. The first ground of opposition is that the applicant's application does not conform to the requirements of Section 30(e) of the Trade-marks Act in that the applicant could not intend to use its trade-mark in Canada in view of the opponent's registered trade-mark EvIdent. The second ground is that the applicant's application does not conform to the requirements of Section 30(i) of the Act because the applicant, having been aware of the opponent and its trade-mark, could not have been satisfied that it was entitled to use the applied for trade-mark in Canada.**

**The third ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with the opponent's trade-mark EvIdent registered under No. 562,568 for the following wares:**

Computer hardware and software for analyzing images in the field of medical diagnostics.

**The fourth ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(2) of the Act because, as of the applicant's effective filing date, the applied for trade-mark was confusing with the trade-mark EvIdent previously used in Canada by the opponent with the registered wares noted above. The fifth ground is that the applicant is not the person entitled to registration pursuant to Section 16(2) of the Act because, as of the applicant's effective filing date, the applied for trade-mark was confusing with the trade-mark EVIDENT previously used in Canada by the opponent with the registered wares noted above**

**The sixth ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3) of the Act because, as of the applicant's effective filing date, the applied for trade-mark was confusing with the trade-mark EvIdent previously used and made known in Canada by the opponent with the registered wares noted above. The seventh ground is that the applicant's trade-mark is not distinctive because it is confusing with the opponent's previously used and registered trade-mark EvIdent.**

**The applicant filed and served a counter statement. As its evidence, the opponent submitted an affidavit of Douglas Strang and a certified copy of its trade-mark registration. The applicant chose not to submit evidence. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.**

#### **THE OPPONENT'S EVIDENCE**

**The certified copy of the opponent's registration reveals that the registered mark is EvIdent. The basis for the registration was use of the mark in Canada since May 27, 1997.**

**In his affidavit, Mr. Strang identifies himself as a Technology Commercialization Officer with NRC's Institute for Biodiagnostics ("IBD"). NRC is a departmental corporation of the Crown and IBD researchers conduct research and develop medical diagnostic technologies and computer software to implement such technologies. IBD produces, maintains and sells software for use in analysing biomedical imaging data such as that obtained from magnetic resonance imaging, spectroscopic imaging, perfusion imaging**

and microscopic imaging. Mr. Strang states that medical facilities purchasing the opponent's software also use computer software for use with chemistry immunoassay analysers and that, in many cases, the same purchasing personnel are involved.

According to Mr. Strang, NRC has used both the registered trade-mark EvIdent and the trade-mark EVIDENT in association with the computer software since May 27, 1997 when a sale was made to The Toronto Hospital. NRC promotes its software in association with its trade-marks through brochures distributed by mail and at conferences and forums. The marks are also displayed on the computer screens of the software users. Exhibit E to the Strang affidavit is a photocopy of the front page of the September 1998 user manual that was, at that time, sold in association with the opponent's software. The front page prominently features the registered trade-mark EvIdent.

Mr. Strang states that NRC's product invoices for the software show the trade-mark EVIDENT and sometimes the mark EvIdent. Exhibit H is a photocopy of a June 28, 2002 invoice to the University of Saskatchewan. Mr. Strang details steady but modest annual sales for NRC's software totalling approximately \$60,000 for the period 1997 to 2004.

#### **THE APPLICANT'S EVIDENCE**

As noted, the applicant elected not to submit evidence.

## **THE GROUNDS OF OPPOSITION**

The first ground does not raise a proper ground of opposition. The mere existence of the opponent's trade-mark registration does not affect the legitimacy of the applicant's stated intention to use its mark in Canada. Thus, the first ground is unsuccessful.

The second ground also does not raise a proper ground of opposition. The mere fact that the applicant may have been aware of the opponent and its trade-mark does not preclude the applicant from honestly making the statement in its application that is required by Section 30(i) of the Act. Thus, the second ground is also unsuccessful.

As for the third ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

As for Section 6(5)(a) of the Act, the applicant's mark ÉVIDENCE is inherently distinctive in relation to the applied for wares. However, given that the mark is used in association with diagnostic testing apparatus and software for detecting what is essentially

medical evidence, it is at least somewhat suggestive and therefore not inherently strong. Since there is no evidence from the applicant, I must conclude that its mark has not become known at all in Canada.

The opponent's registered mark EvIdent is inherently distinctive in relation to the registered wares. However, it, too, is at least somewhat suggestive of computer software used to identify and analyse medical diagnostic images. Thus, it is not an inherently strong mark. Given the limited use of the opponent's mark to date, I am only able to conclude that it has become known to a limited extent within the medical diagnostic community.

The applicant contended that it is unclear to what extent the opponent has used its registered mark EvIdent since it has also used the word mark EVIDENT without the capitalized letter I in the middle. However, I consider that the mark EVIDENT is a minor variation of the registered mark and that use of one is use of the other: see the decision in Registrar of Trade Marks v. Compagnie Internationale pour L'Informatique CII Honeywell Bull, S.A. (1985), 4 C.P.R.(3d) 523 (F.C.A.) and the second principle set out at page 538 in the reported decision in Nightingale Interloc Ltd. v. Prodesign Ltd. (1984), 2 C.P.R.(3d) 535 (T.M.O.B.).

As for Section 6(5)(b) of the Act, the length of time the marks have been in use clearly favors the opponent. As for Sections 6(5)(c) and 6(5)(d) of the Act, it is the applicant's statement of wares and the statement of wares in the opponent's registration that govern: see

**Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R.(3d) 3 at 10-11 (F.C.A.), Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R.(3d) 110 at 112 (F.C.A.) and Miss Universe, Inc. v. Dale Bohna (1994), 58 C.P.R.(3d) 381 at 390-392 (F.C.A.).** However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful: see the decision in **McDonald's Corporation v. Coffee Hut Stores Ltd. (1996), 68 C.P.R.(3d) 168 at 169 (F.C.A.).**

The wares of the parties are similar in that they are all used for medical testing and diagnostics. Both parties include computer software within their wares although the specific uses for the software are somewhat different. Nevertheless, as noted by Mr. Strang, there is an overlap in the trades of the parties since facilities purchasing the opponent's software would also use the applicant's software and presumably the related testing products and equipment. Mr. Strang notes that, in many cases, the same purchasing personnel would be involved.

As for Section 6(5)(e) of the Act, I consider there to be a very high degree of resemblance between the marks at issue in all respects. The first six letters of both marks are effectively the same and they would be viewed and sounded similarly.

In applying the test for confusion, I have considered that it is a matter of first

**impression and imperfect recollection. The onus or legal burden is on the applicant to show no reasonable likelihood of confusion on a balance of probabilities. That means that if the probabilities favor neither side, I must resolve the issue against the applicant. In view of my conclusions above, and particularly in view of the high degree of resemblance between the marks at issue and the fact that there is an overlap in the trades of the parties, I find that the applicant has failed to show on a balance of probabilities that its proposed mark ÉVIDENCE is not confusing with the opponent's registered mark EvIdent. Thus, the third ground of opposition is successful.**

**As for the seventh ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - July 8, 2005): see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.). Finally, there is an evidential burden on the opponent to prove the allegations of fact in support of its ground of non-distinctiveness.**

**The seventh ground of opposition essentially turns on the issue of confusion between the applicants' proposed mark and the opponent's mark EvIdent. For the most part, my conclusions respecting the third ground of opposition also apply to the seventh ground.**



**Thus, I find, on a balance of probabilities, that the applicant has failed to show that its proposed mark was not confusing with the opponent's mark as of the filing of the opposition. Thus, the seventh ground is also successful and it is unnecessary to consider the remaining grounds.**

**In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.**

**DATED AT GATINEAU, QUEBEC, THIS 21<sup>st</sup> DAY OF FEBRUARY, 2008.**

**David J. Martin,  
Member,  
Trade Marks Opposition Board.**